

ADMINISTRATIVE PANEL DECISION

Barnes Europe Consulting Kft. and Heidi Barnes-Watson v. James Peterson Case No. D2023-3609

1. The Parties

Complainants are Barnes Europe Consulting Kft., Hungary and Heidi Barnes-Watson, United States of America (US), represented by MIIP MADE IN IP, France.

Respondent is James Peterson, US.

2. The Domain Names and Registrar

The disputed domain names <barnes-beverlyhills.com>, <barnes-hawaii.com>, <barnes-seattle.com>, <barnes-toronto.com> and <barnes-vancouver.com> (the “Domain Names”) are registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 28, 2023. On August 29, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Names. On August 31, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Names which differed from the named Respondent (Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to Complainant on September 1, 2023, providing the registrant and contact information disclosed by the Registrar and inviting Complainants to submit an amendment to the Complaint. Complainants filed an amended Complaint on September 1, 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 Respondent of the Complaint, and the proceedings commenced on September 4, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 24, 2023. Respondent did not submit a formal response, however sent an email communication to the Center on September 7, 2023. On October 3, 2023, the Center informed the parties that it will proceed to panel appointment.

The Center appointed Harrie R. Samaras as the sole panelist in this matter on October 6, 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

Complainants operate real estate agencies as well as a range of other luxury services, including private jet and yacht charter, art advisory, interior decoration, and wine brokerage services worldwide under the BARNES Mark. They operate their real estate business in over 15 countries and 60 locations.

Complainants jointly own trademark registrations for the BARNES Mark (or the “Mark”) including: French trademark registration No. 3861673 (registered September 26, 2011); International trademark registration No. 1114909 (registered March 13, 2012) and United Kingdom (“UK”) trademark registration No. UK00801114909 (registered March 26, 2013).

Complainants also own the following domain names: <barnes-international.com> (which it uses in conjunction with its official website); <barnes-newyork.com>; <barnes-london.com>; and <barnes-miami.com>.

The Domain Names were all registered on February 7, 2023, and they resolve to web pages with Pay-Per-Click (“PPC”) links that take the public to websites selling various products and services. For example, the <barnes-beverlyhills.com> Domain Name currently resolves to a site with links to “cosmetic surgery”, “liposuction surgery” and “liposuction surgery cost”. The link to “cosmetic surgery” resolves to a website for the facial filler product Juvéderm. The Domain Name <barnes-hawaii.com> currently resolves to a webpage with links to “tour packages”, “travel tour packages” and “Hawaii vacation packages”. The link to “tour packages” resolves to a website offering travel packages to Canada. And, the Domain Name <barnes-seattle.com> currently resolves to a webpage with links to “Seattle Hotels Downtown”, “Barns” and “Paramount Theater Seattle”. The link to “Barns” resolves to a website that sells barn construction services.

5. Parties’ Contentions

A. Complainants

The Domain Names are composed of Complainants’ BARNES Mark adding the geographical terms “seattle”, “beverlyhills”, “hawaii”, “toronto”, or “vancouver”. Both elements are separated with a hyphen. Because the Mark is the first and most prominent element of the Domain Names, the public will think that Complainants own them. Adding the geographical terms does not negate the confusing similarity between the Domain Names and the Mark. Also, adding such terms to identify a location where Complainants have or could have a presence increases the likelihood of confusion.

Respondent has no rights to the BARNES Mark. According to the Global Brand Database, Respondent did not file or register any trademark registrations for the Domain Names. There is no business or legal relationship between Complainants and Respondent. Complainants have neither authorized nor licensed Respondent to use the Mark in any way. Furthermore, the Domain Names are not used thus, Respondent has no legitimate interest in registering or using them. Using a domain name to host a parking page comprising PPC links, like Respondent has done here, does not represent a *bona fide* offering. Furthermore, given the reputation of the BARNES Mark and the addition of the geographic identifiers (likely meant to be associated with Complainants’ activities), it would be difficult to imagine an actual use of the Domain Names that would not be aimed to free ride on the reputation of Complainants and their Mark.

The BARNES Mark is well-known in France and in several countries. Complainants operate real estate agencies as well as a range of other luxury services worldwide under the Mark. Founded over 20 years ago, Complainants are leading international players in high-end residential real estate, established in the world's most popular cities and top holiday destinations.

When registering the Domain Names, Respondent employed a privacy service to hide its identity and to avoid being notified of a UDRP proceeding. This is an inference of bad faith. The Domain Names were registered with the aim of taking advantage of the reputation of the BARNES Mark, pointing to parking pages to mislead consumers and, in all likelihood, to divert Complainants' customers and financially gain from that.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

A. Procedural Issues – Joint Complainants and Multiple Domain Names

Complainants ask for an order consolidating their respective complaints against Respondent on the basis that they have a common grievance against Respondent and a common legal interest in relevant rights that are affected by Respondent's conduct. Also, Complainants request that the Panel consolidate the disputes for the Domain Names registered by Respondent.

Paragraph 3(c) of the Rules provides that a complaint may relate to more than one domain name, provided that the same domain name holder registers the domain names. Paragraph 4(f) of the Policy provides that where there are multiple disputes between a complainant and respondent, either party may petition to consolidate the disputes before a single administrative panel. Under paragraph 10(e) of the Rules, it is for the panel to decide a request by a party to consolidate multiple domain name disputes in accordance with the Policy and Rules.

(1) Joint Complainants

To file a single complaint by multiple complainants or against multiple respondents, the complaint must meet the following criteria: (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. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.11.1.

