

## **ADMINISTRATIVE PANEL DECISION**

**Barrick Gold of North America, Inc. and Barrick Gold Corporation v. Omar Faruk Fahad**

**Case No. D2024-0063**

### **1. The Parties**

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

The Respondent is Omar Faruk Fahad, Bangladesh.

### **2. The Domain Name and Registrar**

The disputed domain name <barrickgold.xyz> is registered with NameSilo, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 9, 2024. On January 9, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 9, 2024, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the 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 January 12, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 1, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 5, 2024.

The Center appointed Anna Carabelli as the sole panelist in this matter on February 9, 2024. 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 Barrick Gold of North America Inc. and Barrick Gold Corporation are part of a large gold mining operations group, active in over thirteen countries since at least as early as 1983.

The Complainant Barrick Gold Corporation is the owner of numerous trademark registrations all over the world, consisting of, or containing the word element BARRICK, including, but not limited to the following registrations:

- United States trademark registration No. 4578245 for the design mark BARRICK, registered on August 5, 2014, based on a claimed date of first use of January 1995, in Class 37 (amongst others, for services related to “gold mining extraction and mining of silver, copper and base metals) and in Class 42 (amongst others, for services related to “mine design and engineering in the field of mine exploration of precious and base metals”);
- United States trademark registration No. 4683358 for the word mark BARRICK GOLD, registered on February 10, 2015, in Class 42;
- United States trademark registration No. 4944505 for the word mark BARRICK GOLD, registered on April 26, 2016, in Class 37;
- Canadian trademark registration No. TMA1063113 for the word trademark BARRICK NEVADA, registered on November 14, 2019, in Classes 37 and 42;
- European Union trademark registration No. 008890386 for the word mark BARRICK, registered on August 10, 2010, in Classes 6,14, and 37.

(Hereinafter also collectively referred to as BARRICK Trademark).

The Complainants conduct business under the “Barrick Gold” trade name as well as the BARRICK Trademark. They actively advertise and promote their mining services and business initiatives through their official website at the domain name <barrick.com> (registered on October 6, 1995) and on social media.

The disputed domain name was registered on July 16, 2023. The uncontested evidence submitted with the Complaint shows that the disputed domain name resolved to a webpage featuring in the top the words “BARRICK GOLD - HOME”, and displaying a login screen which prompts the website visitors to input login credentials. At the time of this decision the disputed domain name resolves to an inactive webpage stating, “This site can't be reached”.

#### **5. Parties' Contentions**

##### **A. Complainants**

The Complainants contend that they have satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainants contend that:

- Due to extensive use and advertising associated with the BARRICK Trademark worldwide, the Complainants and their affiliates and subsidiaries enjoy substantial goodwill and name recognition in many regions around the world;
- The disputed domain name is identical or confusingly similar to a trademark in which the Complainants have rights, since it consists of the Complainants' BARRICK mark immediately followed by the descriptive term “gold”, which is identical to the Complainants' BARRICK GOLD mark;

- The Respondent has no rights or legitimate interests in the disputed domain name since: (i) the Complainants have not authorized or somehow given consent to the Respondent to register and use the disputed domain name, (ii) the Respondent is not commonly known by the disputed domain name, and (iii) the Respondent's use of the disputed domain name is neither a bona fide offering of goods or services nor a legitimate noncommercial or fair use. The Respondent has instead used the disputed domain name with the intent to mislead the Complainants' target market for commercial gain through intentionally misleading itself as affiliated with, connected to, or endorsed by the Complainants;
- The disputed domain name was registered and is being used in bad faith. The Respondent registered the disputed domain name having in mind the Complainants' BARRICK Trademark, with the clear intention to create an association with and take advantage of the Complainant's widely known trademark. The Respondent may be attempting to steal website visitors' sensitive login credentials under the false pretense that it is affiliated with, endorsed by, or otherwise connected to the Complainants, when that is not the case.

Based on the above, the Complainants request the disputed domain name be transferred to the Complainants.

## **B. Respondent**

The Respondent did not reply to the Complainants' contentions.

## **6. Discussion and Findings**

### **6.1 Preliminary Issue – Consolidation - Multiple Complainants**

Paragraph 10(e) of the UDRP Rules grants a panel the power to consolidate multiple domain name disputes. 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. (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.11.1).

