

**DISPUTE RESOLUTION SERVICE**

**DRS9405**

**Decision of Independent Expert**

Barclays PLC

and

Mr Iain Hair

**1. The Parties:**

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

Complainant: Barclays PLC  
United Kingdom

Respondent: Mr Iain Hair  
6 Eastgreen  
Runhall  
Norwich  
Norfolk  
NR9 4DW  
United Kingdom

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

barclays.org.uk

### **3. Procedural History:**

20 December 2010 18:39 Dispute received  
21 December 2010 10:16 Complaint validated  
21 December 2010 10:18 Notification of complaint sent to parties  
10 January 2011 13:02 Response received  
10 January 2011 13:03 Notification of response sent to parties  
18 January 2011 08:36 Reply received  
21 January 2011 11:54 Notification of reply sent to parties  
21 January 2011 11:54 Mediator appointed  
21 January 2011 11:55 Mediation started  
28 January 2011 13:11 Mediation started  
09 February 2011 09:28 Mediation failed  
09 February 2011 09:41 Close of mediation documents sent  
16 February 2011 11:57 Expert decision payment received

### **4. Factual Background**

The Complainant is a major international bank and provider of financial services. It is the proprietor of various trademarks using its trading name, and is the registrant of a number of domain names incorporating its trademark, including barclays.co.uk (registered prior to 1996) and barclays.com (registered November 2003).

The Respondent is the registrant of the Domain Name (registered August 2002).

The undersigned, Peter Davies, was asked to provide a full Expert Decision On 18 February 2011 and agreed to do so, certifying that he was independent of the Parties and knew of no facts which might call his impartiality into question. The Expert's appointment was confirmed on 2 March 2011.

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

#### **5.1 Complainant**

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

In support of its claim to have Rights in the Domain Name, the Complainant makes the following submissions:

a. The Complainant is a financial services provider engaged in retail banking, credit cards, corporate banking, investment

banking, wealth management and investment management services in Europe, the Americas, Africa and Asia.

b. The Complainant has traded as Barclays PLC since 1985. Prior to this as Barclays Bank PLC or Barclays Bank Limited since 1917 and Barclay & Company Limited since 1896. The Complainant currently operates in over 50 countries and employs approximately 144,000 people. The Complainant has more than 48 million customers and clients worldwide.

c. The Complainant has received several banking industry awards and in 2008 was awarded the Business Superbrands status in recognition of quality, reliability and distinction by the Business Superbrands Council and individual business professionals.

d. The Complainant is the registered proprietor of a variety of UK registered and Community registered trade marks in the name BARCLAYS in a range of classes.

e. In addition to its registered trade marks, through its use of the name BARCLAYS over the last 114 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.

f. The Complainant is the registrant of a variety of domain names including [www.barclays.co.uk](http://www.barclays.co.uk) and [www.barclays.com](http://www.barclays.com). [www.barclays.co.uk](http://www.barclays.co.uk) was registered before 1996 and [www.barclays.com](http://www.barclays.com) was registered in November 2003.

### **5.1.2 Abusive Registration**

The Complainant alleges that the Domain Name an Abusive Registration in the hands of the Respondent and makes the following assertions in support of its position:

a. The Domain Name displays a notice that the domain is for sale for £750,000. It is clear that the Domain Name was registered with the intention of taking advantage of the distinctive character and reputation of the Complainant's trade marks and with the intention of resale.

b. The Respondent is not known by the Domain Name.

c. The Respondent is not making a legitimate non-commercial or fair use of the Domain Name. The content found at the Domain Name is an advertisement for the resale of the Domain Name. Such activity does not qualify as non-commercial or fair use.

d. The Respondent is not authorized by the Complainant to register or use any domain name incorporating the Complainant's trade mark.

e. The Complainant's solicitors wrote to the Respondent on 8 June 2010 and again two weeks later advising the Respondent of the Complainant's registered trade marks in the name BARCLAYS and asking for the Domain Name to be transferred to the Complainant. The Respondent replied stating that he would not transfer the Domain Name but was willing to sell it to the Complainant. These exchanges demonstrate that the Respondent was using the Domain Name registration in order to benefit financially from the intended ultimate sale of the Domain Name.

f. Given the widespread use and notoriety of the BARCLAYS mark, the Respondent must have been aware that in registering the Domain Name he was misappropriating the valuable intellectual property of the Complainant.

g. 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.

h. 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.

i. 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.

