

## DISPUTE RESOLUTION SERVICE

D00012328

### Decision of Independent Expert

Barclays Bank Plc

and

Mr Graham Kenny

#### 1. The Parties:

Lead Complainant: Barclays Bank Plc  
1 Churchill Place  
London  
E14 5HP  
United Kingdom

Respondent: Mr Graham Kenny  
8 St. Pauls Road  
Torquay  
TQ1 3QF  
United Kingdom

#### 2. The Domain Name(s):

2.1 The domain name in issue in these proceedings is <barclaycard-ppi-reclaim.co.uk> (the “Domain Names”)

#### 3. Procedural History:

3.1 The procedural timeline in this case is as follows:

09 January 2013 17:58 Dispute received  
10 January 2013 11:17 Complaint validated  
10 January 2013 12:04 Notification of complaint sent to parties

29 January 2013 01:30 Response reminder sent  
31 January 2013 09:55 Response received  
01 February 2013 09:59 Notification of response sent to parties  
06 February 2013 01:30 Reply reminder sent  
08 February 2013 11:05 Reply received  
08 February 2013 11:07 Notification of reply sent to parties  
08 February 2013 11:11 Mediator appointed  
13 February 2013 15:25 Mediation started  
08 March 2013 12:04 Mediation failed  
08 March 2013 12:04 Close of mediation documents sent  
18 March 2013 10:22 Expert decision payment received

- 3.2 I was appointed as Independent Expert on 21 March 2013 and I have confirmed to Nominet that I am independent of the parties and know of no facts or circumstances that might call into question my independence in the eyes of the parties.

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

- 4.1 The Complainant is a subsidiary of Barclays Plc and is part of the Barclays group. It is a well known financial services provider and provides retail banking, credit cards, corporate banking, wealth management and investment management services around the world.
- 4.2 The Complainant is the owner of various registered trade marks around the world including:
- (i) UK registered trade mark no 1286579 filed on 9 October 1986 for the word marks “BARCLAY” and “BARCLAYS” in class 36;
  - (ii) Community registered trade mark no 009861402 filed on 1 April 2011 for the word mark “BARCLAYCARD” in classes 9, 16 and 36;
  - (iii) UK registered trade mark no 2496317 filed on 29 August 2008 in classes 9, 35 and 36 for a device mark (the “Barclaycard Logo”) that takes the following form:



- 4.3 The Respondent is an individual involved in the claims management industry, and through a company offers services in relation to the recovery of mis-sold Payment Protection Insurance (“PPI”).
- 4.4 On 25 July 2012 the Respondent registered the Domain Name. He has since that date used the Domain Name or allowed the Domain Name to be used for a web site offering Barclaycard related PPI claims services.
- 4.5 On 15 November 2012, the Complainant’s solicitors wrote to the Respondent complaining that the Domain Name and the website operating from the Domain Name infringed the Complainant’s intellectual property rights. It noted that although the website made reference to “My Claims Cold Limited”, there was no company of that name registered at Companies House. However, it recorded that there was a company with the name “My Claims Solved.com Limited” and that the Respondent was the sole director and shareholder of that company.
- 4.6 The Respondent’s solicitors responded to that letter on 23 November 2012. In that letter the Respondent sought to counter the Complainant’s allegations of trade mark infringement and suggested that any complaint about the domain name was more properly raised through the DRS.
- 4.7 On 5 December 2012 the Complainant’s solicitors responded to that letter, addressing once again the question of trade mark infringement, claiming that the Respondent had not addressed separate allegations for copyright infringement and also made reference to the “three strikes” presumption to be found in paragraph 3c of the DRS. The Respondent’s solicitors responded on 10 December 2012. That letter, to the limited extent that it addressed the claims made, denied that the Respondent was engaged in any wrongful activity.
- 4.8. As at, and prior, to the date of the Complaint the webpage operating from the Domain Name took the following form:
- (i) at the top and to the left hand side of the web page is prominently displayed the Barclaycard Logo together with the BARCLAYCARD mark in lower case text - under which;
  - (ii) in large text the question ”Have you ever had a loan, credit card or mortgage with Barclaycard” - under which is displayed;
  - (iii) smaller text which reads “You could be owed £1,000s in compensation if Barclaycard mis-sold you PPI” -under which is displayed;
  - (iii) further text in relation to making a claim and an online form titled “Barclaycard mis-sold PPI claim application”; and
  - (iv) at the bottom of the page in very small text is to be found the sentence “© Copyright 2012 My Claim Solved Ltd Authorisation

Number: CRM 29233, My Claim Solved Limited, registered in England, Number: 7718504, address: 8 St Pauls Road Torquay TQ1 3QF” together with other small text containing references to “My Claim Solved Limited”.

