

## **ADMINISTRATIVE PANEL DECISION**

**Barrick Gold of North America, Inc. and Barrick Gold Corporation v.  
Nwaba Klaas  
Case No. D2024-0223**

### **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 (“US”).

The Respondent is Nwaba Klaas, South Africa.

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

The disputed domain name <barrickzm.com> is registered with NetEarth One Inc. d/b/a NetEarth (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 18, 2024. On January 19, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 19, 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 24, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 13, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 15, 2024.

The Center appointed Catherine Slater as the sole panelist in this matter on February 20, 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 are part of a group of companies engaged in gold and copper mining around the world. Since 1983, the Complainants, its affiliates, and subsidiaries, have used the trade mark BARRICK in connection with gold and copper mining and precious metal goods and services in more than thirteen countries.

The Complainants own and operate a copper mine located in the town of Lumwana, Zambia.

The Complainants own several trade mark registrations for, and incorporating, the word BARRICK, in various jurisdictions around the world including: -

- European Union ("EU") Registration 008890386 for BARRICK (plain word mark), filed on February 17, 2010, and registered on August 10, 2010, in classes 6, 14, and 37;
- US Registration 6225225 for BARRICK (plain word mark), filed on November 3, 2019, and registered on December 22, 2020, in classes 6, 14, 37, and 42;
- EU Registration 018012698 for BARRICK (figurative mark), filed on January 21, 2019, and registered on July 3, 2019, in classes 14, 37, and 42; and
- US Registration 6592636 for BARRICK (figurative mark), filed on January 18, 2019, and registered on December 21, 2021, in classes 14, 37, and 42.

The aforementioned plain word mark registrations are hereinafter referred to as "the BARRICK mark" and the figurative marks (which comprise the word BARRICK in blue lettering above a gold-coloured elongated triangle shape) are hereinafter referred to as "the BARRICK logo".

Since 1995 the Complainants have operated their website at the domain name <barrick.com>. It is used to advertise and promote a variety of mining services, business initiatives and other commercial endeavors and uses the BARRICK mark and the BARRICK logo.

The disputed domain name was registered on April 25, 2023, and, at the time of filing of the Complaint, resolved to a webpage that displayed the message, "Something amazing will be constructed here...".

#### **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 the disputed domain name is identical or confusingly similar to their BARRICK trade marks, the Complainants' trade name and the <barrick.com> domain name and in particular that:-

- they not only have registered trade mark rights but that the BARRICK mark enjoys substantial goodwill and name recognition in the US and around the world;
- they own and operate a copper mine in Zambia, Africa which is known as the Lumwana copper mine since it is in the town of Lumwana (which was built to service the mine itself);
- for over a decade the term LUMWANA has been used to exclusively reference the Complainants' mining operation at this location in Zambia.

-the widely accepted abbreviation for Zambia is “zm”; and

-the disputed domain name is confusingly similar to the trade mark BARRICK since it consists of that trade mark immediately followed by the descriptive term “zm”, which is the country code for Zambia, in which country the Complainants conduct business.

The Complainants further contend that there is no evidence that the Respondent has rights or legitimate interests in respect of the disputed domain name and in this regard state that: -

-The Complainants’ trade mark registrations and extensive use of the same provide the Respondent with constructive knowledge of the various BARRICK marks;

-The Complainants have not licensed or otherwise authorized the Respondent to register the disputed domain name or otherwise use the BARRICK mark;

-The fact that the disputed domain name is not pointing to an active website does not preclude a finding of bad faith;

-The Respondent is using the disputed domain name as part of an active phishing campaign and is sending e-mails from an address ending “@barrickzm.com” which contain fake purchase orders and vendor registration forms;

-The Respondent is not making legitimate or fair use of the disputed domain name and has instead used the disputed domain name with fraudulent intent for commercial gain by falsely holding itself out as affiliated with, connected to, or endorsed by the Complainants and is attempting to deceive potential vendors into providing equipment or attempting to steal sensitive and confidential information.

The Complainants further contend that the disputed domain name was registered and is being used in bad faith by reason of the following:

-The Respondent had no bona fide basis for registration of the disputed domain name and did so in an attempt to capitalize unfairly on the goodwill of the Complainants’ widely recognized BARRICK mark;

-The Respondent registered the disputed domain name and is using the BARRICK mark and BARRICK logo in bad faith to pass itself off as the Complainants or, at the very least, create an improper affiliation;

-Use of the disputed domain name for phishing purposes supports a finding of bad faith registration and use; and

-The Respondent undoubtedly registered the disputed domain name with the specific intent to cause consumer confusion and to ride on the goodwill associated with the Complainants’ BARRICK marks and/or for the purpose of creating the false impression that the Respondent is a member, licensee or representative of the Complainants.

## **B. Respondent**

The Respondent did not reply to the Complainants’ contentions.

## **6. Discussion and Findings**

### **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 Complainants' trade mark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

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

The entirety of the BARRICK mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms, here, "zm", may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

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 Complainants have established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainants' 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.

In this regard, the Panel finds that there is no evidence that the Respondent has made preparations to use the disputed domain name in connection with a bona fide offering of goods or services, or been commonly known by the disputed domain name, or is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain, to misleadingly divert consumers or to tarnish the trade mark.

Indeed, the Panel finds that use made of the disputed domain name is the opposite of legitimate. The Respondent has used the disputed domain name to engage in a phishing campaign (or at least the impersonation/passing off of the Complainants) and this demonstrates a lack of rights or legitimate interests. The Panel discusses the Respondent's conduct in more detail below.

Panels have held that the use of a domain name for illegal activity here, claimed phishing and/or impersonation/passing off, 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**

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Panels have held that the use of a domain name for illegal activity here, claimed phishing and/or impersonation/passing off constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

In the present case, the Panel notes that the Respondent has composed the disputed domain name by combining the Complainants' BARRICK mark with "zm" which is the country code for Zambia. The reason for that composition is revealed by the use to which the Respondent has then put the disputed domain name, namely a phishing campaign reliant upon convincing others that the e-mails sent are from the Complainants' operation in Zambia.

The Complainants have submitted in evidence an e-mail sent from an address ending "@barrickzm.com". The e-mail purports to be from an individual working at "Barrick Lumwana Zambia Head Office". The e-mail also contains the Complainants' true physical address in Zambia as well as the BARRICK logo above the word LUMWANA. Attached to that e-mail are: -

- a completed Purchase Order form for the purchase, by the Complainants, of electric motors; and
- a "Vendor Registration" form which the recipient is invited to complete.

Both forms bear the BARRICK logo above the word LUMWANA and both forms repeatedly refer to "Barrick Lumwana".

In short, at the time of registering the domain name the Respondent clearly knew of the Complainants and their operations in Zambia and deliberately chose to register a name incorporating the Complainants' BARRICK mark together with the country code designation for Zambia. It has then gone on to use the disputed domain name to create an e-mail with the clear purpose of impersonating (or at least giving the impression of a business connection with) the Complainants in order to conduct a phishing scam where the intention is either to obtain the sensitive business information of a third party or to obtain goods without making payment.

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 <barrickzm.com> be transferred to the Complainants.

*/Catherine Slater/*

**Catherine Slater**

Sole Panelist

Date: March 5, 2024