

## **ADMINISTRATIVE PANEL DECISION**

**A.G. BARR P.L.C. v. DISCOUNT BARR, Virginia Cova, Virginia LTD**  
**Case No. D2023-3479**

### **1. The Parties**

The Complainant is A.G. BARR P.L.C., United Kingdom, represented by Stobbs IP Limited, United Kingdom.

The Respondents are DISCOUNT BARR, United States of America, and Virginia Cova, Virginia LTD, United States of America.

### **2. The Domain Names and Registrars**

The disputed domain name <barrdiscount.store> is registered with Alibaba.com Singapore E-Commerce Private Limited (the “Registrar”).

The disputed domain names <barrdiscount.shop>, <barrsale.online>, <barrsale.shop>, and <fizzydrinkbarr.store> are registered with Hostinger, UAB (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 16, 2023. On August 17, 2023, the Center transmitted by email to the Registrars a request for registrar verification in connection with the disputed domain names <barrdiscount.store>, <barrsale.shop>, and <barrsale.online>. On August 18 and 21, 2023, the Registrars transmitted by email to the Center their verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Redacted for privacy) and contact information in the Complaint. On August 23, 2023, the Complainant submitted a request to add the disputed domain name <barrdiscount.shop> to the current proceeding. On August 23, 2023, the Center transmitted by email to the Registrar Hostinger, UAB a request for registrar verification in connection with the disputed domain name <barrdiscount.shop>. On August 29, 2023, the Complainant submitted a request to add the disputed domain name <fizzydrinkbarr.store> to the current proceeding. On August 29, 2023, the Center transmitted by email to the Registrar Hostinger, UAB a request for registrar verification in connection with the disputed domain name <fizzydrinkbarr.store>.

The Center sent email communications to the Complainant on August 23 and 29, 2023, with the registrant and contact information of nominally multiple underlying registrants revealed by the Registrars, requesting the Complainant to either file separate complaints for the disputed domain names associated with different underlying registrants or alternatively, demonstrate that the underlying registrants are in fact the same entity. The Complainant filed an amended Complaint on September 8, 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 September 13, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 3, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 4, 2023.

The Center appointed Louis-Bernard Buchman as the sole panelist in this matter on October 26, 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 global multi-beverage manufacturer incorporated in 1904, based in Scotland, United Kingdom, with operations in the United Kingdom and in the United States of America. It is listed on the London Stock Exchange and had in 2022 a turnover of GBP 268.6 million.

The Complainant owns a portfolio of trademarks, registered since 1938, including the United Kingdom trademark No. 00003095255 for BARR, registered on May 15, 2015 and the United Kingdom trademark No. 00003802827 for BARR, registered on September 23, 2022 (together hereinafter referred to as “the Mark”).

The Complainant also owns the <agbarr.co.uk> domain name, which resolves to its official website advertising its products.

The <barrdiscount.store> disputed domain name was registered on July 17, 2023.

The <barrsale.shop> disputed domain name was registered on August 3, 2023.

The <barrsale.online> disputed domain name was registered on August 8, 2023.

The <barrdiscount.shop> disputed domain name was registered on August 18, 2023.

The <fizzydrinkbarr.store> disputed domain name was registered on August 24, 2023.

All disputed domain names resolved to commercial websites having the look and feel of, and displaying highly similar content to, the Complainant’s website, and offering products counterfeiting those of the Complainant.

#### **5. Parties’ Contentions**

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

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain names.

Notably, the Complainant contends that the disputed domain names reproduce the Mark, in which it has rights, and is confusingly similar to the Mark insofar as the disputed domain names all contain the Mark and that the addition of the terms “discount”, “sale” or “fizzydrink”, before or after the Mark, is not capable of dispelling the confusing similarity, as the Mark remains recognizable in the disputed domain names.

The Complainant also contends that the Respondent has no rights or legitimate interests in respect of the disputed domain names and never had any affiliation with the Complainant (which never authorized the Respondent to use the Mark in any manner).

Furthermore, the Complainant contends that the Respondent had knowledge of the Mark and registered the disputed domain names in bad faith, and is also using them in bad faith.

## **B. Respondent**

The Respondent did not reply to the Complainant's contentions.

## **6. Discussion and Findings**

### **6.1. Procedural Aspects**

#### **A. Request for Consolidation - Multiple Respondents**

The amended Complaint was filed in relation to nominally different domain name registrants. The Complainant alleges that the domain name registrants are the same entity or mere alter egos of each other, or under common control. The Complainant requests the consolidation of the Complaint against the multiple disputed domain name registrants pursuant to paragraph 10(e) of the Rules.

The disputed domain name registrants did not comment on the Complainant's request.

Paragraph 3(c) of the Rules states that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder.

In addressing the Complainant's request, the Panel will consider whether (i) the disputed domain names or corresponding websites are subject to common control; and (ii) the consolidation would be fair and equitable to all Parties. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)), section 4.11.2.

As regards common control, the Panel notes that

- all but one of the disputed domain names are registered with the same Registrar;
- the disputed domain names were registered successively and within at most a timespan of 37 days;
- the registrants of the disputed domain names were all initially masked by a privacy protect service or redacted for privacy;
- the disputed domain names are similar to each other beyond the simple fact of containing the Mark, insofar as they all combine the Mark with additional words in English ("discount", "sale" or "fizzydrink");
- the similarity in their structures combined with the similarity in the websites to which they resolved is very unlikely to be a coincidence.

The combination of the above circumstances may indicate that the disputed domain names have been, in fact, registered by the same person or entity and are subject to common control.

As regards fairness and equity, the Panel sees no reason why consolidation of the disputes would be unfair or inequitable to any Party.

