



दिल्ली DELHI

ARBITRATION CASE NO.3 /2009

R 914315

IN THE ARBITRATION MATTER OF:-

BARCLAYS BANK PLC.COMPLAINANT

VERSUS

FACEIDEA LIMITED.RESPONDENT

AWARD

The present dispute relates to the registration of the domain name <barclayscard.in> in favour of the Respondent.

The Complainant has filed the instant complaint challenging the registration of the domain name <barclayscard.in> in favour of the respondent. The Complainant has contended that it is in the business of banking services and has been established world-wide, having operation in more than 50 countries. Complainant has further stated that its rights over the its registered mark/brand 'BARCLAYS' and 'BARCLAYCARD'. The complainant exerts its right over the brand name 'barclays' and 'barclaycard'.



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The Complainant has contended in its claim that its business was formed over 300 years ago and that it has launched its commercial services in India in November 2006 and that today they boast a clientele of over 2,300. The Complainant further contended that in India the Complainant's GRCB (Global Retail and Commercial Banking) division was launched in May'2007 and it includes Barclaycard, which is said to be the Complainant's credit card division.

The Complainant has further contended that they own numerous national, international and European Community trade marks ("CTM"s) and that it owns an Indian registered trade mark for "BARCLAYS" bearing registration number 1,297,655 and a registered trade mark application for "BARCLAYCARD" bearing application number 1,519,366. The Complainant contended that it also owns several gTLD and ccTLD domain names comprising its BARCLAYCARD mark. For instance, <barclaycard.com>; <barclaycard.de>; <barclaycard.co.uk>; <barclaycard.it> and also <barclaycard.in>. The Complainant claimed to have developed substantial goodwill and reputation in its BARCLAYS

and BARCLAYCARD marks and brands, on account of its extensive use in India and other parts of the world.

The Complainant has contended that the disputed domain name is visually, conceptually and substantially identical to the Complainant's domain name and that the only difference between both the domain names is the alphabet 's', as the Complainant's domain name is <barclaycard.in> and the disputed domain name is <barclayscard.in>. The Complainant contended that the disputed domain name <barclayscard.in> appears immediately and obviously connected with the Complainant and its business and the public would perceive it as such. The Complainant further contended that the confusion which is likely to be brought into people's mind through the disputed domain name would not only improperly benefit the Respondent but also disrupt the business of the Complainant, dilute its rights and expose it to the risk of fraud.

The Complainant has further submitted that the disputed domain name was registered in favour of the respondent on 11 November 2007 whereas the Complainant's domain name <barclays.in> and <barclaycard.in> had been operating and serving the Indian market for over two years, having been registered by the Complainant on 16th February 2005. Furthermore the Complainant submitted that it has not authorized, licensed or otherwise consented to the Respondent's use of its marks of brands.

Thus being aggrieved by the said registration of the disputed domain name in favour of the respondent, the Complainant filed the present complaint under the INDRP policy. In response to the instant

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complaint, notice was sent on 4th August'2009 to the Respondent to file its reply. However the respondent has failed to give any reply in spite of due notice being sent. In the interest of justice, any further delay in deciding this matter is uncalled for. Hence I choose to proceed with the adjudication of the said matter ex-parte.

On the analysis of the document and record submitted by the Complainant it is found that the Complainant had registered the trademark "BARCLAYS" and "BARCLAYCARD in various countries and it has been in use in India with respect to the business activities of the Complainant since 2006. The Complainant is also the registrant of the domain names <barclaycard.com>; <barclaycard.de>; <barclaycard.co.uk>; <barclaycard.it>and also <barclaycard.in>. The connection between trademarks and domain names has been well observed in various national and international cases. Recently, authorities in India **Yahoo! Inc Vs. Akash Arora; 78(1999) Delhi Law Times 285]**, the U.K. (**Marks & Apences & Ors Vs. One in a Millions & Ors.**), Taiwan(**fair Trade Committee 89 Gong Zhu Zi No.036**), Italy, Germany, and the USA, among other jurisdiction, have ruled that the act of registering a domain name similar to or identical with or famous trade mark is an act of unfair competition whereby the domain name registrant takes unfair advantage of the fame of the trademark to either increase traffic to the domain, or to seize a potential asset of the trademark owner in the hope that the trademark owner will pay the requirement to relinquish the domain name.

