

ADMINISTRATIVE PANEL DECISION

Barnes Europe Consulting Kft., Heidi Barnes-Watson v. Privacy Service
Provided by Withheld for Privacy ehf / Chris Byrd
Case No. D2022-1358

1. The Parties

The first Complainant is Barnes Europe Consulting Kft., Hungary, and the second Complainant is Heidi Barnes-Watson, United States of America (“United States”), represented by Inlex IP Expertise, France.

The Respondent is Privacy Service Provided by Withheld for Privacy ehf, Iceland / Chris Byrd, United States.

2. The Domain Name and Registrar

The disputed domain name <barnes-internationa.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 14, 2022. On April 19, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same date, 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 and contact information in the Complaint. The Center sent an email communication to the Complainants on April 21, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amended Complaint on April 25, 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 May 5, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 25, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 1, 2022.

The Center appointed Kateryna Oliinyk as the sole panelist in this matter on June 22, 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 first Complainant is a member of the Barnes Group, established 20 years ago by the second Complainant (jointly the “Complainants”). The Barnes Group is an international firm operating in high-end residential real estate and formed of a network of 90 real estate agencies established in 15 countries. The Complainants provide services to their international clients through its various business lines: sales as well as rental of luxury properties and property management.

The Complainants jointly own a series of national and international trademark registrations of the BARNES trademark, including the following:

- International trademark registration No. 1114909 for BARNES, registered on March 13, 2012;
- French trademark registration No. 3861673 for BARNES, registered on January 20, 2012;
- United Kingdom trademark registration No. UK00801114909 for BARNES, registered on March 26, 2013; and
- International trademark registration No. 1324244 for B BARNES INTERNATIONAL REALTY, registered on August 23, 2016.

The Complainants operate the official website under the domain name <barnes-international.com> created on July 25, 2007.

The disputed domain name was created on February 8, 2022 and does not resolve to an active website.

5. Parties’ Contentions

A. Complainant

Identical or Confusingly Similar

The Complainants contend that the disputed domain name and the BARNES trademark are confusingly similar.

According to the Complainants’ contentions, the disputed domain name fully incorporates the Complainants’ BARNES trademark.

The Complainants contend that the addition of the term “internationa”, being the misspelling of the word “international”, does not prevent a finding of confusing similarity between the disputed domain name and the BARNES trademark.

No rights or legitimate Interests

The Respondent has no connection with the Complainants or any of their affiliates and has never sought or obtained any trademark registration for the BARNES trademark. The Complainants do not carry out any activity for, nor have any business with, the Respondent.

The Complainants further contend that the Respondent is not commonly known by the disputed domain name.

Passive holding of the disputed domain name is neither a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use. The Respondent, therefore, has no rights or legitimate interests in the disputed domain name.

Registered and used in bad faith

The Complainants submit that the Respondent has registered the disputed domain name with full knowledge of the Complainant's BARNES trademark as the disputed domain name incorporates it in its entirety.

The Complainants contend that the Respondent has not demonstrated any activity in respect of the disputed domain name, and it is not possible to conceive of any plausible actual or contemplated active use of the disputed domain name by the Respondent that would not be illegitimate.

The Complainants aver that there is a high risk that the disputed domain name will be used for phishing or scams as the Complainants have established that MX records are configured for the disputed domain name.

B. Respondent

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

6. Discussion and Findings

6.1. Procedural Issue - Consolidation of Multiple Complainants

The present proceeding involves two Complainants bringing a single complaint against the Respondent. The Complainants have made a request for consolidation and bear the onus of establishing that such a consolidation is justified.

In assessing whether a complaint filed by multiple complainants can be brought against a single respondent, panels typically consider whether (1) the complainants have a specific common grievance against the respondent, and (ii) it would be equitable and procedurally efficient to permit the consolidation. See section 4.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)).

The Panel is satisfied, based on the material filed, that the Complainants have a specific common grievance against the Respondent, in that the Complainants are related and jointly hold the Complainants' BARNES trademarks.

Therefore, the Panel finds that it is equitable and procedurally efficient to consolidate the proceedings. This is consistent with the Policy and the Rules, comports with prior relevant UDRP decisions in this area, and is appropriate in light of the aforementioned principles. The Panel therefore will proceed to a decision on the merits.

6.2. Substantive Elements of the Policy

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: "[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

Considering that the Respondent did not reply to the Complainant's contentions, in order to determine whether the Complainants have met their burden as stated in paragraph 4(a) of the Policy, the Panel bases its Decision on the statements and documents submitted and in accordance with the Policy and the Rules. Under paragraph 14(b) of the Rules, where a Party does not comply with any provision of the Rules, the Panel "shall draw such inferences therefrom as it considers appropriate".

Paragraph 4(a) of the Policy directs that the Complainants must prove each of the following: (i) that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainants have rights; (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and (iii) that the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

Ownership of a nationally or regionally registered trademark serves as a *prima facie* evidence that the Complainants have trademark rights for the purposes of standing to file this Complaint. See section 1.2 of [WIPO Overview 3.0](#). The Complainants submitted evidence that the BARNES trademark enjoys protection under national and international trademark registrations. Thus, the Panel finds that the Complainants' rights in the BARNES trademark have been established pursuant to the first element of the Policy.

The disputed domain name fully incorporates the Complainants' BARNES trademark.

