

# Nominet UK Dispute Resolution Service

DRS 00115

## Barclays Bank plc–v- Game

### Decision of Independent Expert

#### 1 Parties

Complainant: Barclays Bank plc  
Address: 54 Lombard Street  
London  
Postcode: EC3P 3AH  
Country: GB

Respondent: Game  
Address: 2A Aberdeen Walk  
Scarborough  
YO11 1SL  
Country: GB

#### 2 Domain Name

barclaysbank.co.uk (“the Domain Name”)

#### 3 Procedural Background

The Complaint was lodged with Nominet on 20 November 2001. Nominet validated the Complaint and notified the Respondent of the Complaint on 22 November 2001 and informed the Respondent that he had 15 days within which to lodge a Response. The Respondent failed to respond. Mediation not being possible in those circumstances, Nominet informed the Complainant and on 20 December 2001 Nominet received from the Complainant the appropriate fee for a decision of an Expert pursuant to paragraph 6 of the Nominet UK Dispute Resolution Service Policy (“the Policy”).

On 21 December 2001, I, Simon Carne, the undersigned, notified Nominet that I am independent of each of the parties, but that I wished to disclose the circumstances described below as they might be of such a nature as to call into question my independence in the eyes of one or both of the parties. The circumstances in question are that:

I am Chairman of a not-for-profit company, which has one of its bank accounts with Barclays Bank. I have no personal bank accounts with Barclays Bank and no other customer relationships with Barclays.

On 21 December 2001, Nominet passed a copy of my declaration to the Complainant and the Respondent, inviting them to comment no later than 1 pm on 28 December 2001. On 29 December 2001, I received confirmation from Nominet of my appointment.

#### 4 Outstanding Procedural Issues

The Respondent has not submitted a Response to Nominet in time in compliance with paragraph 5a of the Procedure for the conduct of proceedings under the Dispute Resolution Service (“the Procedure”)

which, in this case, was 14 December 2001. The Respondent did, however, reply on 17 December 2001, as follows:

Hi there, I have only just received your email  
2a Aberdeen walk has been demolished for 5 years  
my new office address is 22a Newborough Scarborough, North Yorkshire, YO11 1NA, Eng. UK  
  
whats happening?  
  
regards Adrian

Nominet responded to this email by indicating that the deadline for a response had passed and the Complaint had moved forward to the next stage, at which the Complainant would have the opportunity to request that the matter be referred to an Expert for decision.

The papers sent to me by Nominet also show that, on 22 November 2001, an attempt by Nominet to communicate with the Respondent by email failed. An error message was received from [postmaster@virgin.net](mailto:postmaster@virgin.net) indicating that the user's account was temporarily over quota. On the same day, Nominet sent further emails, both to the Respondent's email address at virgin.net and also to [postmaster@barclaysbank.co.uk](mailto:postmaster@barclaysbank.co.uk). It is clear from the reply cited above (which came from the email address at virgin.net) that the Respondent received at least one of the notifications from Nominet.

Paragraph 15b of the Procedure provides, inter alia, that "If in the absence of exceptional circumstances, a Party does not comply with any time period laid down in this Policy or the Procedure, the Expert will proceed to a Decision on the complaint." Furthermore, paragraph 15c of the Procedure provides that "If, in the absence of exceptional circumstances, a Party does not comply with any provision in the Policy or this Procedure ... , the Expert will draw such inferences from the Party's non-compliance as he or she considers appropriate."

In several previous cases, the Respondent has failed to respond to the notification of the complaint, but the complaint has proceeded to a decision with the Expert drawing such inferences as he considered appropriate. For example, in *xigris.co.uk* (DRS 001), the Expert proceeded to a decision, having observed that:

"... Respondents may fail to respond for a variety of reasons. The reason may simply be that the Respondent has nothing useful to say in his defence, or it may be that he has not received the Complaint, perhaps because he is away and not in email contact or perhaps because he has not kept his contact details with Nominet up-to-date."