In this context, I rely on the findings in the landmark judgment of **Yahoo! Inc. Vs. Akash Arora & Anr. 78(1999) Delhi Law Times 285;** In this matter, relying on a decision in **Cardservice**

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International Inc Vs. McGee 42 USPQ 2d 1850, the Hon'ble High Court of Delhi held that the domain name serves the same function as the trademark and is not a mere address and therefore entitled to equal protection as trade mark. In the said case, it was held that, Cardservice international's customers who wish to take advantage of its internet service but do not know its domain name are likely to assume that "cardservice.com" belongs to Cardservice International. However, these customers would reach McGee and see a home page for "Cardservice" and thereby assume that they have reached Cardservice International. The Court observed that the services of the plaintiff under the trademark/domain name 'Yahoo!' have been widely publicised and written about globally. In an internet service, a particular internet site could be reached by anyone anywhere in the world who proposes to visit the said internet site.... as a matter of fact in matter where services are rendered through the domain name in the internet, a very alert vigil is necessary and a strict view is to be taken for its easy access and reach by anyone from any corner of the globe....there can be no two opinions that the two marks/domain names 'Yahoo!' of the plaintiff and "Yahooindia" of the defendant are almost similar.... and there is every possibility and likelihood of confusion and deception being caused. The plaintiffs herein were thus granted ad interim injunction restraining the defendants from using the domain name 'Yahooindia.com'. Another similarly decided case is that of **Marks & Spencers & Ors. Vs. One in a Million & Ors**, wherein a British Court ruled that where the value of the domain name consists solely of its resemblance to the trademark of another, the Court could assume likelihood of confusion, and thus find unfair competition. The Court found that the registrant of many domain names similar to famous marks had committed a "deliberate

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practice....with clear intent to deceive people" as the registrant had no legitimate use for the domain names.

In support of their case the Complainant has relied upon a decision in **Sony Ericsson Mobile Communications AB vs. Farhang Farnood, Decision of INDRP dated February 20th, 2007** wherein the dispute was with respect to Complainant's registered domain name 'sonyericsson.in' vis-a-vis Respondent's registration of the domain name 'sonyericson.in'. They were phonetically similar and they both consist of similar 'letters or words' except that in respondent's domain name alphabet, "s", was absent. Here the Complainant's registered trademark was 'SONYERICSSON'. Herein the complainant's submission that the respondent's domain name was conceptually and confusingly similar to the complainant's trade mark was accepted and judgement was passed by protecting the rights of the complainant.

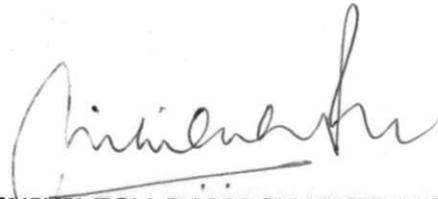
From the evidences submitted by the Complainant, I find that the Complainant is the proprietor and registered owner/mark of the word 'barclays' and its associated name 'barclaycard'. Further the Complainant has also shown its use of various domain names registered and used by it for example <barclaycard.com>; <barclaycard.de>; <barclaycard.co.uk>; <barclaycard.it> and also <barclays.in>.

I find that the impugned domain name <barclayscard.in> is identical and confusingly similar to the other prior registered domain names and registered trade mark of the complainant. Since the Complainant's application for registration of 'barclaycard' is still pending, therefore it is a fit case for transfer of the disputed domain name in favour of the complainant.

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Considering the facts and circumstances of the present matter and taking view of the precedents laid in the context thereof, I am of the view that the complainant has proprietary right over the mark 'BARCLAYS'. Under the facts and circumstances and on perusal of the records, I deem it fit and proper to allow the prayer of the Complainant regarding cancellation of the disputed domain name granted in favour of the respondent and direct the Registry to cancel the said domain name forthwith and transfer the said domain name i.e. <barclayscard.in> in favour of the Complainant.

Parties to bear their costs.



[NIKILESH RAMACHANDRAN]
ARBITRATOR

DATED: 18th September 2009