

ADMINISTRATIVE PANEL DECISION

Barclays Bank PLC v. Michail Starush, SeoDep Magic, Viktor Parchenko,
Brigitte Zehnder
Case No. D2022-4139

1. The Parties

The Complainant is Barclays Bank PLC, United Kingdom, represented by Bird & Bird LLP, United Kingdom.

The Respondents are Michail Starush, SeoDep Magic, Republic of Moldova, Viktor Parchenko, Santa Lucia, and Brigitte Zehnder, United States of America.

2. The Domain Names and Registrar(s)

The disputed domain names <barclay.finance>, <barclay-ltd.com>, and <barclay-s.net> are registered with NameSilo, LLC, and the disputed domain names <br-stone.com>, <br-stone.net>, and <br-stone.org> are registered with NameCheap, Inc. (the “Registrars”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 2, 2022. On November 3, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On November 3, 2022, each Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondents (Privacy service provided by Withheld for Privacy ehf, and PrivacyGuardian.org) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 4, 2022 providing the registrant and contact information disclosed by the Registrars, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on November 9, 2022.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on November 17, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 7, 2022. The Respondent transmitted by email communications on November 8, 2022, November 18, 2022, November 30, 2022, and December 6, 2022.

The Complainant submitted supplemental filings on December 8, 2022 and December 16, 2022, which the Panel will disregard.

The Center appointed Wilson Pinheiro Jabur as the sole panelist in this matter on December 9, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant is a wholly owned subsidiary of Barclays PLC, a British multinational banking and financial services company headquartered in London, operating in over 50 countries and territories and counting with approximately 48 million customers. Barclays PLC is the owner of the following, among other (Annex 3 to the amended Complaint), trademark registrations which have been licensed to the Complainant:

- United Kingdom registration No. UK00001286579 for the word mark BARCLAY, filed on October 1, 1986, registered on March 3, 1989, subsequently renewed, in class 36; and

- European Union registration No. 002315554 for the word mark BARCLAYS, filed on July 13, 2001, registered on February 13, 2003, in classes 9, 16, 35, 36, 38, and 42.

The domain names under dispute are the following:

| Disputed domain name | Registration Date | Present use |
|----------------------|-------------------|---------------------------------------|
| <barclay.finance> | January 4, 2022 | Parked webpage with no active content |
| <barclay-ltd.com> | January 4, 2022 | No active webpage |
| <barclay-s.net> | December 17, 2021 | Parked webpage with no active content |
| <br-stone.com> | June 10, 2020 | Online investment platform |
| <br-stone.net> | October 26, 2021 | Online investment platform |
| <br-stone.org> | October 26, 2021 | Parked page stating "FAST PANEL" |

5. Parties' Contentions

A. Complainant

According to the Complainant, the disputed domain names are under common control given that all of the disputed domain names have been used in connection with identical or nearly identical webpages offering investment services reproducing the Complainant's BARCLAY registered trademark, indicating the same contact details and therefore should be dealt with in the same UDRP procedure.

The Complainant asserts to be one of the world's largest financial services providers with operations in retail, wholesale and investment banking, as well as wealth management, mortgage lending and credit cards, being the responsible for Barclays PLC's investment banking, corporate, private and overseas services operations (amongst others), providing products and services for large corporate, wholesale and international banking clients.

Under the Complainant's view, the disputed domain names <barclay.finance>, <barclay-ltd.com> and <barclay-s.net> reproduce the Complainant's trademarks entirely, being the "-ltd" addition and the ".finance" Top-Level Domain ("TLD") elements that further increase the likelihood of confusion with the Complainant's businesses. As to the <br-stone.com>, <br-stone.net> and <br-stone.org>, disputed domain names, the Complainant argues that they contain prominent letters associated with the Complainant's BARCLAY trademark and that the content of the websites associated with these disputed domain names using the same "Barclay Stone" branding with identical or nearly identical content and company details indicate that

they are linked to the same Respondent which may be using the websites for potentially fraudulent purposes.

