

ADMINISTRATIVE PANEL DECISION

Barrick Gold North America, Inc., Barrick Gold Corporation v. Emmanuel Sam
Case No. D2023-0686

1. The Parties

The Complainants are Barrick Gold North America, Inc. and Barrick Gold Corporation, United States of America (“United States”), represented by Dorsey & Whitney, LLP, United States.

The Respondent is Emmanuel Sam, Ghana.

2. The Domain Name and Registrar

The disputed domain name <barrickgoldcompany.com> is registered with Launchpad.com Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 14, 2023. On February 15, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 15, 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 (Domain Admin, Privacy Protect, LLC (PrivacyProtect.org)) and contact information in the Complaint. The Center sent an email communication to the Complainants on February 21, 2023, 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 February 21, 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 March 1, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 21, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 22, 2023.

The Center appointed Luca Barbero as the sole panelist in this matter on March 28, 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

Barrick Gold North America, Inc (hereinafter, the first Complainant) and Barrick Gold Corporation (hereinafter, the second Complainant) are part of a conglomerate that explores gold mining around the world.

The Complainants, its affiliates and subsidiaries, have used the trademark BARRICK in connection with gold and copper mining and precious metal goods and services in over thirteen countries since 1983.

The second Complainant is the owner of several trademark registrations for BARRICK and BARRICK GOLD, including the following, as per trademark certificates submitted as annexes to the Complaint:

- European Union trademark registration No. 008890386 for BARRICK (word mark), filed on February 17, 2010 and registered on August 10, 2010, in international classes 6, 14 and 37;
- European Union trademark registration No. 018012698 for BARRICK (figurative mark), filed on January 21, 2019 and registered on July 3, 2019, in classes 14, 37 and 42;
- United States trademark registration No. 6225225 for BARRICK (word mark), filed on November 3, 2019 and registered on December 22, 2020, in international classes 6, 14, 37 and 42;
- United States trademark registration No. 6592636 for BARRICK (figurative mark), filed on January 18, 2019 and registered on December 21, 2021 in international classes 14, 37 and 42;
- United States trademark registration No. 4683358 for BARRICK GOLD (word mark), filed on January 6, 2012 and registered on February 10, 2015, in international class 42;
- United States trademark registration No. 4944505 for BARRICK GOLD (word mark), filed on April 30, 2015 and registered on April 26, 2016, in international class 37.

The Complainants operate their main website at the domain name <barrick.com>, registered on October 6, 1995, that they use to advertise and promote a variety of mining services, business initiatives, and other commercial endeavors under the trademark BARRICK.

The disputed domain name <barrickgoldcompany.com> was registered on May 16, 2022, and is pointed to a website prominently displaying the indication “Welcome to Barrick Gold”, publishing articles taken from the Complainants’ official website, a contact form and a section entitled “Track your order” with a field to verify the status of a consignment. The “Delivery” section of the website reads: “Gold delivered right to your doorstep by the trusted delivery branch of Barrick Gold Company. Kindly track your Gold on the website if you have a tracking number”.

5. Parties’ Contentions

A. Complainant

The Complainants contend that the disputed domain name is confusingly similar to the trademarks BARRICK and BARRICK GOLD in which the Complainants have rights.

With reference to rights or legitimate interests in respect of the disputed domain name, the Complainants state that, considering the use of the trademark BARRICK dates back to at least as early as 1983 and its earliest registration for the trademark BARRICK was issued on September 18, 2013, both dates predate the Respondent’s registration of the disputed domain name, since the disputed domain name was not registered until 2022.

The Complainants state that the Respondent has also not used the disputed domain name for a *bona fide* offering of goods or services, since it is not a licensee of the Complainants and has in no way been authorized to register the disputed domain name or otherwise to use the Complainants' trademark BARRICK.

In addition, the Complainants emphasize that the Respondent has no relationship or affiliation with the Complainants or the disputed domain name, though it appears that the Respondent is intentionally attempting to confuse potential consumers by misrepresenting such an affiliation.

Moreover, the Complainants submits that the use of the disputed domain name shows the Respondent is attempting to create a direct connection to the Complainants, since the Respondent is clearly attempting to pass off as the Complainants, or at least as one of their authorized entities, by stating that it has plans to become a multi-mine, multi-jurisdiction gold producer.

The Complainants further underlines that the Respondent appears to claim that customers can purchase gold directly from the website at the disputed domain name, without however providing links or methods to actually purchase the referenced gold. To this end, the Complainants point out that the Respondent's website features several broken links and WordPress template headings, thus suggesting that the Respondent's use of the disputed domain name does not involve a *bona fide* offering of goods or services and serves no purpose other than to make improper use of the trademark BARRICK.

The Complainants further state that the Respondent is not commonly known by the disputed domain name, nor is it making a legitimate or fair use of the disputed domain name, since it has used the disputed domain name with fraudulent intent to mislead the Complainants' target market for commercial gain through intentionally misleading itself as affiliated with, connected to, or endorsed by the Complainants.

With reference to the circumstances evidencing bad faith, the Complainants indicate that it is highly unlikely that the Respondent was unaware of the Complainants at the time of registering the disputed domain name, especially since it decided to use not only the Complainants' well-known and distinctive trademark BARRICK GOLD in the disputed domain name, but also to capitalize on the Complainants' goodwill, whilst clearly creating an association with the Complainants by using press releases taken from the Complainants' website. The Complainants thus conclude that the Respondent registered the disputed domain name in bad faith to pass itself off as the Complainant or, at the very least, to create an improper affiliation.