In this case, I do not consider either the Respondent's statement on 17 December 2001 that he had "only just received [Nominet's] email" or the statement that he had changed postal address some years previously to amount to a plea of exceptional circumstances. Accordingly, I will now proceed to a Decision on the Complaint, in the absence of a response, drawing such inferences from the Respondent's non-reply as I consider appropriate.

## **5 The Parties**

The Complainant is part of a UK-based financial services group, Barclays Plc, engaged primarily in banking, investment banking and investment management. The Complainant has been operating under the Barclays mark for over 100 years and has been operating in many countries over five continents of the world. The Complainant owns registered trade marks for Barclays and Barclays Bank in a variety of countries.

I have little information about the Respondent, other than the name ("Game"), the email addresses and postal addresses referred to above (which may not be current) and the name of the administrative contact, Adrian Hutchison.

On 16 June 1997, the Respondent registered the Domain Name.

## **6 The Parties' Contentions**

### *Complainant*

I set out below relevant extracts from the Complaint in the Complainant's own words. I have added paragraph breaks of my own; this part of the Complaint was submitted in one single paragraph, albeit with numerical subdivision, where I have indicated:

3. *Abusive Registration* Complainant submits that the Domain Name amounts to an Abusive Registration for the following reasons:

3.1 The Respondent has registered the Domain Name primarily for the purpose of selling the Domain Name for a valuable consideration in excess of the Respondent's out of pocket costs of registration [which is one of the non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration] section 3.a.i.A of the Policy.

This contention is evidenced by the web page present at the Domain Name as at 19 November 2001, which states: "Due to retirement this valuable domain is for sale BARCLAYSBANK.CO.UK Please submit all offers to a.game@virgin.net"... Complainant also submits that Respondent is attempting to recover more than his out of pocket costs of registering the Domain Name by placing this statement on the web site requesting offers for his "valuable" Domain Name. It is submitted that, if Respondent were merely looking to recover his out of pocket costs of registering the Domain Name, he would have approached Complainant with such a proposal.

3.2 The Respondent is using the Domain Name in a way which has confused people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant, [which is another of the non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration], section 3.a.ii of the Policy.

This is evidenced by the large number of e-mails received by the Respondent from people who were intending to contact the Complainant....

3.3 The Respondent has registered the Domain Name as a blocking registration against a name or mark in which the Complainant has Rights [which is one of the non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration], section 3.a.i.B of the Policy.

It is submitted that Respondent has no legitimate connection with the BARCLAYS or BARCLAYS BANK names and is not making a legitimate or fair use of the Domain Name.... Complainant has rights in the BARCLAYS and BARCLAYS BANK names and would legitimately desire to register the Domain Name and this would have been obvious to Respondent at the time of registration.

It is submitted that, due to the nature of the Domain Name, there is no legitimate or fair use of the Domain name that could be made by the Respondent without confusing and misleading users or abusing the Complainant's trade mark rights.

The Complainant requested that the Domain Name be transferred.

### *Respondent*

The Respondent has not responded other than as indicated in section 4 of this Decision.

## 7 Discussion and Findings

### *General*

To succeed in this Complaint, the Complainant has to prove, pursuant to paragraph 2 of the Policy, on the balance of probabilities, first, that it has Rights (as defined in paragraph 1 of the Policy) in respect of a name or mark identical or similar to the Domain Name and, secondly, that the Domain Name, in the hands of the Respondent, is an Abusive Registration (as defined in paragraph 1 of the Policy).

### *Complainant's Rights*

In this case the first limb of that task is straightforward. The Complainant is a well-known clearing bank, operating in many high streets throughout the UK and is popularly recognised by the name Barclays and/or Barclays Bank. Even in the absence of the trade mark registrations referred to in section 5 of this Decision, I would have found that the Complainant has Rights in respect of a name or mark, both identical to and similar to the Domain Name.

