

ADMINISTRATIVE PANEL DECISION

Barnes Europe Consulting Kft. and Ms. Heidi Barnes-Watson v. 国景 林
Case No. D2023-1301

1. The Parties

The Complainants are Barnes Europe Consulting Kft., Hungary, and Ms. Heidi Barnes-Watson, United States of America (“United States”), represented by Inlex IP Expertise, France.

The Respondent is 国景 林, China.

2. The Domain Name and Registrar

The disputed domain name <barnes-location.com> is registered with NameSilo, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 27, 2023. On March 27, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 27, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Redacted for Privacy, PrivacyGuardian.org llc) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 31, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on April 3, 2023.

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 April 5, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 25, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 26, 2023.

The Center appointed Mario Soerensen Garcia as the sole panelist in this matter on May 4, 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 Complainants are a Hungarian company and an American citizen, active in the international luxury real estate sector, providing their clientele with real estate consultancy services in over 15 countries and 60 destinations.

The Complainants own an international portfolio of trademark registrations/application for BARNES, BARNES INTERNATIONAL REALTY & design and B BARNES INTERNATIONAL REALTY & design in many jurisdictions around the world, including, but not limited to the following registrations and application:

- French trademark No. 3861673, for BARNES, registered on September 26, 2011;
- International trademark No. 1114909, for BARNES, registered on March 13, 2012, designating among others China;
- French trademark No. 4251838, for B BARNES INTERNATIONAL REALTY & design, registered on February 24, 2016;
- Canadian trademark No. TMA1079518, for B BARNES INTERNATIONAL REALTY & design, registered on June 10, 2020;
- Canadian trademark No. TMA1090929, for BARNES INTERNATIONAL REALTY & design, registered on January 5, 2021;
- European Union Trade Mark No. 018037155, for BARNES, registered on September 26, 2019;
- United States trademark No. 6855266, for BARNES, registered on September 27, 2022;
- French trademark no. 4840275, for B BARNES INTERNATIONAL & design, registered on February 3, 2022.

The Panel notes that the Complainants also have an extensive online presence and that they host their main website under the domain name <barnes-international.com>, registered on July 25, 2007, and their official website for their real estate agency in New York under the domain name <barnes-newyork.com>, registered on September 8, 2011.

The disputed domain name was registered on February 13, 2023, and is therefore of a later date than the abovementioned trademarks and domain names of the Complainants. The disputed domain name was linked to an active webpage containing explicit pornographic content, and displaying gambling advertisements. Currently, the disputed domain name resolves to an inactive page.

5. Parties' Contentions

A. Complainants

The Complainants contend that the disputed domain name is identical or confusingly similar to their trademark BARNES, that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and that the disputed domain name was registered, and is being used in bad faith to divert Internet users to the Respondent's webpage containing pornographic material.

The Complainants essentially argue that the disputed domain name is confusingly similar to the Complainant's trademarks as it incorporates the Complainants' BARNES trademark in its entirety, with the only differing element being the addition of the term "location" ("rental" in French) to the disputed domain name which refers to the Complainants' activities, notably being the rental of luxury real estate. The Complainants also provide evidence that the disputed domain name is linked to an active webpage containing pornographic content, which would be likely to tarnish the Complainants' marks. The Complainants allege that such use does not confer any rights or legitimate interests in respect of the disputed domain name, and that it constitutes use in bad faith of the disputed domain name. The Complainants also argue that the Respondent has clearly registered the disputed domain name to target the Complainants' brand and that the registration of the disputed domain name was therefore conducted in bad faith. Finally, the Complainants assert that the Respondent has engaged in a pattern of cybersquatting behavior because the Respondent was involved in at least one previous case *L'Oréal v. Domain Administrator*, See PrivacyGuardian.org / 国景林, WIPO Case No. [D2021-1608](#) in which the domain name also pointed to a website containing sexually explicit content. The Complainants request the transfer of the disputed domain name to the Complainant, Barnes Europe Consulting Kft.

B. Respondent

The Respondent did not reply to the Complainants' contentions.

6. Discussion and Findings

6.1 Preliminary Issue: Consolidation of Complainants

The Complainants in this administrative proceeding request consolidation in regard to the Complainants. In this regard, the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (the "[WIPO Overview 3.0](#)") states in section 4.11.1: "In assessing whether a complaint filed by multiple Complainants may be brought against a single respondent, panels look at whether (i) the Complainants have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the Complainants in a similar fashion, and (ii) it would be equitable and procedurally efficient to permit the consolidation."

The Panel has carefully reviewed all elements of this case, giving particular weight to the evidence provided by the Complainants that some of the trademarks on which they rely in this proceeding are jointly owned by them. The Panel concludes from such evidence that both Complainants are the target of common conduct by the Respondent and both have a common grievance regarding the use of their BARNES trademarks in the disputed domain name by the Respondent. The Panel accepts that permitting the consolidation would be fair and equitable to all Parties involved and would safeguard procedural efficiency. The Panel therefore grants the request for consolidation of the Complainants and shall hereafter refer to the Complainants jointly as "the Complainant".

