

ADMINISTRATIVE PANEL DECISION

Barnes Europe Consulting Kft., Ms. Heidi Barnes-Watson v. Hubert VOISIN Case No. D2023-0734

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 Hubert VOISIN, France.

2. The Domain Name and Registrar

The disputed domain name <barnes-interantional.com> is registered with Combell NV (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 17, 2023. On February 20, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 28, 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) and contact information in the Complaint. The Center sent an email communication to the Complainants on March 2, 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 March 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 March 9, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 29, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 31, 2023.

The Center appointed Warwick Smith as the sole panelist in this matter on April 14, 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

According to the Complaint, the Complainants run a well-known international business in the field of real estate agency and associated services. The business specializes in high-end properties in a number of regions, including Europe and the United States. The business was founded over 20 years ago, and it is operated through an integrated network of 90 agencies established in 15 countries. The business is said to be established in the world's most popular cities and top holiday destinations, where the agencies provide "luxury" sales, rental, and property management services. The luxury services they provide are said to include acquiring hunting estates, horse farms and wine-growing estates, arranging private jet and yacht charters, and providing art advisory services, interior decoration services, and brokerage services. The Complainants' 2022 "Global Property Handbook" describes the Complainants' group as providing a "global service for an international clientele".

The Complainants provide their services under a number of registered service marks consisting of or prominently incorporating the word "Barnes". It is not necessary for the purpose of this decision to refer to them all. It is enough to note that they are the proprietors of at least two such marks, and one pending application, in France, where the Respondent appears to reside. The first of the registered marks is the word mark BARNES, which was registered in France under No. 3861673 on September 26, 2011. This mark covers a variety of services in international classes 36, 37, and 42, including providing real estate appraisals, supervising construction works, and architecture and interior decoration.

The second of the registered marks is a figurative BARNES mark covering services in the same classes, registered in France under No.4251838 on February 24, 2016. This mark consists of a what appears to be a dark circular or elliptical device, with a large stylized "B" in white lettering dominating the center of the circle or ellipse. The word "Barnes" appears in smaller, white lettering above the stylized "B". In still smaller white lettering, the words "International Realty", appear below the stylized "B".

On February 3, 2022, the Complainants filed trademark application No.4840275 to register (in France) a second figurative mark incorporating the large, stylized "B" device, this time on a white circular or elliptical background with the word "Barnes" above the "B", and the single word "International" below the "B".

The Complainants own the domain name <barnes-international.com>, which was registered on July 25, 2007. This domain name resolves to the Complainants' official website, which they use widely in connection with their real estate business.

The disputed domain name was registered on December 13, 2022. The Complainants produced a screenshot of a website to which the disputed domain name resolves. It appears to be a site operated by the Registrar: it contains the name "Combell" with a logo, and the words "Someone has already reserved this domain name. Smart!" There is then a space for Internet browsers to key in a domain name they might wish to acquire, and a "check" icon to click on to see if that name is available.

5. Parties' Contentions

A. Complainant

The Complainants contend that they have rights, within the meaning of the Policy, in the service mark BARNES, and that the disputed domain name is confusingly similar to that mark. They note that the disputed domain name incorporates in full their BARNES mark, and the BARNES mark is clearly recognizable within the disputed domain name. The "barnes" part of the disputed domain name appears in a distinct, leading position, separated from the rest of the disputed domain name by a hyphen. The hyphen is followed by what is an obvious and intentional misspelling of the word "international". They contend that this is a clear instance of typosquatting, and that it is obvious that the public will think that the disputed domain name must be owned by the Complainants.

The Complainants next contend that the Respondent has no rights or legitimate interests in respect of the disputed domain name. They say that they have not authorized or licensed the Respondent to use their BARNES marks, and they have no business relationship with him. Their searches on the WIPO global brand database have not disclosed any rights or interests the Respondent might have in Barnes, or Barnes-International, and a Google search conducted by the Complainants on “barnes-interantional” did not disclose any pertinent results related to the Respondent (all the results related to the Complainants). The fact that the Respondent has not put the disputed domain name to any apparent use is another factor that suggests that he has no right or legitimate interest in respect of the disputed domain name. Furthermore, the nature of the disputed domain name (typosquatting and confusing similarity with the Complainants’ marks) carries an implied risk of creating a misleading impression of an association with the Complainants. Given the reputation of the BARNES marks, it would be difficult to imagine an actual use of the disputed domain name that would not be aimed at obtaining a free ride on the reputation of the Complainants and their BARNES marks.

