

## ADMINISTRATIVE PANEL DECISION

Barrick Gold of North America, Inc. and Barrick Gold Corporation v. ren Li  
Case No. D2024-1175

### 1. The Parties

The Complainants are Barrick Gold of North America, Inc. (“the 1<sup>st</sup> Complainant”), United States of America and Barrick Gold Corporation (“the 2<sup>nd</sup> Complainant”), Canada, represented by Dorsey & Whitney, LLP, United States of America.

The Respondent is ren Li, Republic of Korea.

### 2. The Domain Names and Registrar

The disputed domain names <barrickgold1.com>, <barrickgold2.com>, <barrickgold3.com>, <barrickgold4.com>, <barrickgold5.com>, <barrickgold6.com> and <barrickgold7.com> are all registered with GoDaddy.com, LLC (the “Registrar”).

### 3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 18, 2024. On March 19, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On the same day, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names, which differed from the named Respondent (Privacy Protected) and contact information in the Complaint. The Center sent an email communication to the Complainants on March 20, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amended Complaint on the same day.

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 March 21, 2024. In accordance with the Rules, paragraph 5, the due date for Response was April 10, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 11, 2024.

The Center appointed Anne-Virginie La Spada as the sole panelist in this matter on April 18, 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 active in the gold and copper mining industry with operations on several continents.

The Complainants use the domain name <barrick.com>, registered in 1995, to advertise and promote their services.

Among other registrations, the 2<sup>nd</sup> Complainant, Barrick Gold Corporation, owns the following trademark registrations for BARRICK or BARRICK GOLD:

- United States trademark registration for BARRICK no. 6,225,225, registered on December 22, 2020, in classes 6, 14, 37, and 42;
- United States trademark registration for BARRICK GOLD no. 4,683,358, registered on February 10, 2015, in class 42;
- United States trademark registration for BARRICK GOLD no. 4,944,505, registered on April 26, 2016, in class 37; and
- Canadian trademark registration for BARRICK GOLD no. 1534965, registered on September 18, 2013, in classes 35, 36, 37, 40, and 42.

The disputed domain names were registered on October 24, 2023.

The disputed domain names used to resolve to parked pages with sponsored links connected to websites with a content purporting to be related to precious metals or stones (the links displayed indeed wording such as “silver investing”, “gold mining”, “mining company” or “diamond nexus”).

#### **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 names.

Notably, the Complainants contend that the disputed domain names consist of their protected mark BARRICK, immediately followed by the descriptive term “gold,” which is identical to their BARRICK GOLD trademarks, and is a descriptive term used to immediately identify the services the Complainants offer, namely gold mining services. The numbers 1 through 7 in the disputed domain names have no distinguishing value. Therefore, the Complainants contend that the disputed domain names are confusingly similar to their trademarks.

Furthermore, the Complainants contend that the Respondent does not have rights or legitimate interests in the disputed domain names because the Respondent is not a licensee of the Complainants, nor have the Complainants otherwise authorized the Respondent to register domain names including the Complainants' trademarks. According to the Complainants, the Respondent has not been commonly known under the disputed domain names, and the Respondent is not making a legitimate or fair use of the disputed domain names.

Finally, the Complainants contend that the Respondent registered the disputed domain names in an attempt to capitalize unfairly on the goodwill of the Complainants' widely recognized BARRICK trademarks, and that the Respondent has used the disputed domain names 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.

## **B. Respondent**

The Respondent did not reply to the Complainants' contentions.

## **6. Discussion and Findings**

According to paragraph 4(a) of the Policy, a complainant must assert and prove each of the following:

- (i) the domain name registered by the respondent 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 domain name; and
- (iii) the domain name registered by the respondent has been registered and is being used in bad faith.

### **6.1 Consolidation of Complainants**

The Complaint was filed by two Complainants against a single Respondent. Neither the Policy nor the Rules expressly provides for or prohibits the consolidation of multiple complainants. In this regard, WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.11.1, states that:

"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."