- 4.9 Recently the form of the web page operating from the Domain Name has changed slightly. It essentially has the same form as that described above, but there has now been added towards the bottom of the page in relatively small text the following disclaimer:

“My Claim Solved Ltd are an independent claims service and not a barclaycard site or service, nor are they in any way connected to barclaycard.”

- 4.10 The Respondent has previously been involved in a number of disputes under the Nominet procedure. These are:

- (i) DRS 11478 brought by the Complainant’s parent company in respect of the Respondent’s registration of <barclays-ppi-reclaim.co.uk>; and
- (ii) DRS 11286 brought by the Royal Bank of Scotland Group plc in respect of the Respondent’s registration of <natwest-ppi-reclaim.co.uk>

In each case the domain name was held to be an abusive registration and transferred to the Complainant.

## **5. Parties’ Contentions**

### Complaint

- 5.1 The Complainant refers to its various trade marks, and contends that the Domain Name is identical or similar to its BARCLAYCARD trade mark on the grounds that this mark is the dominant and only distinctive element of the Domain Name. It also claims to be the owner of the copyright in the Barclaycard Logo and claims that the display of this logo on the website operating from the Domain Name involves an infringement of that copyright.
- 5.2 On the issue of abusive registration the Complainant claims that “no attempt has been to distinguish the Domain Name or the content of the Website from the Complainant’s BARCLAYCARD brand” and that “the Website amounts to an impersonation of the Complainant by the Respondent”. Further it claims that the Respondent had intentionally attempted to attract for commercial gain internet users to his website through the inclusion of Barclaycard in the Domain Name and that there is no use of the Domain Name that would not involve trade mark infringement.

- 5.3 In this respect the Complainant refers to the fact that it displays pages on its own website that describes a claim can be made against it for mis-sold PPI. The top part of that webpage displays the Barclaycard Logo together with the BARCLAYCARD on the left hand side of the page. The similarities between this page and webpage operating from the Domain Name are said to contribute “to the likelihood that consumers may be confused into believing that the Respondent’s website is approved by the Complainant”.
- 5.4 The Complainant also seems to complain about the fact that the Respondent is using the Domain Name and website to gather names and addresses of those who have PPI claims against it. It says that it is aware of other companies engaged in this or similar activities but “these websites are operated from domain names which are not targeted at specific companies, nor do they use these companies’ registered trade marks in the domain names or their copyright material on the corresponding website”.
- 5.5 Reference is also made to the previous DRS cases involving the Respondent and notes that the Domain Name was registered at the time that the mediation stage was taking place in DRS 11478.

#### Response

- 5.6 The Respondent submitted a Response in the form of a letter from his solicitors. That letter did not contain the statement required by paragraph 5 (c)(v) of the DRS Procedure.
- 5.7 The letter contains a denial of the allegations of infringement. It confirms that the Respondent provides a service for the claiming of compensation and refunds associated with the Complainant’s mis-selling of financial products and states that this service is regulated by the Ministry of Justice. It denies that the Respondent is engaged in services that are competitive to that of the Complainant.
- 5.8 It further claims that the Complainant’s intent in pursuing this complaint is to restrain a legitimate business from pursuing claims on behalf of the general public and that this amounts to an “unfair restraint of trade”.
- 5.9 The Respondent further contends that the Complainant’s marks are “in most respects relatively common names”. What exactly is meant by this is not further explained. The letter further contends that there has “been no single occasion of confusion on the part of any member of the general public in relation to our client’s domain name but in fact the specific design of that domain name ensures that any risk of confusion is not existent”. How the “design” of the domain name is said to achieve this is again not explained.
- 5.10 The letter further goes on to complain about the Complainant’s trading practices and once again complains about the motives of the Complainant in making the Complaint.

- 5.11 The letter further contends that at all material times the Respondent has been willing to consider changes to his domain names and the content and design of his sites. However, no evidence is offered in this respect.
- 5.12 The letter complains about the fact that Complainant made reference to the mediation process in DRS 11478 and then makes various claims about what occurred during that process. Finally, it claims that the decision in cases DRS 11478 and DRS 11286 are of no binding effect and “should be disregarded for the purposes of this complaint”.