Regarding the absence of the Respondents' rights or legitimate interests, the Complainant argues that:

- i) to the best of the Complainant's knowledge, the Respondent does not hold any trademarks or other intellectual property rights in respect of any of the Complainant's trademarks;
- ii) the websites to which the disputed domain names resolve consists of pages offering financial services, therefore enhancing the confusion of Internet users; and
- iii) various online reviews have flagged the Respondent's business as scam, amongst which the Financial Commission (an independent self-regulatory organisation and external dispute resolution body dedicated specifically to Forex) states that it "has determined that the indicated company and associated website may be used to scam and defraud traders and investors. As such, the Commission does not recommend doing business with this entity, either individual purporting to represent this broker on social media and in private messages on popular messaging apps. Given this information, Barclay Stone (Barclay Stone LTD) will be placed on the Financial Commission's Warning List". (Annex 5 to the amended Complaint).

As to the registration and use of the disputed domain names in bad faith, the Complainant states that:

- i) the Respondents acquired the disputed domain names for the purpose of unfairly disrupting the business of the Complainant by deceiving customers into believing that the disputed domain names are owned by or associated with the Complainant;
- ii) the fact that the websites associated with the disputed domain names purportedly offer investment services to customers confuses consumers into thinking that the disputed domain names are registered to, operated or authorised by, or otherwise connected with the Complainant, having the disputed domain names clearly been created to deceive customers that they are domains which are connected to the Complainant, leading to potential financial and personal information losses for the Complainant's customers (or potential customers), causing significant disruption to the Complainant, its business and its reputation;
- iii) the Complainant has contacted the Respondent on various occasions since December 2020 regarding various "Barclay Stone" websites, notifying the Respondents of the trademark infringement and requesting that all use of the Complainant's trademarks be immediately ceased, having the Respondent agreed to carry out a re-brand in February 2021 which was promised and then subsequent correspondence delaying the implementation of the rebranding (Annex 6 to the amended Complaint); and
- iv) the Respondents will never be able to use the disputed domain names that reproduce the Complainant's BARCLAY trademark for a legitimate purpose given the ubiquity of the Complainant's trademarks which will lead members of the public into assuming that there would be an association between the Respondents and the Complainant.

B. Respondent

The Respondents replied stating that the negotiations between the Parties to reach a settlement had failed given that the Complainant had insisted on the transfer of the <br-stone.com>, <br-stone.net>, and <br-stone.org> disputed domain names. The Respondents' view on these disputed domain names is that they are not identical or confusingly similar to the Complainant's trademarks BARCLAY or BARCLAYS, that the disputed domain names have never been associated with the Complainant's brand, and that "the necessary changes to the identity and content" of these disputed domain names have been made and therefore should not be considered by the Panel in the present proceeding.

6. Discussion and Findings

Paragraph 4(a) of the Policy sets forth the following three requirements, which have to be met for this Panel to order the transfer of the disputed domain names to the Complainant:

- (i) the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondents have no rights or legitimate interests in respect of the disputed domain names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

The Complainant must prove in this administrative proceeding that each of the aforementioned three elements is present in order to obtain the transfer of the disputed domain names.

Before turning to these questions, however, the Panel needs to address the issue of the consolidation of multiple Respondents.

A. Consolidation of Multiple Respondents

The Complainant requests that this Panel accept the multiple Respondents in a single proceeding in view of the facts enumerated at the section 5.A. above.

The Respondents have not objected to the common control claim and rather indicated full knowledge and control over all of the disputed domain names.

In addition to that, section 4.11.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") establishes that "[w]here a complaint is filed against multiple respondents, panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. Procedural efficiency would also underpin panel consideration of such a consolidation scenario".

All of the aforementioned criteria are present in this case and therefore this Panel accepts such request considering that it would be more procedurally efficient to have the six disputed domain names dealt with in the same proceedings.

This Panel is satisfied, in view of the evidence submitted and on balance that the disputed domain names are indeed subject to a common control and that consolidation would be fair and equitable to all Parties.

B. Identical or Confusingly Similar

The Complainant has established rights over the BARCLAY and BARCLAYS trademarks duly registered.

