

## **ADMINISTRATIVE PANEL DECISION**

Barclays Bank PLC v. “Barclays Bank”

Case No. D2023-0185

### **1. The Parties**

The Complainant is Barclays Bank PLC, United Kingdom (“UK”), represented by Bird & Bird LLP, United Kingdom.

The Respondent is “Barclays Bank”, UK.

### **2. The Domain Name and Registrar**

The disputed domain name <barclays-group.ltd> is registered with Eranet International Limited (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 13, 2023. On January 16, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 17, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details. The Center sent an email communication to the Complainant on January 17, 2023, providing the registrant and further contact information disclosed by the Registrar.

The Center verified that the 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 January 18, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 7, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 8, 2023.

The Center appointed Ian Blackshaw as the sole panelist in this matter on February 14, 2023. 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 British multinational banking and financial services company headquartered in London and 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, with many different entities included within the Barclays group.

The Complainant has operations in over 50 countries and territories and has approximately 48 million customers.

The Complainant, therefore, has a substantial worldwide reputation for banking and financial services both overseas and in the UK.

The Complainant is the licensee of numerous registered trademarks in a range of classes throughout the world containing or incorporating the name BARCLAY and BARCLAYS including the following:

- UK Trademarks for BARCLAY and BARCLAYS, registered on March 3, 1989 (no. UK00001286579);
- UK Trademark for BARCLAYS, registered on January 11, 2008 (no. UK00002461096);
- UK Trademark for BARCLAYS, registered on September 21, 2012 (no. UK00002621974);
- European Union Trademark for BARCLAYS, registered on February 13, 2003 (no. 002315554)
- European Union Trademark for BARCLAYS, registered on October 11, 2012 (no. 010890366)
- European Union Trademark for BARCLAYS, registered on October 11, 2012 (no. 010890309); and
- European Union Trademark for BARCLAYS, registered on October 12, 2012 (no. 010890473)

(the "Complainant's Trademarks").

All of the Complainant's Trademarks cover a variety of financial services.

Copies of print outs from the official trademark register in respect of all the Complainant's Trademarks have been provided to the Panel.

All the Complainant's Trademarks were registered before the disputed domain name, which was registered on September 6, 2022.

The disputed domain name does not resolve to an active web page.

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

##### **A. Complainant**

The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant makes the following assertions.

The disputed domain name contains the string "barclays" and, therefore, uses the Complainant's Trademarks to create a domain name very similar to many of the Complainant's official domains, including: <barclays.co.uk> and <home.barclays>.

Such use of the Complainant's Trademarks in the disputed domain name increases the likelihood that visitors will infer that the disputed domain name is owned by the Complainant.

Furthermore, the disputed domain name contains the string "group", which, when taken together with "barclays", makes a phrase which is commonly used to refer to a collection of corporate entities that are

related and function together as a business. The inclusion of the word “group” in the disputed domain name suggests that the disputed domain name hosts content relevant to a variety of legal entities within the wider corporate structure of the Complainant.

The disputed domain name must, therefore, be considered identical or confusingly similar to the Complainant’s Trademarks.

The page to which the disputed domain name currently resolves indicates that the “Host is not resolvable”. A copy of a screenshot of this page, as captured on December 29, 2022, has been provided to the Panel.

Notwithstanding that the disputed domain name does not, at present, appear to resolve to active content, the Complainant has reason to believe that the Respondent may already be using the website for potentially fraudulent purposes, for example, phishing purposes leading to potential financial or personal information loss, which would cause significant damage to the Complainant’s business and reputation.

In support of this contention, the Complainants rely upon Internet searches conducted by the Complainant’s representatives which identify that, as of December 29, 2022, the disputed domain name has active MX and SPF records, which indicate that it is possible for emails to be sent and received from the disputed domain name. In particular, the SPF record indicates a strong likelihood that mail is being sent, as an SPF record is typically set up so that mail servers receiving emails from accounts associated with the disputed domain name will not reject the emails or class them as spam. A copy of the screenshot showing the results of the MX and SPF record searches undertaken on December 29, 2022 has been provided to the Panel.

The Respondent has no rights or legitimate interests in respect of the disputed domain name.