### Reply

- 5.13 In its Reply the Complainant restates a number of the points it made in its Complaint. However:
- (i) it denies that it is engaged in any improper restraint of trade and contends that its objection is to the infringement of its “intellectual property rights” as opposed to the “the Respondent’s business per se”;
  - (ii) in response to the Respondent’s claimed willingness to make changes to the way in which he operates, it maintains that the Complainant’s concern is not only with the content of the website but the registration and use of the Domain Name and accordingly it does not believe that the “making amendments of the Website alone will adequately address its concerns; and
  - (iii) denies that reference to the fact that the Domain Name was registered during the mediation process in in DRS 11478 was in any way improper and comments that this is a fact that is effectively a matter of public record by reference to the fact that the dates of mediation are referred to in the decision in this case.

## **6. Discussions and Findings**

### General

- 6.1 To succeed under the Policy, the Complainant must prove first, that it has Rights in respect of a “name or mark” that is identical or similar to the Domain Name (paragraph 2(a)(i) of the Policy) and second, that the Domain Name is an Abusive Registration in the hands of the Respondent (paragraph 2(a)(ii) of the Policy). The Complainant must prove to the expert that both elements are present on the balance of probabilities (paragraph 2(b) of the Policy).
- 6.2 Abusive Registration is defined in paragraph 1 of the Policy in the following terms:

*“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."*

6.3 Before addressing whether the Complainant has satisfied these requirements, it is convenient first to address a number of procedural issues in this case. They are as follows:

(i) The failure of the Response in this case to comply with paragraph 5 (c)(v) of the DRS procedure.

(ii) The Respondent's contention that the Complainant has acted improperly in referring to the fact that the Domain Name was registered when the Complainant and Respondent were engaged in the mediation stage of previous proceedings under the Policy; and

(ii) The relationship between the Respondent and My Claims Solved.com Ltd/ My Claim Solved Ltd

6.4 There are various procedural requirements laid down by the DRS procedure as to the form and content of the submissions of the parties pursuant to the DRS. They include a requirement that any Complaint or Response be accompanied by a declaration as to the truthfulness of the information contained in this submission. Given the relatively informal nature of the proceedings under the Policy with no procedure for the exchange or testing of factual evidence beyond that set out in or referred to in the parties submissions, the inclusion of this statement is important..

6.5 This declaration is missing from the Respondent's Response. Nevertheless, I am still prepared to consider the content of that Response. The reason is that there is little of significance that is factually in dispute in this case and for the most part the Response constitutes legal or procedural argument.

6.6 As to the Respondent's complaint about the Complainant's reference to the timing of the registration of the Domain Name, I consider it to be without merit. Paragraph 6 of the Policy states that:

"Documents and information which are 'without prejudice' (or are marked as being 'without prejudice') may be used in submissions and may be considered by the Expert except that the Expert will not consider such materials if: i. they are generated within Informal Mediation ..."

6.7 Neither the fact that a mediation has taken place or the fact that a domain name was registered during that process constitute documents or information "generated within Informal Mediation". Indeed, as the

Complainant has pointed out, the dates of the mediation are a matter of public record, being recorded in the substance of the decision in DRS 11478. The date of the registration of the Domain Name is also recorded in the publically available WhoIs details for the Domain Name. There is no good policy reason why the Complainant should be precluded from referring to these facts in these proceedings.

- 6.8 In contrast, the Respondent's attempt to refer in his Response to statements made in the course of that mediation is of a somewhat different character. The mediation process is intended to provide a mechanism whereby the parties can freely make statements with a view to settlement without the fear that these statements will subsequently be used against them in those or any subsequent DRS proceedings. The Respondent has sought to rely on his own statements rather than those of the Complainant. However, I do not think this makes any difference. One cannot fairly consider the significance of any statement, unless it is judged against the discussions as a whole, and this would involve an impermissible disclosure of the Complainant's stance in those discussions. As is the case with without prejudice communications in the context of court proceedings, these discussions should be treated as subject to a joint "privilege" that cannot be waived by one party alone<sup>1</sup>. For this reason the nature of those claimed statements are not recorded in this decision nor have I taken any notice of them in coming to my decision. In any event, even had I taken these comments into account they are unlikely to have been of any probative value.
- 6.9 Finally, I note that for the purposes of these proceedings both parties seem to have proceeded on the assumption that the Respondent and My Claims Solved.com Ltd/ My Claim Solved Ltd can be treated as essentially the same entity and that the Respondent is responsible for and controls the content of the website operating from the Domain Name. Accordingly, I proceed on that basis in this decision.