### *Abusive Registration*

Paragraph 1 of the Policy defines “Abusive Registration” as:

“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.”

Given this definition, it might be considered that a registration in the name of *barcalysbank.co.uk* by a person who has no connection with Barclays Bank is, on the face of it, an Abusive Registration, with the burden resting on the Respondent to show otherwise. For example, in *jacksonstops.co.uk* (DRS 073), the Expert concluded that:

“It is difficult to think of any reason why, if the Respondent wished to advertise its business, it could not have chosen some name which was not the well-known name of another well-known business. In the absence of any explanation from the Respondent I draw the inference that for some reason or other the Domain Name was registered by the Respondent primarily for the purpose of unfairly disrupting the business of the Complainant.”

However, in *fiatvans.co.uk* (DRS 066), the Expert found that, on the facts of that case, the registration was not abusive.

### **The Complainant's submission**

The Complainant has submitted that the registration of the Domain Name by the Respondent was:

- a) “primarily for the purpose of selling the Domain Name for a valuable consideration in excess of the Respondent's out of pocket costs of registration” [paragraph 3.1 of the Complainant's submission];  
*and*
- b) “a blocking registration against a name or mark in which the Complainant has Rights” [paragraph 3.3 of the Complainant's submission].

These two possibilities are mutually exclusive. A Respondent cannot wish both to block the Complainant from registering a name and to sell the registration of that name to him. It is, of course,

possible that the Respondent's behaviour is such that it is not possible to discern which of these two objectives is being pursued because, for example, the Respondent may invite bids for the domain name whilst having no intention to accept any of the offers. The Complainant can, of course, submit both allegations in the alternative. Indeed, the Expert might find that the Respondent's aim is to harm the Complainant in some way, but that the Respondent is indifferent as to whether this is achieved by means of blocking or by extracting a high sales price for the Domain Name, so long as one or other of these aims is achieved.

#### The Paragraph 3(a)(i)A submission

The submission that the Respondent registered the name primarily for the purpose of selling the Domain Name at a price in excess of the Respondent's out of pocket costs of registration is one which I am reluctant to accept without further evidence. Paragraph 3(a)(i)A of the Policy refers expressly to the primary purpose of the respondent *at the time of registering (or otherwise acquiring) the Domain Name*. The Respondent's registration took place in June 1997, some 4½ years prior to the date on which evidence was collected relating to the content of the web site for submission as evidence of the Respondent's intent.

Whilst the list of factors in paragraph 3 is not exhaustive, I consider it significant that the Policy refers to the purpose at the time of registration or acquisition. In my opinion, an individual might legitimately build up the reputation of a web site so that it attracted many visitors and might then seek to sell it as a going concern at its then market price, which could well be considerably above the original cost of registration. In such circumstances, the primary purpose of the registration is to build up a valuable business, which might then be sold at the fair value of that business. The fact, therefore, that an *active* and *longstanding* Domain Name (as in this case) is available for sale at more than its registration cost, is not of itself sufficient to establish that the registration in the hands of its present owner is an Abusive Registration.

#### The Paragraph 3(a)(i)B submission

I find it difficult to infer that the Respondent registered the Domain Name in order to block the Complainant from registering the Domain Name for itself, when, on the Complainant's own evidence, the Domain Name is apparently available for sale and (so far as can be seen from the evidence submitted) the Complainant has made no attempt to purchase it.

As part of its 3(a)(i)A submission, the Complainant argued that there is an obligation on the Respondent to seek out the Complainant and offer the Domain Name in order to rebut the presumption that the registration is abusive. That argument was not repeated by the Complainant in the context of the 3(a)(i)B submission, but if it had been, I would have rejected it given the circumstances identified in the previous paragraph.

If, on the facts of this case as submitted by the Complainant, the Complainant wishes to establish that it is being blocked from registering the Domain Name, when the Domain Name appears to be available to the Complainant to purchase, I should need to see at least some evidence that the invitation to bid for the name is either not genuine or foreclosed to the Complainant.