To the best of the Complainant’s knowledge, the Respondent is not known by the disputed domain name, nor does the Respondent hold any trademarks or other intellectual property rights in respect of any of the Complainant’s Trademarks.

The page to which the disputed domain name currently resolves indicates that the “Host is not resolvable” and contains no substantive content. However, even if the disputed domain name, once active, contained content entirely unrelated to financial services, the disputed domain name would, at the very least, cause initial interest confusion because users of the website would, based on the domain name alone, be visiting the website in the expectation that it is an official website of the Complainant and the user is likely to be a potential customer looking for financial services.

It is not clear how the Respondent could make use of the disputed domain name for a legitimate purpose. Given that the disputed domain name incorporates the Complainant’s Trademarks in full and without any other distinctive element, the disputed domain name is such that it could never be used for a legitimate purpose by any party other than the Complainant. Any such third-party use would inevitably confuse visitors into believing that the disputed domain name is registered to, operated or authorised by, or otherwise connected with the Complainant. There is, therefore, a serious reputational and financial risk to the Complainant as well as to the Complainant’s customers.

The Respondent, therefore, has no legitimate interests in respect of the disputed domain name.

The disputed domain name was registered and is being used in bad faith.

For the reasons set out below, the Respondent has registered and is using the disputed domain name in bad faith.

It is plain that the Respondent acquired the disputed domain name for the purpose of unfairly disrupting the business of the Complainant by deceiving customers into believing that the disputed domain name is owned by or associated with the Complainant. The disputed domain name indicates that the website is associated with the “Barclays Group”, confusing consumers into thinking that the disputed domain name is registered to,

operated or authorised by, or otherwise connected with the Complainant. The disputed domain name has clearly been created to deceive customers that it is a website which is connected to the Complainant, leading to potential financial and personal information losses for the Complainant's customers (or potential customers), which would cause significant disruption to the Complainant, its business and its reputation. This is further evidenced by the WhoIs registrant details which list the Registrant Organization as "Barclays Bank", despite the Respondent having no apparent connection to the Complainant's business. Given the strong reputation of the Complainant's Trademarks, the Respondent must have been aware that, in registering the disputed domain name, they were misappropriating the valuable intellectual property of the Complainant's Trademarks.

Furthermore, the Respondent has registered and, from the MX and SPF records, is likely already to be using the disputed domain name in bad faith, because any mail that is sent from an email address containing the string "barclays-group" is very likely to have been done with the intention of confusing visitors to the disputed domain name, for commercial gain, by creating a likelihood of confusion with the Complainant's Trademarks and/or website. Any use by the Respondent of the disputed domain name, including the sending of mail from email addresses associated with the disputed domain name, would, at the very least, cause initial interest confusion because a user of the website or a recipient of an email sent from an account associated with the disputed domain name would, based on the disputed domain name alone, have an expectation that it is an official website of the Complainant, irrespective of whether the user is subsequently disabused of that notion or not.

The Respondent's registration of the disputed domain name has also prevented the Complainant from registering a domain name which corresponds to the Complainant's Trademarks contrary to paragraph 4(b)(ii) of the Policy.

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 Trademarks in breach of paragraph 4(b)(iv) of the Policy.

The Respondent will never be capable of using the disputed domain name for a legitimate purpose as the ubiquity of the Complainant's Trademarks is such that members of the public will always assume there is an association between the Respondent and the Complainant.

## **B. Respondent**

The Respondent, having been duly notified of the Complaint and of these proceedings, did not reply to the Complainant's contentions or take any part in these proceedings.

## **6. Discussion and Findings**

To qualify for cancellation or transfer of the disputed domain name, the Complainant must prove each of the following elements of paragraph 4(a) of the Policy, namely:

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

In accordance with paragraph 15(a) of the Rules, the Panel shall decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules, and any rules and principles of law that it deems applicable.

In accordance with paragraph 14(a) of the Rules, in the event that a party, in the absence of exceptional circumstances, does not comply with any of the time periods established by the Rules or the Panel, the Panel shall proceed to a decision on the Complaint; and under paragraph 14(b) of the Rules, if a party, in the absence of exceptional circumstances, does not comply with any provision of, or requirement under, the Rules or any request from the Panel, the Panel shall draw such inferences as it considers appropriate.