Accordingly, on the balance of the probabilities and in the interest of procedural efficiency, the Panel decides that all named registrants of the disputed domain names are, in fact, the same entity and/or that all the disputed domain names are under common control, and accepts to consolidate the disputes regarding the nominally different disputed domain name registrants (referred to below as "the Respondent") in a single proceeding.

## **B. Failure to respond**

As aforementioned, no formal Response was received from the Respondent.

Under the Rules, paragraphs 5(f) and 14(a), the effect of the Respondent not replying formally is that, in the absence of exceptional circumstances, the Panel shall proceed to a decision on the basis of the Complaint.

The Panel does not find any exceptional circumstance in this case which would cause the Panel to proceed differently.

Under paragraph 4(a) of the Policy, it is the Complainant's burden to establish that all three of the required criteria for a transfer of the disputed domain name have been met, even in the event of a default.

Under paragraph 14(b) of the Rules, the Panel is empowered to draw such inferences from the Respondent's default as it considers appropriate under the circumstances.

In this case, the Panel finds the Respondent has failed to rebut any of the reasonable factual assertions that are made and supported by evidence submitted by the Complainant. In particular, by failing to respond formally, the Respondent has failed to offer the Panel any of the types of evidence set forth in paragraph 4(c) of the Policy or otherwise, from which the Panel might conclude that the Respondent has any rights or legitimate interests in the disputed domain names, such as making legitimate noncommercial or fair use of the disputed domain names.

Moreover, as discussed below, the Respondent has failed to provide any exculpatory information or reasoning that might have led the Panel to question the Complainant's arguments that the Respondent has acted in bad faith.

### **6.2. Requirements of paragraph 4(a) of the Policy**

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

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain names. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the dominant feature of the Mark is recognizable within the disputed domain names.

Accordingly, the disputed domain names are confusingly similar to the Mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

While the addition of other terms here, such as "discount", "sale" or "fizzydrink", may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain names and the Mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Regarding the generic Top-Level Domains ("gTLD") ".store", ".shop" and ".online" in the disputed domain names, it is well established that a gTLD does not generally affect the assessment of a domain name for the purpose of determining identity or confusingly similarity. [WIPO Overview 3.0](#), section 1.11.1.

Based on the available record, the Panel finds that the first element of the Policy has been established.

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

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names. The Respondent has not rebutted the Complainant’s *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain names such as those enumerated in the Policy or otherwise.

Given the use of the Complainant’s trademark within both the construction of the disputed domain names, wherein it is combined with terms that would suggest some sort of association, as well as the use of the disputed domain names to reflect the Complainant’s trademark without any disclaimer and allegedly offer for sale the Complainant’s products, it is clear that the Respondent sought to create a direct inference of association with the Complainant, for its commercial gain. [WIPO Overview 3.0](#), sections 2.5.1 and 2.8. Given the impersonation of the Complainant, it is not necessary for the Panel to determine whether the offered goods are genuine or not, though clearly the provision of counterfeit goods would neither establish rights nor legitimate interests. [WIPO Overview 3.0](#), section 2.13.

Based on the available record, the Panel finds that the second element of the Policy has been established.

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

The Panel notes that for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular but without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that by registering the disputed domain names and using them to direct Internet users to websites offering infringing products, the Respondent intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Mark.

Furthermore, it is well-established in prior UDRP decisions that where the respondent knew or should have known of a trademark prior to registering the disputed domain name, such conduct may be, in certain circumstances, evidence of bad faith registration. See *Weetabix Limited v. Mr. J. Clarke*, WIPO Case No. [D2001-0775](#).

In this case, considering the duration of the use in commerce of the Complainant’s corporate name, the size of the Complainant’s operations (including in the United States of America where the Respondent seems to be located), and the fact that the disputed domain names resolved to fraudulent websites, the Panel finds implausible that the Respondent chose to register the disputed domain names randomly with no knowledge of the Mark. See *Barney’s Inc. v. BNY Bulletin Board*, WIPO Case No. [D2000-0059](#); *Kate Spade, LLC v. Darmstadter Designs*, WIPO Case No. [D2001-1384](#), citing *Cellular One Group v. Paul Brien*, WIPO Case No. [D2000-0028](#); and *Sembcorp Industries Limited v. Hu Huan Xin*, WIPO Case No. [D2001-1092](#).

Finally, some UDRP panels have held that in certain circumstances, registrants of domain names would have a duty to abstain from registering and using a domain name, which is either identical or confusingly similar to a prior trademark held by others and which would infringe upon or otherwise violate the rights of a third party. See Policy, paragraph 2(b); *Nike, Inc. v. Ben de Boer*, WIPO Case No. [D2000-1397](#); *Nuplex Industries Limited v. Nuplex*, WIPO Case No. [D2007-0078](#); *Mobile Communication Service Inc. v. WebReg, RN*, WIPO Case No. [D2005-1304](#); *BOUYGUES v. Chengzhang, Lu Ciagao*, WIPO Case No. [D2007-1325](#); *Media General Communications, Inc. v. Rarenames, WebReg*, WIPO Case No. [D2006-0964](#); and *mVisible Technologies, Inc. v. Navigation Catalyst Systems, Inc.*, WIPO Case No. [D2007-1141](#).

Based on the available record, the Panel finds that the third element of the Policy has been established.

## 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 <barrdiscount.shop>, <barrdiscount.store>, <barrsale.online>, <barrsale.shop>, and <fizzydrinkbarr.store> be transferred to the Complainant.

*/Louis-Bernard Buchman/*

**Louis-Bernard Buchman**

Sole Panelist

Date: November 9, 2023