As provided in section 1.8 of the [WIPO Overview 3.0](#), the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. Thus, addition of the term "international" (which is the clear misspelling of the term "international") preceded with the hyphen does not prevent a finding of confusing similarity between the Complainants' trademark which remains recognizable in the disputed domain name and the disputed domain name, as the latter includes the Complainants' BARNES trademark in its entirety.

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the BARNES trademark in which the Complainants have rights.

The first element of paragraph 4(a) of the Policy is therefore satisfied.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, a complainant must make at least a *prima facie* showing that a respondent possesses no rights or legitimate interests in a disputed domain name. See, e.g., *Malayan Banking Berhad v. Beauty, Success & Truth International*, WIPO Case No. [D2008-1393](#). Once a complainant makes such a *prima facie* showing, the burden of production shifts to the respondent, though the burden of proof always remains on the complainant. If the respondent fails to come forward with evidence showing rights or legitimate interests, the complainant will have sustained its burden under the second element of the UDRP.

Based on the Complainants' contentions, the Respondent is not a licensee of, or otherwise affiliated with, the Complainants, and has not been authorized by the Complainants to use their BARNES trademark.

The Complainants further contend that the Respondent is not commonly known by the disputed domain name and has not made any *bona fide* use - neither commercial nor noncommercial, of the same.

Based on the case records, the Panel finds that there is no evidence that the Respondent has been commonly known by the disputed domain name, and there is no similarity or association between the name of the Respondent and the disputed domain name, which could demonstrate rights or legitimate interests of the Respondent. See, e.g., *World Natural Bodybuilding Federation, Inc. v. Daniel Jones TheDotCafe*, WIPO Case No. [D2008-0642](#).

The disputed domain name does not resolve to an active website. Prior UDRP panels have found that the passive holding of a disputed domain name is neither a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use. See, by way of example, *Skyscanner Limited v. WhoisGuard Protected, WhoisGuard, Inc. / petrov petya*, WIPO Case No. [DCC2020-0003](#), *Instagram, LLC v. Zafer Demir, Yok*, WIPO Case No. [D2019-1072](#), "The passive holding of the disputed domain name does not amount to

use or preparations to use it in connection with a *bona fide* offering of goods and services. Nor is there any evidence which indicates that the Respondent is commonly known by the disputed domain name. Nor does a passive holding of the disputed domain name comprise a legitimate noncommercial or fair use of it.”).

The Panel agrees and holds the passive holding of the disputed domain name by the Respondent in this case as evidence that the Respondent has not registered the disputed domain name in connection with any *bona fide* offering of goods or services.

In the Panel's view, the use of the disputed domain name by the Respondent does not constitute either a *bona fide* use or a legitimate noncommercial or fair use of the disputed domain name.

By not submitting a Response, the Respondent has failed to invoke any circumstances which could demonstrate any rights or legitimate interests in the disputed domain name. Under such circumstances the Panel draws adverse inferences from this failure, where appropriate, in accordance with the Rules, paragraph 14(b).

The second element of paragraph 4(a) of the Policy is therefore satisfied.

C. Registered and Used in Bad Faith

The disputed domain name was created on February 8, 2022, and is passively held by the Respondent.

Under section 3.3 of the [WIPO Overview 3.0](#), the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. Previous UDRP panels have held that the passive holding of a domain name that incorporates a well-known trademark may confirm the bad faith use of a disputed domain name. See, *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#).

While panels will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put. See, *Andrey Ternovskiy dba Chatroulette v. WhoisGuard Protected, WhoisGuard, Inc. / Armando Machado*, WIPO Case No. [D2018-0082](#).

The Complainants have produced evidence showing that they own registrations for the BARNES trademark, of which registration dates significantly precede the creation date of the disputed domain name.

In addition, the Complainants have credibly submitted that over the years they have developed substantial goodwill in the BARNES trademark. The Panel is convinced that the Complainants' trademark is well established through long and widespread use and the Complainants have acquired a significant reputation and goodwill in their trademark. See, e.g., *Carrefour SA v. hanib bas*, WIPO Case No. [D2020-1798](#); *Carrefour SA. v. Reliant-web Domain Admin / Jean Marie Grolleau / Joanne Elvert*, WIPO Case No. [D2021-2389](#); *Carrefour v. Andre Machado*, WIPO Case No. [DIO2020-0004](#).

Furthermore, according to section 3.1.4 of the [WIPO Overview 3.0](#), the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. Given the reputation of the BARNES trademark, registration in bad faith can be inferred. See, e.g., *Charles Jourdan Holding AG v. AAIM*, WIPO Case No. [D2000-0403](#).

Taking the above facts into consideration, it is not possible to conceive of any plausible actual or contemplated active use of the disputed domain name by the Respondent that would not be illegitimate. See *Telstra Corporation Limited v. Nuclear Marshmallows, supra*.

Finally, the Respondent has failed to submit a response or to provide any evidence of actual or contemplated

good faith use of the disputed domain name.

In light of the aforesaid and applying the above-referenced factors, the Panel establishes that the Respondent registered and is using the disputed domain name in bad faith.

The third element of paragraph 4(a) of the Policy is therefore satisfied.

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-internationa.com> be transferred to the Complainants.

/Kateryna Oliinyk/

Kateryna Oliinyk

Sole Panelist

Date: July 6, 2022