#### Complainant's Rights

- 6.10 Although the Complainant refers in its Complaint both to its BARCLAYS and BARCLAYCARD marks, it would appear that only the BARCLAYCARD mark is relied upon for the purposes of section 2(a)(i) of the Policy.
- 6.11 It is clear and undisputed that the Domain Name contains and deliberately refers to the Complainant's BARLAYCARD mark. The Domain Name can only sensibly be read as combining that mark with the terms "PPI" and "reclaim". Both "PPI" and "reclaim" are terms or words that do not in any way detract from the trade mark incorporated in the Domain Name. Accordingly, the Complainant has rights in respect of a name or mark which is similar to the Domain Name and the Complainant has made out the requirements of paragraph 2(a)(i) of the Policy.

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<sup>1</sup> See White Book paragraph 31.3.40



### Abusive Registration

6.12 There are aspects of both parties' submissions that have been of limited assistance to me in assessing whether the Domain Name is an abusive registration.

6.13 So far as the Complainant is concerned, there are frequent claims that the Respondent has infringed or is infringing its trade marks. The problem with this is that although the questions of abusive registration and trade mark infringement often overlap, they are not the same. In *Seiko UK Limited v. Designer Time/Wanderweb* DRS 00248 the Appeal Panel stated as follows:

“The Panel considers that parties and Experts should not be overly concerned with whether or not an allegedly abusive registration also constitutes an infringement of registered trade mark. The question of trade mark infringement is, as both parties (and the Expert) agree, one for the courts to decide. The question of abusiveness is for the Expert to decide. The two jurisdictions co-exist alongside each other, and no doubt there will be considerable overlap. However there may well be factual scenarios in which an abusive registration under the Policy would not be an infringement of trade mark under the 1994 Act, and where an infringement of trade mark under the 1994 Act would not be an abusive registration under the Policy. The safest course for parties and Experts is simply to address the terms of the Policy.”

6.14 The Appeal Panel in *Comité Interprofessionnel du Vin de Champagne v Steven Terence Jackson*, DRS 4479 also quoted this aspect of the *Seiko* decision with approval. Further, more recently in *Furniture Village Limited v. Furnitureland.co.uk Ltd.* DRS9674 the Appeal Panel (at paragraph 8.21) swiftly dismissed a complaint that the original Expert in that case had given insufficient weight to claims of trade mark infringement with the words:

“... the question of whether the Respondent's activities amount to trade mark infringement is a matter to be determined elsewhere ...”

6.15 Trade mark law cases are referred to in the Experts' Overview. However, the reasons for this are set out in the introduction to that Overview as follows:

“Disputes are decided by reference to the terms of the Policy, not the law, so the fact that a domain name registration and/or the registrant's use of it may constitute trade mark infringement, for example, will not necessarily lead to a finding of Abusive Registration under the DRS Policy. Nonetheless, if the DRS Policy and the Law are too far apart, the DRS Policy will inevitably lose some of its value. Rights owners or domain name registrants (depending upon the nature of dispute) may prefer the expense of litigation to the likely result under the DRS Policy.

Accordingly, it is important that all concerned are aware of relevant legal developments and it is for this reason that in this Overview there are references to UK court decisions, most if not all of which are to be found in full text form on the Nominet web site.”

