

ADMINISTRATIVE PANEL DECISION

Barrick Gold North America, Inc., Barrick Gold Corporation v. Paul Buckley
Case No. D2023-1533

1. The Parties

The Complainants are Barrick Gold of North America, Inc. a Delaware corporation and Barrick Gold Corporation a Canadian corporation both represented by Dorsey & Whitney, LLP, United States of America. For the purposes of the decision they are together referred to as the Complainant.

The Respondent is Paul Buckley, South Africa.

2. The Domain Name and Registrar

The disputed domain name <barricklumwanazm.com> is registered with eNom, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 6, 2023. On April 11, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 11, 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 (Whois Agent (632371283)) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 12, 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 13, 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 17, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 7, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 8, 2023.

The Center appointed Clive Duncan Thorne as the sole panelist in this matter on May 17, 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 and its group comprise one of the largest gold mining operations in the world. It has traded using the mark BARRICK in connection with gold and copper mining and precious metal goods and services in over thirteen countries since at least 1983.

In particular the Complainant is the owner and operator of a copper mine in Zambia which is known as the "Lumwana" copper mine. It is located in the town of Lumwana which was built to service and as a resource for the mine. At Annex 7 to the Complaint is set out a website extract regarding the mine. The Complainant acquired a 100% interest in the mine in 2011. Since then the term LUMWANA has been exclusively used to refer to the Complainant's operations at the mine.

The term LUMWANA is frequently used in conjunction with the Complainant's name BARRICK. This can be seen from the extract from the BARRICK LUMWANA Facebook page dedicated to the Lumwana mine and exhibited at Annex 8 to the Complaint. The Complainant submits on the basis of its use of the term LUMWANA that it has developed significant common law rights in LUMWANA as a mark and that it has become distinctive of the Complainant. The consumer public exclusively associates the mark LUMWANA with the Complainant and its services.

The Complainant sets out in the Complaint evidence of its trade mark rights in the mark BARRICK and variations of the mark in the United States ("US"), Canada and the European Union ("EU"). Copies of the certificates of registration of the marks relied upon are set out at Annex 4 to the Complaint. These include;

- US Registration 4578245 dated August 5, 2014 in classes 37 and 42 BARRICK and device
- US Registration 4683358 dated February 10, 2015 in class 42 BARRICK GOLD
- US Registration 4944505 dated April 26, 2016 in class 37 BARRICK GOLD
- US Registration 6039563 dated April 28, 2020 in classes 37 and 42 BARRICK NEVADA and device
- US Registration 6077368 dated June 16, 2020 in classes 37 and 42 BARRICK NEVADA
- US Registration 6225225 dated December 22, 2020 in classes 6, 14, 37 and 42 BARRICK
- US Registration 6592636 dated December 21, 2021 in classes 14, 37 and 42 BARRICK
- Canada Registration 1817567 dated November 14, 2019 in classes 37 and 42 BARRICK NEVADA
- Canada Registration 1534965 dated September 18, 2013 in classes 35, 36, 37, 40 and 42 BARRICK GOLD
- Canada Registration 1534964 dated September 18, 2013 in classes 35, 36, 37, 40 and 42 BARRICK and device
- Canada Registration 1941491 dated January 18, 2019 in classes 14, 37 and 42 BARRICK
- EU Registration 008890386 dated August 10, 2020 in classes 6, 14 and 37 BARRICK
- EU Registration 016268989 dated January 19, 2017 in classes 37 and 42 BARRICK NEVADA

- EU Registration 016304925 dated February 1, 2017 in classes 37 and 42 BARRICK NEVADA
- EU Registration 018012698 dated July 3, 2019 in classes 14, 37 and 42 BARRICK

All of the above registrations predate the date of registration of the disputed domain name on February 20, 2023.

The Complainant advertises and promotes its goods and services online using the BARRICK marks. Since 1995 the Complainant and its affiliates have also used the domain name <barrick.com> to advertise and promote a variety of mining services, business initiatives, and other commercial endeavours involving the BARRICK marks. A copy of the Complainant's website is exhibited at Annex 5 to the Complaint which shows this and its mining operations worldwide.

The BARRICK marks are prominently used on social media. The Complainant's LinkedIn page has over 601,000 followers and maintains a variety of content involving the BARRICK marks. Other social media platforms with similar promotional content are maintained on Facebook.com with over 193,000 followers and Twitter.com with over 58,000 followers. Copies of these pages are exhibited at Annex 6.

The Complainant conducts business under the trade name BARRICK GOLD as well as the BARRICK marks. In summary and due to its trading success in the mining of gold, copper, and other precious metals the Complainant submits that it has developed a tremendous trading goodwill and name recognition amongst a large base of commercial and consumer industries, including banking and professional and personal investment communities.

In the absence of a Response and evidence to the contrary the Panel is satisfied on the basis of the above evidence that the Complainant has acquired a trading goodwill and common law in the mark BARRICK as a result of its trading using the mark since 1983 and owns registered trade mark rights in the marks; BARRICK, BARRICK GOLD, and BARRICK NEVADA. It has also acquired through long use a trading goodwill and common law rights in the mark LUMWANA.

5. Parties' Contentions

A. Complainant

The Complainant submits;

- i. The Complainant owns registered and unregistered trade mark rights in the mark BARRICK and common law rights in the mark LUMWANA which predate the date of registration of the disputed domain name.
- ii. The disputed domain name is confusingly similar to the mark BARRICK.
- iii. There is no evidence that the Respondent has rights or legitimate interests in respect of the disputed domain name. To the contrary the evidence shows the Respondent is using the domain name for fraudulent phishing activity.
- iv. On the evidence adduced by the Complainant the disputed domain name was registered and is being used in bad faith.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Panel has found on the basis of the evidence of the Complainant's trade mark rights set out in section 4 above that it owns registered rights in the US, Canada and the EU in the mark BARRICK. It has also found that the Complainant has developed common law or unregistered trade mark rights in the mark LUMWANA.