6.2 Discussion and Findings on the Merits

As per paragraph 4(a) of the Policy, the Complainant must prove that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (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.

Based on the evidence and arguments submitted, the Panel's findings are as follows:

A. Identical or Confusingly Similar

The evidence demonstrates that the Complainant is the owner of several trademark registrations for BARNES, BARNES INTERNATIONAL REALTY & design and B BARNES INTERNATIONAL REALTY & design in many jurisdictions. The Complainant's trademarks predate the registration of the disputed domain name.

The disputed domain name incorporates the Complainant's trademark BARNES in its entirety, with the addition of the word "location," which does not prevent a finding of confusing similarity between the disputed domain name and the Complainant's trademarks.

As numerous prior UDRP panels have recognized, the incorporation of a trademark in its entirety or a dominant feature of a trademark is sufficient to establish that a domain name is identical or confusingly similar to the complainant's mark. See section 1.7 of the [WIPO Overview 3.0](#).

The Panel finds that paragraph 4(a)(i) of the Policy has been proved by the Complainant, *i.e.*, the disputed domain name is confusingly similar to the Complainant's trademark BARNES.

B. Rights or Legitimate Interests

The Respondent has not submitted a response to the Complaint.

There is no evidence that the Respondent has any authorization to use the Complainant's trademarks or to register domain names containing the Complainant's trademark BARNES.

There is no evidence that the Respondent is commonly known by the disputed domain name.

There is no evidence that the Respondent is making a legitimate noncommercial or fair use of the disputed domain name or that before any notice of the dispute, the Respondent has made 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. Instead, the disputed domain name resolved to a website with pornographic content and gambling advertisements.

The construction of the disputed domain name itself carries a risk of implied affiliation that cannot constitute fair use. See section 2.5.1 of the [WIPO Overview 3.0](#). The Panel notes that the Complainant operates the similar domain names <barnes-international.com> and <barnes-newyork.com>. Further, the disputed domain name, with "-location" ("rental" in French) after the trademark BARNES, seems to imply that it belongs to the Complainant.

The Panel finds that the use of the disputed domain name, which incorporates the Complainant's trademark BARNES plus the word "location" ("rental" in French), for a website with pornographic content and gambling advertisements, does not correspond to a *bona fide* use of the disputed domain name under the Policy.

For the above reasons, the Panel finds that the Complainant has made out an unrebutted *prima facie* case and the condition of paragraph 4(a)(ii) of the Policy has been satisfied, *i.e.*, the Respondent has no rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

The trademarks BARNES, BARNES INTERNATIONAL REALTY & design and B BARNES INTERNATIONAL REALTY & design are registered by the Complainant in several jurisdictions and have been used for years.

The Complainant's trademarks BARNES, BARNES INTERNATIONAL REALTY & design and B BARNES INTERNATIONAL REALTY & design have a strong worldwide and online visibility.

The disputed domain name reproduces the Complainant's trademarks BARNES and the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant demonstrates that there is no other reason for the use and registration of the disputed domain name than to take advantage of the reputation of the Complainant's trademarks, with the intent to deceive Internet users into believing that the disputed domain name is associated with the Complainant. The Respondent obviously knew of the Complainant's mark when registering the disputed domain name, since the Respondent chose the word "location" ("rental" in French) to associate with the trademark BARNES, in a clear reference to the Complainant's real estate business.

Moreover, the Respondent has chosen not to respond to the Complainant's allegations. According to the panel's decision in *The Argento Wine Company Limited v. Argento Beijing Trading Company*, WIPO Case No. [D2009-0610](#), "the failure of the Respondent to respond to the Complaint further supports an inference of bad faith" (see also *Bayerische Motoren Werke AG v. (This Domain is For Sale) Joshuathan Investments, Inc.*, WIPO Case No. [D2002-0787](#)).

The disputed domain name previously resolved to a website displaying pornographic content and gambling advertisements. Therefore, this Panel finds that the Respondent has intentionally attempted, for commercial gain, to cause confusion with the Complainant's trademarks by misleading Internet users into believing that the inherently misleading disputed domain name belongs to or is associated with the Complainant.

Although the disputed domain name is currently inactive, the Panel finds that the failure of the Respondent to submit a Response, the fact that the Respondent used a privacy service to conceal his identity, the fact that the Complainant's trademark BARNES are widely know, and the implausibility that the disputed domain name may be put in good faith use are indication of the Respondent's bad faith. See section 3.3 of the [WIPO Overview 3.0](#).

For the above reasons, the Panel finds that the condition of paragraph 4(a)(iii) of the Policy has been satisfied, *i. e.*, the disputed domain name has been registered and is being used 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 <barnes-location.com> be transferred to the Complainant Barnes Europe Consulting Kft.

/Mario Soerensen Garcia/

Mario Soerensen Garcia

Sole Panelist

Date: May 18, 2023