In accordance with paragraph 10(d) of the Rules, the Panel shall determine the admissibility, relevance, materiality and weight of the evidence.

In previous UDRP decisions in which the respondents failed to file a response, the panels' decisions were based upon the complainants' reasonable assertions and evidence, as well as inferences drawn from the respondents' failure to reply. See *The Vanguard Group, Inc. v. Lorna Kang*, WIPO Case No. [D2002-1064](#); and *Köstritzer Schwarzbierbrauerei v. Macros-Telekom Corp.*, WIPO Case No. [D2001-0936](#).

Nevertheless, the Panel must not decide in the Complainant's favor solely based on the Respondent's default. See *Cortefiel, S.A. v. Miguel García Quintas*, WIPO Case No. [D2000-0140](#).

In the present case, the Panel must decide whether the Complainant has introduced elements of proof, which allow the Panel to conclude that its allegations are true.

#### **A. Identical or Confusingly Similar**

It is well established in previous UDRP decisions that, where the disputed domain name incorporates a complainant's registered trademark, this may be sufficient to establish that the disputed domain name is identical or confusingly similar for the purposes of the Policy. See *Magnum Piering, Inc. v. The Mudjacks and Garwood S. Wilson, Sr.*, WIPO Case No. [D2000-1525](#).

In the present case, the disputed domain name essentially incorporates the Complainant's Trademarks, and this makes the disputed domain name confusingly similar to the well-known and widely-used Complainant's Trademarks.

The addition of a hyphen and the word "group" in the disputed domain name does not prevent a finding of confusing similarity between the Complainant's Trademarks and the disputed domain name. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8.

Furthermore, the addition of the gTLD ".ltd" is also irrelevant in determining whether the disputed domain name is confusingly similar to the well-known and widely-used Complainant's Trademarks; this being a standard registration requirement of domain names. See *Blue Sky Software Corp. v. Digital Sierra Inc. and Abdullah Khan*, WIPO Case No. [D2000-0165](#).

In view of the above, the Panel finds that the disputed domain name is confusingly similar to the well-known and widely-used Complainant's Trademarks, in which the Complainant has demonstrated, to the satisfaction of the Panel, prior rights in and prior commercial use of them.

The first element of the Policy, therefore, has been met.

#### **B. Rights or Legitimate Interests**

In order to determine whether the Respondent has any rights or legitimate interests in respect of the disputed domain name (paragraph 4(c) of the Policy), attention must be paid to any of the following circumstances, in particular, but without limitation:

- whether there is any evidence of the Respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services before any notice to the Respondent of the dispute;
- whether the Respondent (as an individual, business, or other organization) has been commonly known by the disputed domain name, even if the Respondent has acquired no trademark or service mark rights;
- whether the Respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

There is no evidence before the Panel to show that the Respondent was acting in pursuance of any rights or legitimate interests with respect to the disputed domain name. On the contrary, if the Respondent had any such rights or legitimate interests, the Respondent would have reasonably been expected to assert them, which the Respondent clearly has not done so, by not replying to the Complaint or taking any part in these proceedings. See *Belupo d.d. v. WACHEM d.o.o.*, WIPO Case No. [D2004-0110](#).

There is also no evidence before the Panel that the Respondent has been authorized or licensed by the Complainant to use the well-known and widely-used Complainant's Trademarks. In fact, in the view of the Panel, the adoption by the Respondent of a domain name confusingly similar to the well-known and widely-used Complainant's Trademarks, which the Panel considers, as asserted above by the Complainant, would appear not to be by mere chance but by design, inevitably leads to confusion on the part of Internet users and consumers seeking information about the Complainant and its banking and financial services.

Further, the Panel finds that the Respondent is consequentially trading unfairly on the well-known and widely-used Complainant's Trademarks and also the valuable goodwill that the Complainant has established in them through the Complainant's prior commercial use, without any rights or justification for doing so.