The disputed domain name <barricklumwanazm.com> consists of the mark BARRICK immediately followed by the mark LUMWANA. In addition to "barrick" and "lumwana" the disputed domain name consists of the letters "zm". The Complainant considers that this combination is intended to reference the copper mine which it operates in Zambia. The inclusion or addition of these terms does not prevent a finding of confusing similarity. See section 1.8 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Importantly, the Complainant's marks are readily recognizable in the disputed domain name. See section 1.7 of [WIPO Overview 3.0](#).

The domain name also consists of the non-distinctive generic top level domain ("gTLD") ".com" which on the basis of established authority the Panel should and does disregard for the purpose of deciding confusing similarity.

Accordingly the Panel finds that the disputed domain name is confusingly similar to the Complainant's registered trade mark BARRICK within paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant submits that there is no evidence that the Respondent has any rights or legitimate interests in the disputed domain name but that the evidence shows that the Respondent is using the domain name for perpetrating a fraudulent phishing scheme. That is sufficient to show that the Respondent is not making a legitimate or fair use of the domain name.

The Complaint points out that;

- i. The Respondent is not a licensee of the Complainant nor has the Complainant otherwise authorized the Respondent to register the disputed domain name;
- ii. There is no relationship or affiliation between the Complainant and the Respondent;
- iii. The Respondent is not commonly known by the domain name nor has he commonly been known as "BARRICK".

The evidence adduced by the Complainant shows that as of March 21, 2023 (one month after the registration of the disputed domain name) no website resolves to the disputed domain name. There is however a "landing page" a copy of which is exhibited at Annex 3 to the Complaint which underneath the disputed domain name states; "Something amazing will be constructed here ...". In the Panel's view this suggests an intention to create a website using the disputed domain name.

It was then brought to the Complainant's attention that the Respondent was using the email address <@barricklumwanazm.com> to send out fake requests for quotations using the Complainant's marks BARRICK and LUMWANA and purporting to be the Complainant. This appeared to be an impersonation of the Complainant's employees who exclusively use the email address <@barrick.com>.

At Annex 9 to the Complaint the Complainant exhibits a phishing email sent to an associated vendor from the email address <[email address]@barricklumwanazm.com> inviting the recipient "to be a supplier with us at the Lumwana Copper Mine". This was forwarded to the Complainant by the vendor.

The email's signature block includes a name along with the Complainant's actual address and a copy of the BARRICK logo with the added moniker "Lumwana" which the Complainant uses to brand its LUMWANA mining services. The Complainant in fact has an actual employee whose LinkedIn profile is printed at Annex 10. The Complainant submits that this document is evidence of phishing by the Respondent who is attempting to deceive suppliers into providing it with equipment, goods or related services without payment whilst purporting to be the Complainant.

The Complainant submits that this is clear evidence of illegitimate activities so as to prove that the Respondent does not have rights or legitimate interests in the disputed domain name.

The Respondent's use of the disputed domain name is an attempt to pass itself off as the Complainant or at least a Complainant -authorized entity by impersonating an existing employee, the use of the Complainant's logo BARRICK, its Zambia address, its trade marks BARRICK and LUMWANA and the email address "@barricklumwanazm.com".

In the Panel's view this evidence (and there is no evidence to the contrary from the Respondent) establishes that the Respondent is not making a legitimate or fair use of the disputed domain name. The Panel follows section 2.13.1 of the [WIPO Overview 3.0](#) which is cited by the Complainant and which states that;

"Panels have categorically held that the use of a domain name for illegal activity (eg. the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/ hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent."

It follows that the Panel finds that the Respondent has no rights or interests in respect of the disputed domain name within paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Complainant submits that the Respondent registered the disputed domain name without any *bona fide* basis for such registration in an attempt to capitalize unfairly on the goodwill of the Complainant's marks BARRICK and LUMWANA.

It relies upon the fact that prior panels have held that bad faith is to be found if it is unlikely that the registrant would have selected the domain name without knowing of the reputation of the trade mark in question. This is particularly so where the complainant's trade mark is well known as is the position in this case with the mark BARRICK.

In the Complainant's view it is inconceivable that the Respondent registered the disputed domain name containing the well-known and distinctive mark BARRICK without the intent of capitalizing upon the goodwill of the mark. This is further evidenced by the use of the BARRICK logo in the signature block of the phishing email and the impersonation of the Complainant's employee.

The Panel agrees with the Complainant's submissions on the evidence that the Respondent undoubtedly registered the disputed domain name;

- i. with the specific intent to cause consumer confusion and to free ride on the vast, internationally - recognized goodwill associated with the BARRICK marks; and/or
- ii. for the purpose of creating the false impression that the Respondent is member, licensee, or representative of the Complainant, which the Respondent is not.

The Panel is satisfied on the evidence of the Respondent's phishing activity set out in Section 6B above (and with no evidence to the contrary) that the Respondent is using the BARRICK marks and registered the disputed domain name in bad faith to pass itself off as the Complainant.

The Respondent's conduct falls within [WIPO Overview 3.0](#), section 3.1 which is cited by the Complainant which states;

"Bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark."

The Panel, in the absence of a Response finds that the disputed domain name was registered and is being used in bad faith within 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, <barricklumwanazm.com> be transferred to the Complainant.

/Clive Duncan Thorne/

Clive Duncan Thorne

Sole Panelist

Date: May 31, 2023