Finally, the Complainants contend that the disputed domain name was registered and is being used in bad faith. They say that the BARNES marks enjoy a wide reputation around the world, citing earlier decisions of UDRP panels where that reputation has been recognized.¹ Having regard to that reputation, they contend that the Respondent knew or should have known of their rights in the BARNES marks when he registered the disputed domain name, and that he had no conceivable legitimate interest in registering the disputed domain name. Further in support of their bad faith registration argument, they point to the Respondent’s use of a privacy service when he registered the disputed domain name. They contend that the Respondent used the privacy service to hide his identity and to avoid being notified of any UDRP proceeding. On the issue of use of the disputed domain name in bad faith, the Complainants accept that the disputed domain name is not presently being used, as it resolves to a registrar’s default page. However, they submit that a respondent’s non-use of a disputed domain name does not necessarily prevent a finding of bad faith use. They rely on the doctrine of “passive holding” of a disputed domain name, where in certain circumstances panels may find bad faith “use” of a disputed domain name notwithstanding the absence of any actual use of that domain name by the respondent.²

The Complainants also point to the fact that the MX records attached to the disputed domain name have been activated, indicating that the disputed domain name is likely to be used for sending and receiving emails. They submit that members of the public who received an email from the disputed domain name would mistakenly think that it came from the Complainants. There is thus a high risk that the disputed domain name will be used for phishing activities. It is in the public interest to transfer the disputed domain name to the first-named Complainant, in order to avoid the disputed domain name being used to mislead consumers.

B. Respondent

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

6. Discussion and Findings

Under paragraph 4(a) of the Policy, a Complainant is required to establish each of the following:

- (i) the 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 domain name; and
- (iii) the domain name has been registered and is being used in bad faith.

¹ *Barnes Europe Consulting Kft., Heidi Barnes-Watson v. Privacy Service Provided by Withheld for Privacy ehf / Chris Byrd* WIPO Case No. [D2022-1358](#); and *Barnes Europe Consulting Kft. and Heidi Barnes-Watson v. Jianhua Wang*, WIPO Case No. [D2022-3059](#).

² Those circumstances are summarized in the Center’s document “WIPO Overview of WIPO Panel Views on Selected UDRP Questions Third Edition” (“[WIPO Overview 3.0](#)”), at paragraph 3.3.

A. Procedural Issue – joint complainants

The Complainants ask for an order consolidating their respective complaints against the Respondent, on the basis that they have a common grievance against the Respondent, and a common legal interest in relevant rights that are affected by the Respondent's conduct.

Paragraph 4.11.1 of [WIPO Overview 3.0](#) notes that Rule 10 (e) of the Rules grants a panel the power to consolidate multiple domain name disputes. Paragraph 4.11.1 goes on to say:

"[...]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 Complainants referred to two recent UDRP cases in which they were co-complainants, where the panels each found that it would be equitable and procedurally efficient to consolidate the Complainants' complaints, having regard to the fact that they were related, and jointly held the relevant BARNES marks.³ The Panel also notes that the passage from [WIPO Overview 3.0](#) quoted above has been applied even more recently in circumstances where joint complainants were to be considered as both having rights in the trademark on which they relied.⁴

On the evidence that has been filed, the Panel is satisfied that the Complainants have a specific common grievance against the Respondent: they are the joint registered owners of the BARNES marks, and the Complaint alleges that the Respondent is wrongfully attempting, in bad faith, to take advantage of the Complainants' rights in those marks. The Complainants' respective claims against the Respondent are essentially identical, and it will clearly be equitable and procedurally efficient to consolidate their claims in this proceeding. The panel accordingly accepts the consolidation request.

B. Identical or Confusingly Similar

The Complainants have proved this part of the Amended Complaint.

The Complainants are the registered proprietors of the BARNES mark in France, and in a number of other jurisdictions around the world. That is sufficient for them to establish "rights" in that mark for the purposes of paragraph 4(a)(i) of the Policy.

The next issue is whether the disputed domain name is confusingly similar to the Complainants' BARNES mark.

The consensus view of UDRP panels on the issue of confusing similarity where a complainant's mark is incorporated within a disputed domain name, is described as follows in [WIPO Overview 3.0](#):⁵

"Where the relevant trade mark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. [. . .]"

In this case, the BARNES mark is reproduced precisely in the disputed domain name, and the hyphen in the disputed domain name separates it from the rest of the disputed domain name. The BARNES mark is therefore easily recognizable within the disputed domain name.

³ *Barnes Europe Consulting Kft., Heidi Barnes-Watson v. Privacy Service Provided by Withheld for Privacy ehf / Chris Byrd* (above n.1), and *Barnes Europe Consulting Kft. and Heidi Barnes-Watson v. Jianhua Wang* (above n.1).