Also, the Panel finds no evidence that the Respondent has used or undertaken any demonstrable preparations to use the disputed domain name in connection with any *bona fide* offering of goods or services. The use of the confusingly similar disputed domain name which resolves to a page which indicates "Host is not resolvable" does not constitute a *bona fide* offering of goods or services.

Additionally, the use of the Complainant's name to register the disputed domain name as evidenced by the WhoIs, falsely suggests affiliation with the Complainant and points to an intention to confuse Internet users by leading them to think that the disputed domain name belongs to the Complainant or to one of the Complainant's group of companies. The Respondent did not provide any explanation whatsoever for the registration of the disputed domain name, and likewise, no evidence has been adduced that the Respondent has been commonly known by the disputed domain name or by the name "Barclays Bank"; nor, for the reasons mentioned above, is the Respondent making a legitimate noncommercial or fair use of the disputed domain name.

The Complainant has put forward a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, which has not been rebutted by the Respondent. Therefore, for all the above reasons, the Panel concludes that the Respondent has neither rights nor legitimate interests in the disputed domain name.

### **C. Registered and Used in Bad Faith**

Regarding the bad faith requirement, paragraph 4(b) of the Policy lists four examples of acts, which constitute *prima facie* evidence of bad faith. However, this list is not exhaustive, but merely illustrative. See *Nova Banka v. Iris*, WIPO Case No. [D2003-0366](#).

Paragraph 4(b)(iv) of the Policy is particularly relevant to the present case and provides that there is evidence of bad faith in the following circumstances:

“(iv) by using the domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [its] website or other on-line location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of [the respondent’s] web site or location or of a product or service on [its] web site or location.”

Based on the evidence provided on the record, the Panel considers that the Respondent, by registering the disputed domain name confusingly similar to the well-known and widely-used Complainant’s Trademarks, is trading unfairly on the Complainant’s valuable goodwill established in them.

Also, the effect of such conduct on the part of the Respondent is to mislead Internet users and consumers into thinking that the Respondent is, in some way or another, connected to, sponsored by, or affiliated with the Complainant and its banking and financial services; or that the Respondent’s activities are approved or endorsed by the Complainant. None of which the Panel can find, on the basis of the evidence provided on the record, is, in fact, the situation. Such misleading consequences, in the view of the Panel, are indicative of bad faith on the part of the Respondent. See *Columbia Insurance Company v. Pampered Gourmet*, WIPO Case No. [D2004-0649](#).

Again, in the absence of any explanation to the contrary by the Respondent, of which none is forthcoming on the record, the Panel agrees with the Complainant’s contention that the Respondent did not register and use the disputed domain name by chance; but, as noted above, the Respondent used the Complainant’s name to register the disputed domain name and hence, the Respondent appears to have been fully aware of the notoriety of the Complainant and its worldwide banking and financial services, as well as the well-known and widely-used Complainant’s Trademarks and its prior commercial use of them.

The Panel also agrees with the Complainant’s contention, mentioned and for the reason stated above, that the registration and use of the disputed domain name by the Respondent is contrary to the provisions of paragraph 4(b)(ii) of the Policy.

Furthermore, the use of the confusingly similar disputed domain name to resolve to a page which indicates “Host is not resolvable”, as described above by the Complainant and supported by evidence provided by the Complainant to the Panel, constitutes bad faith within the context of paragraph 4(b)(iv) of the Policy.

Finally, the failure of the Respondent to answer the Complaint or take any part in the present proceedings, again, in the view of the Panel and under the circumstance of this case, is another indication of bad faith on the part of the Respondent. See *Bayerische Motoren Werke AG v. (This Domain is For Sale) Joshuathan Investments, Inc.*, WIPO Case No. [D2002-0787](#).

Therefore, taking all these particular facts and circumstances into account, and for all the above-mentioned reasons, as well as the arguments advanced by the Complainant in its contentions, as set out above, and also based on the previous UDRP cases cited above, the Panel concludes that the Respondent has registered and is using the disputed domain name in bad faith.

## **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 name, <barclays-group.ltd>, be transferred to the Complainant.

*/Ian Blackshaw/*

**Ian Blackshaw**

Sole Panelist

Date: February 20, 2023