B. Respondent

The Respondent did not reply to the Complainants' contentions.

6. Discussion and Findings

According to paragraph 15(a) of the Rules: "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." Paragraph 4(a) of the Policy directs that the Complainants must prove each of the following:

- (i) that the disputed domain name registered by the Respondent 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

The Panel finds that the Complainants have established rights over the trademarks BARRICK and BARRICK GOLD based on the trademark registrations cited under section 4 above and the related trademark certificates submitted as annex 4 to the Complaint.

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

The disputed domain name incorporates the trademark BARRICK in its entirety with the addition of the terms "gold" and "company" and the generic Top-Level Domain suffix ".com", which the Panel finds do not exclude the confusing similarity. As found in a number of prior cases decided under the Policy, where a trademark is recognizable within a domain name, the addition of other terms does not prevent a finding of confusing similarity under the first element. See section 1.8 of the [WIPO Overview 3.0](#).

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainants' trademark BARRICK. For the same reasons detailed above, the Panel also finds that the disputed domain name is confusingly similar to the Complainant's trademark BARRICK GOLD.

Therefore, the Panel finds that the Complainants have proven that the disputed domain name is confusingly similar to a trademark in which the Complainants have established rights according to paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

It is well established that the burden of proof lies on the complainant. However, satisfying the burden of proving a lack of the respondent's rights or legitimate interests in respect of the domain name according to paragraph 4(a)(ii) of the Policy is potentially onerous, since proving a negative can be difficult considering such information is often primarily within the knowledge or control of the respondent.

Accordingly, in line with previous UDRP decisions, it is sufficient that the Complainants show a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name in order to shift the burden of production on the Respondent. If the Respondent fails to demonstrate rights or legitimate interests in the disputed domain name in accordance with paragraph 4(c) of the Policy or on any other basis, the Complainants are deemed to have satisfied paragraph 4(a)(ii) of the Policy.

In the case at hand, the Panel finds that the Complainants have made a *prima facie* case and that the Respondent, by not submitting a Response, has failed to invoke any circumstance that could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in the disputed domain name.

Moreover, it has been repeatedly stated that when a respondent does not avail itself of its right to respond to a complaint, it can be assumed in appropriate circumstances that the respondent has no rights or legitimate interests in the disputed domain name (*Nordstrom, Inc. and NIHC, Inc. v. Inkyu Kim*, WIPO Case No. [D2003-0269](#)).

The Panel notes that there is no relation, disclosed to the Panel or otherwise apparent from the record, between the Respondent and the Complainants. The Respondent is not a licensee of the Complainants, nor has the Respondent otherwise obtained an authorization to use the Complainants' trademarks. Moreover, there is no element from which the Panel could infer a Respondent's right over the disputed domain name, or that the Respondent might be commonly known by the disputed domain name.

As mentioned above, the disputed domain name has been pointed to a website prominently displaying the indication "Welcome to Barrick Gold", publishing articles taken from the Complainants' official website, a contact form and a section entitled "Track your order" with a field to verify the status of a consignment. The "Delivery" section of the website reads: "Gold delivered right to your doorstep by the trusted delivery branch of Barrick Gold Company. Kindly track your Gold on the website if you have a tracking number". The Panel notes that the contents of the Respondent's website demonstrate the Respondent's intent to impersonate the Complainants or one of their affiliated entities to attract users and obtain their personal information and, possibly, also payments.

In view of the above-described use of the disputed domain name, the Panel finds that the Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainants' trademark.

Moreover, in view of the combination of the trademark BARRICK GOLD - also included in the Complainants' company names - with the term "company", the disputed domain name suggests an affiliation with the trademark owner which does not exist. As stated in section 2.5.1 of the [WIPO Overview 3.0](#), even where a domain name consists of a trademark plus an additional term, UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner.

Therefore, the Panel finds that the Complainants have proven that the Respondent has no rights or legitimate interests in the disputed domain name according to paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy requires that the Complainants prove that the disputed domain name was registered and is being used by the Respondent in bad faith.

The Panel finds that, in light of the prior registration and use of the Complainants' trademarks BARRICK and BARRICK GOLD in connection with the Complainants' gold and copper mining services and of the confusing similarity of the disputed domain name with the Complainants' trademarks, the Respondent very likely registered the disputed domain name having the Complainants' trademark in mind.

Furthermore, the circumstance that the disputed domain name has been redirected to a website featuring the Complainants' trademarks and providing information about the Complainants' services as well as publishing original articles authored by Complainants on its own website, demonstrates that the Respondent was indeed well aware of the Complainants and their trademarks.

The Panel also finds that, by pointing the disputed domain name to the website described above, publishing original articles authored by Complainant and apparently promoting the sale and delivery of gold under the Complainants' trademarks, the Respondent has intentionally attempted to attract Internet users to its website for commercial gain, by causing a likelihood of confusion with the Complainants' trademarks as to the source, sponsorship, affiliation or endorsement of their website and the products and services promoted therein, according to paragraph 4(b)(iv) of the Policy.

Therefore, the Panel finds that the Complainants have also proven that the Respondent registered and is using the disputed domain name in bad faith according to paragraph 4(a)(iii) of the Policy.

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 <barrickgoldcompany.com> be transferred to the Complainants.

/Luca Barbero/

Luca Barbero

Sole Panelist

Date: April 11, 2023