- 6.16 So for example, although the Appeal Panel in *Toshiba Corporation v Power Battery Inc* DRS 07991 refers to various ECJ decisions on the issue of trade mark infringement, it is reasonably clear that ultimately it was concerned with and had to form a view on the separate question of what was an abusive registration.
- 6.17 Against that background, mere assertions of infringement of the sort made by the Complainant in this case are not particularly helpful.
- 6.18 There are various similarly unhelpful assertions by the Respondent. For example, both in prior correspondence and in his Response, the Respondent refers to the fact that his activities are supervised by the Ministry of Justice as if this is a matter of some importance. However, why this might be sensibly said of any relevance to proceedings under the Policy is not really explained.
- 6.19 Similarly, the Respondent’s contends that the Respondent questions the Complainant’s real motives for bringing this complaint and claims that the Complainant’s is engaged in an unfair restraint of trade. However, why if true (and the Complainant of course denies that it is true) this would be relevant, is again not explained. These are not issues for an expert applying the Policy. The task of the expert is simply to assess whether the Complainant has made out the requirements of paragraph 2(a).
- 6.20 What is clear is that the Respondent is engaged in a lawful business of PPI claims management in relation to “Barclaycard” and is using the trade mark BARCLAYCARD in the Domain Name for that purpose. The Complainant contends that the use in this case is unfair and amounts to impersonation. The Respondent denies that this is so claiming that no one has ever been confused by the use of the trade mark.
- 6.21 Whether such use amounted to an abusive registration is a question that was addressed by experts both in the DRS 11286 and DRS 11478 cases. The Respondent’s activities in those cases seem to have been very similar if not identical to those undertaken from the Domain Name. DRS 11478 involved the Complainant’s parent company and the domain name was <barclays-ppi-reclaim.co.uk>. In DRS 11286 the Complainant was The Royal Bank of Scotland plc and the domain name in issue was <natwest-ppi-reclaim.co.uk>.
- 6.22 The Respondent contends that these decisions are not binding upon an expert in any subsequent case and should be “disregarded”. The first part of that statement is correct but the second is misconceived. Although, previous decisions under the DRS are not formally binding upon me, it clearly makes sense to consider whether the reasoning in any case

(particularly if relied upon by one of the parties) is of assistance in determining any issue before me. Further, there is significant value in consistency and thereby predictability of decision making under the DRS process. Therefore if an expert disagrees with the analysis of another expert in relation to an issue under the DRS at the very least he or she should explain why he or she does so.

6.23 Of the two decisions the analysis of the expert in DRS 11286 is somewhat more detailed and it is sufficient to refer to this case alone. In particular, the expert stated as follows:

“6.16 ... It seems to me that there are three broad categories of case which could be of assistance here. These are all cases where the domain name in issue included the name or mark in which the complainant had Rights and where that mark is well known. These are as follows:

1. Cases where the respondent was using the name or mark in which the complainant had Rights without addition or with only the addition of some fairly descriptive words which relate to the complainant’s own business – a feature of these cases is that the respondents are usually up to no good and have registered the domain names either to divert customers to their own trading websites or use the domain names as parking pages in order to generate pay per click revenue. One such example of a case that falls into this category is DRS case D00005761 natwest-ibank.co.uk which is cited by the Complainant in its Complaint. These cases are usually relatively easy and it is clear that the domain name is being used to create an unfair advantage for the respondent and this in turn causes unfair detriment to the complainant’s name or mark.
2. Reseller cases – these are cases where the respondent operates an online shop which resells the genuine goods of the complainant. These cases are more difficult, although for a number of reasons they have generally been decided in favour of the complainants. I will discuss the relevant tests set out in these cases below;
3. Tribute or Criticism Sites – these cases can be decided either way, but as a rule of thumb the domain names in issue stand a much better chance of being regarded as fair use if the domain name flags up what the visitor is likely to find at the site rather than use the mark without addition. This is set out in the expert’s overview as follows:

*A criticism site linked to a domain name such as <ihateComplainant.co.uk> has a much better chance of being regarded as fair use of the domain name than one connected*

*to <Complainant.co.uk>. The former flags up clearly what the visitor is likely to find at the site, whereas the latter is likely to be believed to be a domain name of or authorised by the Complainant.*

6.17 Returning now to the reseller sites which I described as category 2 above, these were considered by the Appeal Panel in DRS07991 toshiba-laptop-battery.co.uk. In this case the respondent was using the domain name to run a site which sold both Toshiba laptop batteries, other Toshiba accessories as well as other accessories from other manufacturers. The Appeal Panel summarised the principles to be applied as follows:

1. *It is not automatically unfair for a reseller to incorporate a trade mark into a domain name and the question of abusive registration will depend on the facts of each particular case;*
2. *A registration will be abusive if the effect of the respondent's use of the domain name is falsely to imply a commercial connection with the complainant;*
3. *Such an implication may be as a result of "initial interest confusion" and is not dictated only by the contents of the website;*
4. *Whether or not a commercial connection is implied, there may be other reasons why the reseller's incorporation of the domain name was unfair. One such reason is the offering of competitive goods on the respondent's website".*

6.18 The present case does not fit squarely into any of these categories although it has some similarities with all three, particularly, in my view, the reseller cases.