## **5.2 Respondent**

In his Response, the Respondent makes certain points which directly address matters raised in the Complaint, and then

elects to reproduce his exchange of correspondence with the Complainant which sets out additional arguments. In the interests of providing a standard format summarising the Respondent's case, points raised in correspondence with the Complainant have been incorporated into his Response as follows:

**5.2.1** The Respondent denies that his registration of the Domain Name is an Abusive Registration, and makes the following assertions in support of his position:

a. The Respondent was trying to set up as a domain name dealer and purchased the Domain Name on the open market. He also purchased other domain names including, inter alia

bmw.org.uk  
freetricity.co.uk  
vanman.me  
toyota.org.uk  
cheapcars.org.uk  
morgagehelp.co.uk  
internetmortgage.co.uk  
land-rover.me.uk

b. The Respondent understands that the Complainant wants the Domain Name, but does not understand why the Complainant will not discuss buying it from him. The Respondent's delay in replying to the Complainant's initial letter arose from a change of address and not from unwillingness to negotiate the sale of the Domain Name.

c. The Respondent bought the Domain Name on the open market with no restrictions. It was initially set up with email forwarding but this was soon switched it off as the Respondent was constantly getting emails from Barclays Bank customers.

d. A few years ago an attempt to sell the Domain Name on eBay met with resistance from the Complainant, who argued that the Respondent had no right to sell the Domain Name and if it was sold, it was illegal to sell it for a profit. The Respondent spoke with Nominet and was informed that he was within his rights to do what he wanted with the Domain Name and at whatever price so long as he was not pretending to be any one else. There are hundreds of domain names for sale not just on eBay but also with dedicated domain sellers

and re-sellers. The Complainant had no right to pressurise eBay into removing the listing.

e. The Respondent also owns, among others, toyota.org.uk and bmw.org.uk and has at no time pretended to be involved with any of these companies.

f. The following domain names have been sold

1. Insure.com, sold to QuinStreet for \$16 million in 2009.
2. Sex.com, sold for \$12-\$14 million in 2006.
3. Fund.com, sold for \$9.99 million in 2008.
4. Porn.com, sold for \$9.5 million in 2007.
5. Business.com, sold for \$7.5 million in 1999.
6. Diamond.com, sold to Ice.com for \$7.5 million in 2006.
7. Beer.com, sold for \$7 million in 2004.
8. Israel.com, sold for \$5.88 million in 2004.
9. Casino.com, sold for \$5.5 million in 2003.
10. Toys.com, sold to Toys 'R Us for \$5.1 million in 2009.

It can be seen from this list that the price of a domain name is not restricted to the initial purchase price. If the Complainant is willing to buy the Domain Name then the Respondent would be more than happy to talk with them.

g. The Domain Name was purchased in August 2002 on the open market in good faith and has not been used in any illegal or immoral way nor with any suggestion that it has anything to do with the Complainant. In fact it has not been used at all, only to advertise that it is for sale. In 8 years it has not been a problem. The Complainant could have bought it when it was available, but the Respondent can't be held responsible if the Complainant did not do its job properly. The Respondent is willing to sell the Domain Name if the Complainant wishes to buy, but will not be bullied into giving it away.

h. The Respondent has, without success, requested the Complainant to identify someone in its organization who can make a purchasing decision in respect of the Domain Name.

i. The Complainant is trying to reverse domain name hijack the Domain Name and using their powerful influence to do so.

j. Section 4 (d) of the DRS Policy states that it is lawful to trade in domain names and that is what is being done. At no time has the Respondent used the Domain Name for any

other reason than trying to sell it. The value is wholly dependant on what someone is willing to pay.

k. There are many other companies listed at companies house starting with Barclays so there has not been any intention of trading off the back of Barclays Bank.

