

## **ADMINISTRATIVE PANEL DECISION**

Barrick Gold of North America, Inc. and Barrick Gold Corporation v.

Michel Tee

Case No. D2024-0064

### **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 Michel Tee, Nigeria.

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

The disputed domain name <barrickgolds.com> is registered with Hosting Concepts B.V. d/b/a Registrar.eu. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 8, 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 disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Redacted for Privacy, Whois Privacy Protection Foundation) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 16, 2024, 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 January 16, 2024.

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 January 19, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 8, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 13, 2024.

The Center appointed Anna Carabelli as the sole panelist in this matter on February 15, 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 Complainants Barrick Gold of North America Inc. and Barrick Gold Corporation are part of a large gold and copper 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;
- United States trademark registration No. 6225225 for the word trademark BARRICK, registered on December 22, 2020, in Classes 6, 14, 37 and 42;
- United States trademark registration No. 6592636 for the design mark BARRICK, registered on December 21, 2021, in Classes 14, 37 and 42;
- 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 May 23, 2023.

The uncontested evidence submitted with the Complaint shows that the disputed domain name resolved to a website allegedly selling rare coins, gold and silver, with the ability to invest in these resources. This website featured the Complainant’s BARRICK mark and logo with the descriptive term “GOLD” edited underneath it, used in a similar manner as the Complainant’s own website.

#### **5. Parties’ Contentions**

##### **A. Complainant**

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 Trademark immediately followed by the descriptive term "golds", namely the pluralized form of "gold", which the Complainants use for their trade name, and is a descriptive term which immediately identified the services the Complainants offer;
- 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 Complainants' widely known trademark, and mislead consumers into believing the website at the disputed domain name is affiliated with the Complainants;
- The circumstances of the case suggest that the Respondent may be attempting to use the disputed domain name for illicit activities by inducing consumers into sending money for the purported purchase of actual coins of value under the Complainants' reputation. In this connection the Complainants contend that a copyright notice appearing in the homepage of the Respondent's website indicates a "Boom Trade Metals" as the purported owner of the website. According to a Google search the company Bloom Trade Metals is involved with the sale of gold, silver, and rare coins but when trying to access the "bloomtrademetals.com" website, the result is an error message that the connection is not private and "attackers might be trying to steal your information from bloomtrademetals.com (for example, passwords, messages or credit cards)".

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 Complainant's 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 disputed domain name consists of the Complainant's BARRICK mark followed by the term "golds", i.e. the pluralized form of the term "gold" which the Complainant uses for its trade name and in its registered trademark BARRICK GOLD.

The entirety of the Complainant's registered BARRICK and BARRICK GOLD marks are reproduced and recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the marks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. The letter "s" added after the term "gold" is a minor difference and does nothing to dispel confusion.

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.

As discussed in par. 6.2(B), the disputed domain is 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 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 website featuring the Complainant's BARRICK trademark and logo with the descriptive term "GOLD" edited underneath it and used in a similar manner as the Complainant's own website, 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 above conduct constitutes opportunistic bad faith registration ([WIPO Overview 3.0](#), section 3.2.), as well as bad faith use of the disputed domain name under the Policy. Indeed, the Respondent has used the disputed domain name to capitalize on the goodwill of the Complainant's BARRICK Trademark, and has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainants' mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website. [WIPO Overview 3.0](#), section 3.1.3.

Under the circumstances of the case as shown by the uncontested evidence in the Complaint, the Panel accepts that the Respondent may be attempting to use the disputed domain name for illegal activities.

Panels have held that the use of a domain name for illegal activity constitutes bad faith. [WIPO Overview 3.0](#), section 3.4.

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 <barrickgolds.com> be transferred to the Complainant.

*/Anna Carabelli/*

**Anna Carabelli**

Sole Panelist

Date: February 29, 2024