The 2<sup>nd</sup> Complainant is the registered owner of the marks BARRICK and BARRICK GOLD. The Complainants mention that the 1<sup>st</sup> Complainant is the assignee and licensee of such trademarks. While the case file does not contain information about the nature of said assignment or license, there is no reason to doubt, in the Panel's opinion, that the Complainants indeed belong to the same group of companies and that the 1<sup>st</sup> Complainant is entitled to use the concerned trademarks in the course of its activities.

The Panel finds accordingly that the Complainants have a specific common grievance against the Respondent as they have a common legal interest in the trademark rights on which this Complaint is based, and it is equitable and procedurally efficient to permit the consolidation of their complaints. The Complainants shall be referred to from now on as the "Complainant".

### **6.2 Substantive issues**

#### **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.

In particular, the Complainant has shown that it owns trademark registrations for the mark BARRICK GOLD.

The entirety of the mark is reproduced within the disputed domain names. Accordingly, the disputed domain names are 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 the numbers “1” to “7”) may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain names 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 Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain names. 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 names such as those enumerated in the Policy or otherwise.

Indeed, no evidence suggests that the Respondent was using or was making demonstrable preparations to use the disputed domain names in connection with any type of bona fide offering of goods or services. Instead, based on the evidence provided by the Complainant, it appears that the Respondent used the disputed domain names in connection with web pages containing pay-per-click (“PPC”) links to third-party websites purportedly offering services competing with those of the Complainant. Applying UDRP paragraph 4(c), UDRP panels have found that the use of a domain name to host a parked page comprising PPC links does not represent a bona fide offering where such links compete with or capitalize on the reputation and goodwill of the complainant’s mark, or otherwise mislead Internet users. [WIPO Overview 3.0](#), section 2.9.

Finally, the Panel may draw from the lack of a Response the inferences that it considers appropriate, according to the Rules, paragraph 14(b). The Panel is of the view that the lack of Response corroborates the absence of rights or legitimate interests of the Respondent in the disputed domain names.

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 trademark BARRICK GOLD is distinctive. The disputed domain names were registered years after the Complainant first registered and used its trademarks. Given the distinctiveness of the Complainant's trademark, and also the presence, on the parked pages previously connected to the disputed domain names, of references to the Complainant's field of activity (including for example "silver investing", "gold mining", "mining company" or "diamond nexus"), the Panel finds it unlikely that the disputed domain names were chosen independently without reference to the Complainant's trademarks. Consequently, the Panel considers that the Respondent could not ignore the existence of the Complainant and of its trademark at the time of the registration of the disputed domain names, such that the disputed domain names were registered in bad faith.

In addition, the presence of sponsored links to (apparently competing) third party websites on the pages to which the disputed domain names resolved supports a finding of use in bad faith. Indeed, the redirection to webpages with sponsored links suggests an intention on the part of the Respondent to exploit and profit from the Complainant's trademark, by attempting to generate financial gains by means of "click through" revenues. Such conduct constitutes bad faith registration and use of the disputed domain names within the meaning of paragraph 4(b)(iv) of the Policy (see F. *Hoffmann-La Roche AG v. James Lee*, WIPO Case No. [D2009-1199](#); *Scania CV AB v. Michael Montrief*, WIPO Case No. [D2009-1149](#); *Aspen Holdings Inc. v. Rick Natsch, Potrero Media Corporation*, WIPO Case No. [D2009-0776](#); and *AllianceBernstein LP v. Texas International Property Associates*, WIPO Case No. [D2008-1230](#)).

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 names, <barrickgold1.com>, <barrickgold2.com>, <barrickgold3.com>, <barrickgold4.com>, <barrickgold5.com>, <barrickgold6.com>, and <barrickgold7.com>, be transferred to the Complainant.

*/Anne-Virginie La Spada/*

**Anne-Virginie La Spada**

Sole Panelist

Date: April 30, 2024