### **5.3 Complainant's Reply**

The Complainant exercised its right to reply to the Response from the Respondent, and makes the following submissions:

a. The Respondent confirms that he bought the Domain Name with the sole intention of selling it. The website makes it clear that the Respondent expects to sell the Domain Name for valuable consideration in excess of his out of pocket expenses directly associated with acquiring or using the Domain Name. Such behaviour is indicative of an Abusive Registration in accordance with paragraph 3(a)(i) of the Policy.

b. The Respondent has confirmed that actual confusion has resulted from the registration of the Domain Name, in that internet users looking to contact the Complainant contacted the Respondent through the Domain Name in error. In his Response the Respondent notes:

*"I was constantly getting emails from Barclays Bank customers."*

This indicates that the Respondent is using the Domain Name in a way which causes confusion and leads the public to believe that the Domain Name is registered to, operated by or associated with or otherwise connected to the Complainant. Such circumstances are indicative of an Abusive Registration in accordance with paragraph 3(a)(ii) of the Policy.

c. The Respondent confirmed that he has registered other domain names, three of which, [bmw.org.uk](http://bmw.org.uk), [toyota.org.uk](http://toyota.org.uk) and [land-rover.me.uk](http://land-rover.me.uk) correspond to well known names or trade names in which it is reasonably anticipated that the Respondent has no apparent rights. These registrations and the registration of the Domain Name indicate that the Respondent is engaged in a pattern of registrations of domain names in which he has no apparent rights. Such behaviour is indicative of an Abusive Registration in accordance with paragraph 3(a)(iii) of the Policy.

d. The Respondent stated that Nominet advised him of his right to do *"what he wanted with the domain name and at whatever price so long as [he] was not pretending to be anyone else."* The Respondent has not filed evidence to support this claim. Nor has the Respondent filed evidence to detail his alleged exchange with the Complainant concerning the Respondent's offer of the Domain Name for sale on eBay.

e. The Respondent argues that trading in domain names is lawful. The Complainant accepts that in certain circumstances trading in domain names may be lawful. It is not lawful to trade in a domain name which infringes a third party's registered trade mark rights and any attempt to trade in a domain name in which a third party has rights and is an Abusive Registration will be subject to Nominet dispute resolution proceedings.

f. The Respondent has noted various domain names which have been sold in the past. These domain names are all generic in nature and none includes a trading name or a well known name of any third party. They cannot be compared to the Domain Name which includes the Complainant's registered trade mark. It would be inappropriate to speculate what the circumstances may be as there may be various reasons why the generic domain names were sold and why they were sold for the price which was paid. The sale of the generic domain names is not relevant to the current case.

g. The Respondent is not making legitimate non-commercial or fair use of the Domain Name. The Respondent shows no preparations to use the Domain Name for a genuine offering of goods or services, and his sole purpose, based on the Response, is to sell the Domain Name to either the Complainant or to another third party which may be a competitor of the Complainant. This behaviour is contrary to paragraph 3 of the Policy.

h. Given the widespread use, reputation and notoriety of the BARCLAYS mark, the Respondent must have been aware that in registering the Domain Name he was misappropriating the Complainant's intellectual property rights.