6.19 From the Toshiba laptop battery case, it can be seen that the test is really whether the respondent's use of the domain name is such so as to falsely to imply a commercial connection with the complainant. This implication can be drawn because of, "initial interest confusion", i.e. because the public see the domain name and assume it is connected with the complainant, or it can be for another reason – for example because the public visit the website and assume it is something to do with the complainant.

6.20 The Respondent says that his registration and use cannot be an Abusive Registration because, inter alia, the Complainant does not provide the same services and therefore the Complainant's mark is only used to identify the nature of the services that the Respondent is providing. I am not sure whether what the Respondent says is completely correct as a matter of fact. Neither side has provided any evidence about it, but I am aware that claims for PPI mis-selling can

be made directly to the institutions involved as well as through claims handling services, such as the one run by the Respondent and indeed there has been quite a lot about this in the press in the last few months.

- 6.21 In any event and whether or not what the Respondent says about the Complainant offering these services is correct it seems to me to be entirely feasible that a member of the public who is looking to reclaim their premiums or make a claim in relation to mis-sold PPI may well visit the Respondent's website believing it is in some way connected to the Complainant and that it therefore provides a way of claiming or reclaiming these monies directly from the Complainant.
- 6.22 One could argue that this is only analogous with the tribute or criticism site point and that the Domain Name is simply flagging up what one can expect to find at the Respondent's website. I do not think however that this analogy holds good. With the tribute or criticism sites, if you go to a site which is linked to the domain names, "IhateNatWest.co.uk" or "IloveNatWest.co.uk", you know what you are going to get, i.e. a site either criticising or praising NatWest. It is very unlikely to be run by NatWest. The Domain Name is however subtly different. It is suggestive of a service that the Complainant may well feasibly offer (even if in actual fact it does not) as it is so closely related to the Complainant's business. In my view and on the balance of probabilities this makes it all the more likely that the public will believe that the Domain Name is something to do with the Complainant, regardless of the fact that the Domain Name describes what is to be found at the site.
- 6.23 I am also swayed towards this view by the look and feel of the Respondent's site. The Complainant's logo appears prominently at the top of the Respondent's site and the true identity of the Respondent is only contained in very small type at the bottom of the site. It seems to me that it is very possible indeed that the public will believe that the site is indeed something to do with the Complainant. It may even be that this is the Respondent's intention.
- 6.24 By way of conclusion therefore I do think that on the balance of probabilities that the Respondent has registered and/or used the Domain Name in order to take unfair advantage of the Rights that the Complainant has in its name or mark and that in doing so, he may well have also caused unfair detriment to those Rights. I therefore find that on the balance of probabilities that the Domain Name is in the hands of the Respondent an Abusive Registration.
- 6.24 I am in agreement with the analysis at paragraphs 6.16 to 6.19 of the decision from which I have just quoted. In particular, I accept that although this is not a reseller case, there are clear similarities with those sorts of case. Accordingly, the reasoning and principles identified by the

appeal panel in the Toshiba case as to when a registration is unfair are of relevance.

- 6.25 It is also apparent from paragraphs 6.20 to 6.21 that the expert considered the fact that whether NatWest offered a PPI reclaim and compensation service (or perhaps more accurately, might be thought by the public to offer such a service) to be of some importance when it came to an assessment of how the public might perceive the domain name. I agree that this is a relevant factor in the assessment and in the present case it seems even clearer than it was in DRS 11286 that the Complainant is engaged in some form of independent advertising as to how a PPI mis-selling claim can be made against it.
- 6.26 However, I have some reservations about the analysis and reasoning to be found at paragraph 6.22 of the decision. It appears (although this is not entirely clear) from the statement that “the public will believe that the Domain Name is something to do with the Complainant regardless of the fact that the Domain Name describes what is to be found at the site” that the expert was persuaded that this was a case of impermissible initial confusion. In doing so it is also noticeable that he contrasted the form of the domain name before him with that of <IhateNatWest.co.uk> where the nature of the site was clear from the domain name alone.
- 6.27 I certainly agree that where a domain name clearly flags up the fact that the site is likely to be unconnected with a trade mark owner, there is unlikely to be unfair initial interest confusion. Similarly where a domain name takes the form of <[trademark].co.uk>, such confusion can perhaps be presumed. However, the more difficult question is how one should treat those cases where the domain name incorporates the trade mark and some other text, particularly where the domain name is said to be descriptive of the goods or services on offer.
- 6.28 This is a question that the Appeal Panel sought to address in the Toshiba decision. There was no unanimity among the panellists on this issue and the majority and minority view can be found in the following passage in that decision:

“The Panel does not believe that any reasonable Internet user who was looking to find an official Toshiba UK website in order to buy a genuine Toshiba battery would actually type the address [www.toshiba-laptop-battery.co.uk](http://www.toshiba-laptop-battery.co.uk). However, “initial interest confusion” could arise where, as is much more likely, a user types the terms “toshiba laptop battery” into a search engine and is then presented with a range of results including the Respondent’s website address incorporating the Domain Name. The question is whether the Internet user would, at that point, be confused into believing that the Respondent’s site was operated or authorised by the Complainant or was otherwise connected with the Complainant.

The view of the majority of the Panel is that the Complainant has not demonstrated, on the balance of probabilities, that the Respondent's use of the Domain Name would be likely to give rise to any such confusion. The majority panellists do not consider that either the Domain Name itself or the results of a search of the terms in question would be likely to result in any such confusion in the mind of the average Internet user, bearing in mind that a typical search page includes a short description of each "hit" as well as the actual domain name. So far as the name itself is concerned, the majority Panel believes that the Domain Name in this case falls into a very different category from cases involving the "unadorned" use of a trade mark (e.g. <toshiba.co.uk>), where Internet users may be presumed to believe that the name belongs to or is authorised by the complainant. In this case, two extra hyphenated words turn the domain name as a whole into a rather clear description of the main goods on offer at the website (replacement batteries for Toshiba laptop computers). In addition, this lengthy "adornment" may reasonably be seen as atypical of the usage of major rights owners, who are free to use much shorter unadorned names.

In the view of the remaining panellist, it is not necessary to pass such a severe test in order to demonstrate "initial interest confusion". As the DRS Expert Overview (available on the Nominet website at [http://www.nic.uk/digitalAssets/39192\\_DRS\\_Expert\\_Overview.pdf](http://www.nic.uk/digitalAssets/39192_DRS_Expert_Overview.pdf)) states at section 3.3, "Findings of Abusive Registration in this context are most likely to be made where the domain name in issue is identical to the name or mark of the Complainant and without any adornment (other than the generic domain suffix)." Nevertheless, "the activities of typosquatters are generally condemned...as are those people who attach as appendages to the Complainant's name or mark a word appropriate to the Complainant's field of activity. See for example the Appeal decision in DRS 00248 (seiko-shop.co.uk)."

- 6.27 I am similarly unconvinced that anyone searching for the Barclays' own PPI reclaim service would type "barclaycard-ppi-reclaim.co.uk" into a browser. It is far more likely that the internet user would come across the Domain Name and the Respondent's website through a search engine, whether that be through an organic or sponsored result or an advertisement. But, the difficulty I face is that there is no argument before me on this point, and no evidence has been offered as to how the public might perceive the Domain Name and/or what form any sponsored results or advertisement might take. Similarly, there is no argument before me as to whether the majority or minority positions in the Toshiba case are to be preferred.
- 6.28 However, ultimately, I do not need to consider these issues further. The reason is that regardless of whether there is or has been impermissible initial interest confusion, I am on balance persuaded by the Complainant's argument that the Respondent has engaged in a more fundamental unfair impersonation of the Complainant.