In the present case, the Complainants are part of the same gold mining operations group. They both operate under the "Barrick Gold" trade name that is also used in their corporate names, and have a common interest in the BARRICK Trademark. The Panel finds that there is sufficient nexus to allow them to bring this Complaint as joint complainants (hereinafter collectively referred to as "Complainant"). In these circumstances consolidation would be equitable and procedurally efficient.

### **6.2 Substantive Issues**

Paragraph 15(a) of the Rules instructs the panel to decide the complaint based on the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

Under paragraph 4(a) of the Policy, the complainant must prove each of the following:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- (ii) the respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

Paragraph 4(b) of the Policy sets out four illustrative circumstances, which for the purposes of paragraph 4(a)(iii) of the Policy, shall be evidence of registration and use of a domain name in bad faith.

Paragraph 4(c) of the Policy sets out three illustrative circumstances any one of which, if proved by the respondent, shall be evidence of the respondent's rights to or legitimate interests in a disputed domain name for the purpose of paragraph 4(a)(ii) of the Policy above.

#### **A. Identical or Confusingly Similar**

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the Complainant's registered marks BARRICK and BARRICK GOLD are reproduced within the disputed domain name. Accordingly, the disputed domain name is identical to the BARRICK GOLD mark and confusingly similar with the Complainant's BARRICK marks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. The generic Top-Level Domain such as ".xyz" is viewed as a standard registration requirement and as such is typically disregarded under the first element confusing similarity test. [WIPO Overview 3.0](#), section 1.11.1.

The Panel finds the first element of the Policy has been established.

#### **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although 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 difficult 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 (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

Moreover, the disputed domain name is identical to the Complainant's BARRICK GOLD mark and confusingly similar to the Complainant's BARRICK Trademark and carries a risk of implied affiliation with the Complainant. Such a risk for implied affiliation cannot constitute fair use. [WIPO Overview 3.0](#), section 2.5.1.

The Panel also notes that according to the evidence submitted by the Complainant - which has not been challenged by the Respondent - the disputed domain name resolved to a webpage headed "BARRICK GOLD-HOME" displaying a login screen which prompts the website visitors to input login credentials. This suggests an actual or intended use of the disputed domain name by the Respondent to deceive Internet users and obtain personal information from them.

Panels have held that the use of a domain name for illegal activity such as phishing, impersonation/passing off or other types of fraud can never confer rights or legitimate interests on a respondent.

[WIPO Overview 3.0](#), section 2.13.1.

The Panel finds the second element of the Policy has been established.

### **C. Registered and Used in Bad Faith**

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Complainant's BARRICK Trademark has been continuously and extensively used for many years and have as a result acquired reputation and goodwill worldwide. It is difficult to believe that the Respondent did not have in mind the Complainant's BARRICK Trademark when registering the disputed domain name. Prior panels have consistently found that 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 ([WIPO Overview 3.0](#), section 3.1.4).

The fact that the Respondent used the disputed domain name following registration, to resolve to a login page which contained the Complainant's marks and trade name, establishes both an awareness by the Respondent of the Complainant's rights as at the date of registration of the disputed domain name and an intention on its part to take unfair advantage of those rights in some manner.

The circumstance at paragraph 4(b)(iv) of the Policy, is that, by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website. The evidence submitted with the Complaint shows that the disputed domain name pointed to a webpage which by its form and content would signify to Internet users that it was operated by the Complainant. Such a belief will have been reinforced because of the confusing similarity between the disputed domain name and the Complainant's BARRICK Trademark and trade name, which accentuates the false impression of a connection with the Complainant's business and increases the likelihood of confusion to Internet users.

At the time of this decision the disputed domain name appears inactive, pointing to a webpage stating, "This site can't be reached".

Panels 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. Although panelists 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, and (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3.

Having reviewed the available record, the Panel notes the reputation of the Complainant's trademark as an international established mark, the composition of the disputed domain name as discussed above, the failure of the Respondent to submit a response, and finds that in the circumstances of this case the current inactive status of the disputed domain name does not prevent a finding of bad faith under the Policy.

The Panel finds that the Complainant has established the third element 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 <barrickgold.xyz> be transferred to the Complainant.

*/Anna Carabelli/*

**Anna Carabelli**

Sole Panelist

Date: February 23, 2024