The Panel is satisfied that Complainants have fulfilled the above-referenced standard. Complainants co-own the BARNES Mark upon which this proceeding is based and the Domain Names target those rights. This constitutes a specific common grievance against Respondent. Likewise, Respondent has engaged in common conduct (Domain Names all resolve to webpages with PPC links) that has affected Complainants in a similar fashion. Furthermore, Complainants' respective claims against Respondent are essentially identical, thus it will be equitable and procedurally efficient to consolidate their claims in this proceeding. Accordingly, the Panel grants Complainants' request to consolidate.

(2) Multiple Domain Names

To file a single complaint against multiple respondents, the complaint must meet the following criteria: (i) the domain names or corresponding websites are subject to common control, and (ii) it would be equitable and procedurally efficient to permit the consolidation. See [WIPO Overview 3.0](#), section 4.11.2.

The Panel finds that Complainants satisfy both parts of the above-mentioned test. With regard to part (1):

1. The Domain Names are registered with the same Registrar, namely GoDaddy.com, LLC.
2. The Domain Names were registered the same day – February 7, 2023.
3. The contact information available on the Whois database for the registrant is the same.
4. The Domain Names were registered by the same person – James Peterson.
5. The Domain Names share the same structure, namely BARNES + geographic identifier.

Regarding the second part of the test, it would be unfair to require Complainants to file separate complaints against Respondent because it is clear that the Domain Names are connected and under the same control. For the aforementioned reasons, Complainant's consolidation request is granted.

B. Identical or Confusingly Similar

Complainants have established rights in the Mark based on the aforementioned French, UK and International registrations for the BARNES Mark.

The Domain Names <barnes-beverlyhills.com>; <barnes-hawaii.com>; <barnes-seattle.com>; <barnes-toronto.com>; <barnes-vancouver.com> are confusingly similar to Complainants' BARNES Mark because: Complainants' Mark is clearly recognizable within the Domain Names; the Top-Level Domains are typically not determinative in establishing whether the Domain Names are confusingly similar to the Mark; and adding the geographic identifiers "Beverly Hills"; "Hawaii"; "Seattle"; "Toronto"; and "Vancouver" and hyphens do not prevent a finding of confusing similarity with the BARNES Mark. See, [WIPO Overview 3.0](#), section 1.8 ("Where the relevant trademark 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.").

For the foregoing reasons, the Panel finds that Policy, paragraph 4(a)(i) has been satisfied.

C. Rights or Legitimate Interests

Complainants maintain: (1) they have not given any authorization to Respondent to use the BARNES Mark for any purpose; (2) Respondent does not have any rights in the BARNES Mark; (3) Respondent is not using the Mark; and (4) under the circumstances here, Respondent's use of the Domain Names to host parked pages with PPC links is not a *bona fide* offering of goods or services.

Where, as here, Complainant has raised a *prima facie* presumption of Respondent's lack of any rights or legitimate interests in the Domain Names, and Respondent has failed to rebut that presumption, the Panel is satisfied that Complainant has carried its burden of proving that Respondent has no rights or legitimate interests in the Domain Names within the meaning of paragraph 4(a)(ii) of the Policy.

D. Registered and Used in Bad Faith

Respondent registered five Domain Names that are confusingly similar to the BARNES Mark. When Respondent registered the Domain Names on February 7, 2023, Complainants had been using the Mark since at least 2011 internationally. It is highly likely that Respondent was aware of the Mark when it registered the Domain Names because: (1) Respondent has not shown that he has any rights or legitimate interests in the Domain Names; (2) Respondent registered the Domain Names that are confusingly similar to Complainants' registered Mark; (3) Respondent registered five similar Domain Names simply adding different geographic identifiers to the Mark; and (4) Respondent has copied Complainants' strategy of registering domain names having geographic identifiers (*i.e.*, Complainants' domain names are: <barnes-international.com>; <barnes-newyork.com>; <barnes-london.com>; and <barnes-miami.com>). On the uncontroverted evidence, the Panel finds that Respondent registered the Domain Names knowing of Complainants and their rights in the BARNES Mark.

Furthermore, Respondent's use of the Domain Names for commercial gain (*i.e.*, PPC links directing website visitors to third party websites selling various products and services), strongly suggests that Respondent's intent in registering the Domain Names was to profit in some fashion from or otherwise commercially exploit Complainants' BARNES Mark. There is no plausible reason for Respondent's registration of five Domain Names that are confusingly similar to the BARNES Mark, in which Respondent has no rights or legitimate interests, other than as a deliberate attempt to profit unfairly from confusion with the Mark. See *Government Employees Insurance Company v. Domain Hostmaster, Whois Privacy Services Pty Ltd. / Lisa Katz, Domain Protection LLC*, WIPO Case No. [D2016-1275](#) (transferring <geicorewards.com> to the complainant and finding the respondent's use of the domain name to offer click through links to insurance services of the complainant's competitors is evidence of bad faith).

Given these circumstances, Respondent's failure to submit a formal response or to provide any evidence of actual or contemplated good-faith use, and Respondent's concealment of his identity via the use of a privacy service, the Panel is left to conclude that Respondent's registration and use of the Domain Names is in bad faith.

For the foregoing reasons, the Panel finds that paragraph 4(a)(iii) of the Policy has been 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 Domain Names <barnes-beverlyhills.com>; <barnes-hawaii.com>; <barnes-seattle.com>; <barnes-toronto.com>; <barnes-vancouver.com> be transferred to Complainants.

/Harrie R. Samaras/

Harrie R. Samaras

Sole Panelist

Date: October 18, 2023