#### The Paragraph 3(a)(ii) submission

In paragraph 3.2 of the Complainant's submission, the Complainant argues that the Respondent is using the Domain Name in a way which has confused people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant. This is another of the non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration, as set out in section 3(a)(ii) of the Policy.

For this part of its submission, the Complainant relies solely on the matters relating to the email addresses derived from the Domain Name and makes no submission relating to the Respondent's web

site. The evidence and the argument offered in support of this submission is the “large number” of emails (specified as 21 emails) received by the Respondent from people who were intending to contact the Complainant.

The Complainant says that the emails were forwarded by the Respondent to the Complainant under cover of two emails on 1 March 1999 stating: “I have just emptied my mailbox and it seems that some people have got our web addresses mixed up!” and “I have sent some more of the mail that I think is intended for your company.” [As an aside, I note that the 21 emails in question apparently post-date 1 March 1999. It seems that the dates either on the covering emails, or on the forwarded emails, are incorrect, but nothing in my Decision turns on this point.]

What is absent from the Complainant’s submission is any evidence to suggest that the Respondent is “*using the Domain Name in a way which has confused people ...*” [words taken from paragraph 3(a)(ii) of the Policy, emphasis added]. The italicised words are important. To see why, consider the hypothetical example of an individual who writes to someone whose email address is at the domain name (say) jones.co.uk, but mistakenly (and entirely through the sender’s own fault) addresses the email to jonesltd.co.uk.

If both domain names have been registered to companies with Rights in the name “Jones” and there is no (other) reason to suppose that the domain name, jonesltd.co.uk, is abusive, does the sender’s act of misdirecting his email now render jonesltd.co.uk an abusive registration (or jones.co.uk if the sender’s mistake had been the other way around)? Clearly not.

And if someone at jonesltd.co.uk forwards the emails to the intended recipient at jones.co.uk, is that to be taken as acting in a manner likely to confuse people (which is the issue for the purposes of paragraph 3(a)(ii)), or as a helpful act?

If any ulterior motives are to be attached to the forwarding of the emails to the intended recipient, it is more likely to be in connection with a plan to extract an excessive sale price from the recipient (cf paragraph 3(a)(i)A of the Policy), than it is to confuse the sender(s). I have, however, already indicated why I do not consider a case to have been made out under paragraph 3(a)(i)A (see above) and I do not think the emails referred to by the Complainant provide any reason to overturn my conclusion on that issue

In order for the Complainant to sustain an argument under paragraph 3(a)(ii) of the Policy based on emails intended for the Complainant, but sent to the Respondent, it seems to me that the Complainant would need to provide evidence of actions *taken by the Respondent* which created confusion. If, for example, the Respondent’s web-site had a “Contact Us” button, which generated an email addressed to [enquiries@barclaysbank.co.uk](mailto:enquiries@barclaysbank.co.uk), and/or the Respondent had sent out emails from an email address which included the Domain Name and which provided information which might be thought to have been written by the Complainant, that would be evidence of the way in which the respondent was *using* the Domain Name to have confuse people. On the evidence I have before me, that is not the case here.

#### Other matters to consider

In the final sentence of paragraph 3.3 of the Complainant’s submission, the Complainant asserts that:

“... due to the nature of the Domain Name, there is no legitimate or fair use of the Domain name that could be made by the Respondent without confusing and misleading users or abusing the Complainant’s trade mark rights.”

Although this sentence is positioned so that it falls within the material addressing the issue of “blocking”, which I have dismissed as a relevant factor here, I consider that this sentence has merit when read in isolation and should be considered as a separate matter from “blocking”, as follows.

The Domain Name, barclaysbank.co.uk, has been registered by an individual or organisation with no

obvious or apparent Rights in the name “Barclays Bank”, nor has any claim to Rights in the name been asserted by the Respondent. In contrast, the name “Barclays Bank” is clearly associated with the bank operated widely (in the UK and elsewhere) by the Complainant.