- 6.29 First, there is the prominent reproduction of the Logo and the BARCLAYCARD mark at the top of the web page. The immediate impression this gives is that this is a web page that is authorised or controlled by the Complainant. Further, the Logo and mark are presented in an almost identical fashion to the page on the Complainant's website that describes how to make a PPI related claim. The Complainant contends that the reproduction of the logo involves copyright infringement. That may or may not be correct, but what is important here is not whether there is infringement, but the likely impact of the use of that Logo on someone who reaches the webpage. Further, whilst it may be necessary to use the BARCLAYCARD mark to identify the nature of the Respondent's services, the same cannot be said of the use of the Logo.
- 6.30 Second, who is actually behind the website is not at all clear from the text on the webpage itself. This is predominantly directed to the question of who can make a claim and the presentation of the "claim application" form.
- 6.31 I accept that at the very bottom of the page there are references to "My Claim Solved Ltd", but the text is tiny in comparison to the rest of the website (and in particular the size of the Complainant's Logo and mark) and is also presented in a less than easy to read grey font. Elsewhere on the page there is a more prominent reference to a "No Win No Fee Claims Service" and the statement that "A claim becomes valid from the date of receipt of an acceptable offer from Barclaycard". Perhaps that text might be said to flag up to someone reading it that this is unlikely to be a service offered by Barclays. Nevertheless, the overall impression one gets, is that the operator of the site has deliberately designed the site to maximise the reference to the Complainant's marks and to minimise any reference to who is actually operating the web page.
- 6.32 More recently, a disclaimer has been added to the bottom of the web page. But the text is still not that prominent in comparison to the rest of the page. Also the fact that the Respondent has chosen to add this disclaimer at all, indicates that the Respondent accepts that a serious risk of confusion otherwise exists.
- 6.33 In the Toshiba case the Appeal panel considered the approach generally adopted by the UDRP as instructive to the analysis of whether and when the use of another's trade mark in a domain name is legitimate (although recognising that care must be taken in doing so because the tests under the UDRP are different from those under the Policy). It referred in this respect to the four criteria first laid down in the decision in *Oki Data America -v- ASD* WIPO Case No. D2001-0903 before such use is legitimate. The third of these criteria was described as

"the site must accurately disclose the respondent's relationship with the trade mark owner (i.e. must not falsely claim to be an official site)"



In fact, a somewhat better description of this requirement is that the site must accurately and prominently disclose the respondent's relationship with the trade mark owner<sup>2</sup>. So far as the website operating from the Domain Name is concerned, the disclosure is in my view insufficiently prominent.

- 6.34 I appreciate that the Respondent contends that there “has been no single occasion of confusion on the part of any member of the general public in relation to our client’s domain name but in fact the specific design of that domain name ensures that any risk of confusion is not existent”, but it is not at all clear what this actually means. Is this a denial that anyone has ever complained that the website did not make it clear that the person operating it was not Barclays?
- 6.35 Even if that statement should be read that way (and leaving aside the fact that this is an assertion of fact unsubstantiated with statement of truth), I do not think this is determinative. I am simply in no position to judge whether an absence of this sort of complaint is significant given that the Domain Name was only registered a few months prior to the commencement of these proceedings and no information is offered as to (a) the extent of the activity through the website. (b) how long it takes to process a claim and for the claimant to receive payment, (c) whether and at what stage who is actually running the claim is made clearer to the Claimant; and (d) why it is at that stage someone who might initially have been fooled as to who it is who is behind the site would bother to complain.
- 6.36 In the circumstances, the most compelling evidence I have on the question of impersonation is the web page itself. Given that evidence I find on the balance of probabilities that the Domain Name is in the hands of the Respondent an Abusive Registration.
- 6.37 In reaching that conclusion, I also note that the “look and feel” of the Respondent’s site appears to have been an important (if not a determinative) factor in the expert’s decision in favour of the complainant in DRS 11286 (see paragraph 6.23 of that decision set out above).
- 6.38 Accordingly, the Complainant has made out the requirements of paragraph 2(a)(ii) of the Policy.
- 6.39 Finally, for the sake of completeness I note that the Complainant also relies upon the fact that the Domain Name was registered during the mediation process in case DRS 11478. No explanation is offered by the Respondent as to why he chose to register the Domain Name at that time. In the absence of any explanation, the obvious inference is that the Respondent was determined to continue his activities under a similar domain name if those proceedings did not go his way. It is a point that may be of

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<sup>2</sup> See paragraph 2.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition accessible online at <http://www.wipo.int/amc/en/domains/search/overview2.0/>

significance in future proceedings against the Respondent, particularly given that the presumption set out in paragraph 3c of the Policy is now likely to apply. However, the timing of the registration it is not something that I have relied upon in coming to my decision in this case.

## **7. Decision**

- 7.1 I find that the Complainant has Rights in a trade mark, which is similar to the Domain Name, and that the Domain Name, in the hands of the Respondent, is an Abusive Registration.
- 7.2 I, therefore, determine that the Domain Name be transferred to the Complainant.

**Signed: Matthew Harris**

**Dated 3<sup>rd</sup> April 2013**