⁴ *Ticket Sms s.r.l and Mr. Andrew Vitaliy Franklin Iziren*, WIPO Case No. [D2023-0442](#).

⁵ The WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") at section 1.8.

The addition of the misspelt version of the generic expression “international” in the disputed domain name does nothing to mitigate the confusing similarity caused by the incorporation of the BARNES mark in the disputed domain name, and the generic top level domain (“gTLD”) “.com” is not taken into account in the comparison that is required by paragraph 4(a)(i) of the Policy. The gTLD is a technical requirement of registration, and is not normally considered to have legal significance in applying paragraph 4(a)(i).⁶

C. Rights or Legitimate Interests

Paragraph 4(c) of the Policy set out a number of circumstances which, without limitation, may be effective for a respondent to demonstrate that it has rights to, or legitimate interests in, a domain name for the purposes of paragraph 4(a)(ii) of the Policy. The circumstances are –

- (i) Before any notice to [the respondent] of the dispute, use by [the respondent] 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; or
- (ii) Where [the respondent] (as an individual business or other organization) [has] been commonly known by the disputed domain name, even if [the respondent has] acquired no trademark or service mark rights; or
- (iii) Where [the respondent is] making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly direct consumers or to tarnish the trademark or service mark at issue.

[WIPO Overview 3.0](#) states the following on the burden of proof under paragraph 4(a)(ii) of the Policy:

“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.”⁷

In this case, the disputed domain name is confusingly similar to the Complainants’ BARNES marks, and the Respondent has not been licensed or otherwise authorized to use those marks, or any confusingly similar expressions, whether in a domain name or otherwise. The Complainants’ Google search, and their search of the WIPO global brand database, did not show that the Respondent has any trademark or other rights in the expressions “Barnes” or “Barnes-international”.

The disputed domain name does not appear to have been used at all, let alone in connection with any *bona fide* offering of goods or services of the kind referred to in paragraph 4 (c) (i) of the Policy. Nor is there anything to suggest that the Respondent has made any demonstrable preparations for any such use, or that the disputed domain name has been put to some legitimate noncommercial or fair use of the kind described in paragraph 4 (c) (iii) of the Policy.

Paragraph 4 (c) (ii) of the Policy does not appear to apply – there is no evidence that the Respondent, whether personally or through a business or other organization, has been commonly known by the disputed domain name.

⁶ [WIPO Overview 3.0](#), section 1.11.

⁷ [WIPO Overview 3.0](#), section 2.1.

Those matters in combination are sufficient to establish a *prima facie* case under paragraph 4(a)(ii) of the Policy. The evidential burden of showing rights or legitimate interests in respect of the disputed domain name therefore moves to the Respondent. In the absence of any Response, the Respondent has failed to discharge that evidential burden, and the Complainants' *prima facie* proof must prevail. The Complainants have made out their case under paragraph 4(a)(ii) of the Policy.

D. Registered and Used in Bad Faith

Under paragraph 4(b) of the Policy, the following circumstances, without limitation, are deemed (if found by the Panel to be present) to be evidence of the registration and use of a domain name in bad faith –

- (i) Circumstances indicating that the holder has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the holder's documented out-of-pocket costs directly related to the domain name; or
- (ii) The holder has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the holder has engaged in a pattern of such conduct; or
- (iii) The holder has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) By using the domain name, the holder has intentionally attempted to attract, for commercial gain, Internet users to the holder's website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation or endorsement of the holder's website or location or of a product or service on the holder's website or location.

The Complainants have also sufficiently proved this part of the Amended Complaint.

The Panel has found that the disputed domain name is confusingly similar to the Complainants' BARNES marks, and the Respondent has not claimed to have any rights or legitimate interests in respect of the disputed domain name. He has offered no explanation for his decision to register / acquire the disputed domain name.

In the absence of any Response containing assertions to the contrary, the Panel concludes that the Respondent was almost certainly aware of the Complainants and their BARNES marks when he registered the disputed domain name. First, the Respondent appears to reside in France, and the Barnes group appears to have a substantial business presence in the French city, Paris, in which the Respondent resides. Secondly, the Complainants have held a registered mark in France consisting of the word BARNES, since September 2011. They are also the proprietors of a figurative "Barnes" mark, registered in France in 2016, which contains both the words "Barnes" and "International". Thirdly, the Complainants are the owners of the domain name <barnes-international.com>, which was registered as long ago as 2007.