## **6. Discussions and Findings**

### **6.1 General**

In order to succeed in these proceedings, paragraph 2.b of the DRS Policy requires the Complainant to prove on the balance of probabilities that both elements of the test set out in paragraph 2.a are present, namely that:

*i. the Complainant has Rights in respect of names or marks which are identical or similar to the Domain Name; and*

*ii. the Domain Name, in the hands of the Respondent, is an Abusive Registration.*

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

The Complainant has submitted evidence, which the Expert accepts, that the Complainant has Rights in a name which is identical to the substantive portion of the Domain Name. The Respondent does not address the issue of these Rights, except to argue that they do not extend to interfering with his use of the Domain Name, bought it in good faith and (the Respondent asserts) not circumscribed in any way, save for the need to avoid deception of the public. The Respondent says that Nominet advised him, at the time of his attempted sale of the Domain Name on eBay, *"that he was within his rights to do what he wanted with the Domain Name and at whatever price so long as he was not pretending to be anyone else."* If fully and accurately reported by the Respondent, this advice would have been misleadingly incomplete. As it is, no evidence of the reference to Nominet, nor even a date, is provided to allow an informed assessment of what advice was given and in what words. Consequently, the Respondent's case is not helped by this claim.

In any event, it is clear that registering a domain name incorporating a third party's trademark inevitably involves limitations upon the freedom of action to be enjoyed by the registrant. The market in domain names is not as free as the Respondent assumes, as he seeks to show that they can change hands at elevated prices, dictated solely by market forces. It must be apparent that domain names such as those quoted by the Respondent have high market value precisely because, being generic, they run few risks of infringing third party rights. The Respondent's arguments on this count cannot succeed and accordingly I find that the Complainant has Rights for the purpose of bringing this Complaint in accordance with Paragraph 1 of the DRS Policy.

### **6.3 Abusive Registration**

Paragraph 3 of the DRS Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. Included in this list are:

- 3 a.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;*

The Complainant relies upon these and other grounds to show that the Domain Name is an Abusive Registration. The Complainant submits additionally that

- the registration gives rise to confusion on the part of the public, contrary to Paragraph 3a.ii of the Policy
- the Respondent is engaged in a pattern of registrations of domain names in which he has no apparent rights, contrary to Paragraph 3.a.iii of the Policy;
- the Respondent has made no use or preparations for use of the Domain Name in any permissible setting, as foreseen in Paragraph 4 a.i.A of the Policy;

Paragraph 4 of the DRS Policy sets out a number of ways in which the Respondent can show that a registration is not abusive. The list is non-exhaustive but the Respondent's submissions do not allow him to take advantage of any of the possible means of rebuttal available. The Respondent refers specifically to Paragraph 4 d. of the Policy which states that

*Trading in domain names for profit, and holding a large portfolio of domain names, are of themselves lawful activities.*

The Respondent relies upon this statement and feels that he has acted within his rights as proprietor of the Domain Name. He points to the fact that the Complainant did not attempt to register the Domain Name when it was available and that he should not be penalised for stepping in and acquiring it. However, Paragraph 4 d does not give carte blanche to

owners of domain names to ignore the rights of third parties. The Complainant is such a third party and it is well established that those with rights in a name are not obliged to register each and every domain name which might conceivably incorporate that name.

Moreover, the Respondent has acquired the Domain Name, with others incorporating the marks of third parties, in full knowledge of their prominence as trading names. It does not seem plausible that he could be unaware of the possible consequences of these registrations. Although there is no evidence of deception or bad faith on the part of the Respondent, he fails to appreciate the constraints within which he must operate in connection with a domain name incorporating the name of a third party.

The heads of complaint set out by the Complainant illustrate different aspects of this misjudgement on the Respondent's part and each of them has merit. Some have more than others, but it is perhaps sufficient to state that the Expert finds that the Respondent, having admitted the same, has registered the Domain Name primarily 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. This action on the part of the Respondent constitutes an Abusive Registration in accordance with Paragraph 3.a.i.A of the DRS Policy.

## **7. Decision**

For the reasons set out above, I find that the Complainant has Rights in a name identical or similar to the Domain Name and that the Domain Name in the hands of the Respondent is an Abusive Registration. The Domain Name should be transferred to the Complainant.

**Signed: Peter Davies**

**Dated: 5 March, 2011**