The Domain Name is being used to host a web site under the title “UK Shopping”, at which the impression is created (whether accurately or not) that the purchase of goods or services can be transacted.

It is highly likely that some people (not inconsiderable in number) who are looking for the Complainant’s web site might try the Domain Name as a first guess at the likely address. It is also not inconceivable that, at some time or other, the words “barclays bank”, when typed into a search engine, might produce results indicating the web site at the Domain Name in addition to, or in preference to, the Complainant’s web site.

There is every reason to believe that at least some visitors to the Respondent’s site will be confused into thinking that “UK Shopping” is a brand name operated by Barclays. The fact that, by following the link “Go to Bank”, the visitor is taken to a web page which links to Barclays Bank may well reinforce that impression in the minds of some (but probably not all) visitors to the site. The further fact that the page containing the link to Barclays Bank also contains links to other banks may well remove the confusion in the minds of some other visitors to the page, but that will not undo the harm done in respect of those who have been confused. It is also more than probable that some visitors to this page might try one or more of the links to the other banks listed and, thereby, Barclays’ business will have been disrupted.

It is also more than likely that there will be users who, having looked for Barclays Bank at the site and not immediately found it, will nevertheless remain at the site for the purpose of making purchases or carrying on other activities available at the sight. In this way, the Respondent will have taken advantage of the Complainant’s Rights in the name Barclays Bank to secure business for itself.

I conclude, therefore, that the Respondent has used the Domain Name for one or both of the following purposes:

- a) to attract visitors to the web site at the Domain Name, so as to benefit the Respondent’s activities there, which I consider to be taking unfair advantage of the Complainant’s Rights; or
- b) to deflect individuals away from the Barclays Bank web site, which I consider to be unfairly detrimental to the Complainant’s Rights.

Either of these reasons is sufficient, in the absence of a rebuttal (see below), to establish that a registration is an Abusive Registration (see limb (ii) of the definition of Abusive Registration in paragraph 1 of the Policy).

### **The absence of any response from the Respondent**

The Respondent has not provided a response to the Complaint.

Bearing in mind that my reasons for consider the registration to be an Abusive Registration are not based on the specific paragraphs in the Policy which were itemised in the Complainant’s submission, I have to consider whether the Respondent would be disadvantaged were I to proceed to a Decision without first giving the Respondent an opportunity to make a further statement under paragraph 13 of the Procedure.

In my opinion, this is not necessary. I do not consider the flaw(s) in the Complainant’s submission to be so self-evident that the Respondent could have safely dispensed with the need to respond. In the absence of a reply from the Respondent, even if only to deny the alleged reason(s) for registering the Domain Name and/or to challenge the suggestion that the use of the Domain Name had led to any confusion, I think it is fair to conclude that the Respondent would not have replied to the Complainant’s submission had the arguments on which I based my Decision been identified as a separate issue.

Moreover, I consider that, if there is sufficient evidence before the Expert to enable a conclusion to be reached, the Expert is entitled to draw that conclusion, even if neither of the parties has expressly submitted it in argument. Even in the absence, therefore, of the final sentence of paragraph 3.3 of the Complainant's submission, I would have drawn the conclusions set out above under "Other matters to consider". These conclusions follow directly from the evidence submitted; the Respondent should not expect the absence of an expressly stated argument from the Complainant to prevent the Expert from drawing the proper conclusions.

Accordingly, I find that the Domain Name is an Abusive Registration within the definition of that term in paragraph 1 of the Policy, on the basis that it has been used in a manner which took unfair advantage of, or was unfairly detrimental to, the Complainant's Rights.

## **8 Decision**

In light of the foregoing findings, namely that the Complainant has Rights in respect of a name or mark, both identical to, and similar to, the Domain Name and that the Domain name, in the hands of the Respondent, is an Abusive Registration, I direct that the Domain Name, barclaysbank.co.uk, be transferred to the Complainant.

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Simon Carne

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Date