In those circumstances, the Respondent chose to register as a domain name the word "barnes", followed by a hyphen and "interantional", which is an obvious and clearly intentional misspelling of the word "international". Given the matters discussed in the previous paragraph of this decision, the chances of the Respondent coming up with a domain name which combined all three elements of the domain name that resolves to the Complainants' principal website ("barnes" plus hyphen plus "international", with the only difference being the transposition of the letters "a" and "n" in "international"), without the Respondent being aware of the Complainants and their BARNES marks, must be very small indeed. In the absence of any Response, the Panel finds that the Respondent very probably *was* aware of the Complainants and their various BARNES marks, and that he registered the disputed domain name with the knowledge that some Internet users who were familiar with the Complainants and their services would incorrectly assume that any

website (or email address) at the disputed domain name would be a website or email address operated or controlled by the Complainants. It is difficult in those circumstances to conceive of any *bona fide* use the Respondent might make of the disputed domain name.

Having regard to those considerations, and in the absence of any Response, the Panel concludes that the disputed domain name was probably registered or acquired by the Respondent for the bad faith purpose of deriving financial gain from the deliberate creation of confusion between the disputed domain name and the Complainants' BARNES marks.

Paragraph 4(a)(iii) of the Policy also requires the Complainant to prove that the disputed domain name is being *used* in bad faith. That might be thought to create a difficulty where no actual use has been made of a disputed domain name. However, UDRP panels have consistently held that mere passive holding of a disputed domain name may constitute bad faith use of that domain name, if certain factors are present.

The consensus view of WIPO panels on the issue of "passive holding" (that is, registration with no subsequent active use), is summarized in [WIPO Overview 3.0](#) as follows:⁸

"From the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding. While panelists will look at the totality of the circumstances in each case, factors which 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."

Each of those factors does appear to be present in this case.

First, the Complainants have been operating their business for approximately 20 years under the BARNES marks, in 15 countries. The services offered under the mark are luxury, "top-end" services, and the Complainants' Global Property Handbook 2022 describes the Barnes group as a "leading international player in high-end residential real estate". The Panel accepts that over the last 20-plus years the BARNES marks would have acquired a high level of distinctiveness for the services offered under them, in France and in a number of other countries. The BARNES marks would therefore seem to be an attractive target for an abusive domain name registrant seeking to ride on the back of the Complainants' reputation in their marks, or to target the Complainants' customers with phishing, or similar bad faith activities.

Secondly, the Respondent has failed to submit any Response, and he has failed to suggest any good faith use to which the disputed domain name might be put.

Thirdly, the Registrar's Whois database available to the Complainant did not disclose the Respondent's name and contact details: they showed the registrant as "Redacted for Privacy". The Respondent's identity was therefore concealed when the disputed domain name was registered (his name and contact details were only disclosed, by the Registrar, when the Center sent its usual verification request to the Registrar).

Fourthly, and for the reasons stated above, it is difficult to conceive of any good faith use the Respondent might make of the disputed domain name. Any Internet user who is familiar with the Complainants and their services could easily miss the transposition of the letters in "interantional", and inevitably some would mistakenly believe that any online activity at or from the disputed domain name (website or emails) has been undertaken by the Complainants.

⁸ [WIPO Overview 3.0](#), section 3.3.

The circumstances of this case may not fall clearly within any of the subparagraphs of paragraph 4(b) of the Policy, but those paragraphs are only illustrative of the circumstances that may constitute bad faith registration and use. They are not intended to provide an exhaustive list of the circumstances that will qualify as bad faith registration and use.⁹

Having regard to those considerations, and in the absence of any Response, the Panel concludes that the disputed domain name has been (passively) used by the Respondent in bad faith, and that the Complainants have therefore satisfied both the bad faith registration and bad faith use elements of paragraph 4(a)(iii) of the Policy.

The Complainants having satisfied each of the three elements of paragraph 4(a) of the Policy, there will be an order transferring the disputed domain name to the first-named Complainant Barnes Europe Consulting Kft. (as requested by the Complainants).

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules and as requested by the Complainants, the Panel orders that the disputed domain name, <barnes-interantional.com>, be transferred to the first-named Complainant Barnes Europe Consulting Kft.

/Warwick Smith/

Warwick Smith

Sole Panelist

Date: April 28, 2023

⁹ *Aria Foods Ambg v. Michael Guthrie*, M. Guthrie Building Solutions WIPO Case No. [D2016-2213](#); and *Tetra Laval Holdings & Finance S.A. v. Evelyn Bryant, Glen Cleaning*, WIPO Case No. [D2022-4264](#).