The disputed domain names <barclay.finance>, <barclay-ltd.com>, and <barclay-s.net> reproduce the Complainant's trademarks entirely, the "ltd" and "-s" hyphen additions in the second and third disputed domain names do not preventing a finding of confusing similarity (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8).

It is well accepted that the first element functions primarily as a standing requirement and that the threshold test for confusing similarity involves a "reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name" ([WIPO Overview 3.0](#), section 1.7).

In what it regards the disputed domain names <br-stone.com>, <br-stone.net>, and <br-stone.org> due to the clear targeting of the Complainant's notorious trademark by the Respondent at the time of the filing of

this Complaint – noting not only the content at the respective websites but also the pattern of six domain names all intending to target the Complainant, the Panel would be prepared to find that these disputed domain names may be considered confusingly similar to the Complainant's trademark for purposes of UDRP standing, but given the finding below as to the third element, a definitive finding here is not necessary.

For the reasons above, the Panel finds that the disputed domain names <barclay.finance>, <barclay-ltd.com>, and <barclay-s.net> are confusingly similar to the Complainant's trademark.

C. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a non-exclusive list of circumstances that may indicate the Respondents' rights or legitimate interests in the disputed domain names. These circumstances are:

(i) before any notice of the dispute, the Respondent's use of, or demonstrable preparations to use, the disputed domain names or a name corresponding to the disputed domain names in connection with a *bona fide* offering of goods or services; or

(ii) the Respondent (as an individual, business, or other organization) have been commonly known by the disputed domain names, in spite of not having acquired trademark or service mark rights; or

(iii) the Respondent is making a legitimate noncommercial or fair use of the disputed domain names, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

According to the evidence submitted by the Complainant, the use made of the disputed domain names at the time of the filing of the Complaint in connection with webpages purportedly offering competing services under the "Barclay Stone" brand clearly points to an attempt to suggest an affiliation with the Complainant which in fact does not exist. Such use does not constitute a *bona fide* offering of goods or services, nor a legitimate noncommercial or fair use of the disputed domain names in these circumstances.

Under these circumstances and absent evidence to the contrary, the Panel finds that the Complainant has met its burden under the second element.

D. Registered and Used in Bad Faith

The Policy indicates in paragraph 4(b)(iv) that bad faith registration and use can be found in respect of a disputed domain name, where a respondent has intentionally attempted to attract, for commercial gain, Internet users to the respondent's website or other online location, by creating a likelihood of confusion with a complainant's mark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on the website or location.

In this case, the registration of the disputed domain names in bad faith can be found pursuant to Policy, paragraph 4(b)(iv) in view of the reproduction of the Complainant's famous trademark at the webpages offering financial services.

Notwithstanding the present use of the disputed domain names – *i.e.*, removing reference to "Barclay Stone" following a "rebrand" by the Respondent, the Panel concludes that such use would still be considered in bad faith in relation to the disputed domain names <barclay.finance>, <barclay-ltd.com>, and <barclay-s.net> which reproduce the Complainant's trademarks entirely and are being used in connection with financial services.

However, in what it relates to the disputed domain names <br-stone.com>, <br-stone.net>, and <br-stone.org> this conclusion as to bad faith use presents a more complicated question since the Respondents have undertaken a nominally different identity, suppressing the reference to the Complainant's BARCLAY trademark and instead using "br-stone" branding; the Panel also notes in this regard the

Complainant's correspondence with the Respondent about potential trademark infringement, and recalls that this would be a matter to take up in a court.

For the reasons above, the Respondent's conduct has to be considered, in the Panel's view, as bad faith registration and use of the disputed domain names <barclay.finance>, <barclay-ltd.com>, and <barclay-s.net> and registration of the disputed domain names <br-stone.com>, <br-stone.net> and <br-stone.org> in bad faith but no present use in bad faith has been shown by the Complainant.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain names <barclay.finance>, <barclay-ltd.com>, and <barclay-s.net> be transferred to the Complainant.

For the foregoing reasons, the Complaint is denied in relation to the disputed domain names <br-stone.com>, <br-stone.net>, and <br-stone.org>.

/Wilson Pinheiro Jabur/

Wilson Pinheiro Jabur

Sole Panelist

Date: December 23, 2022