

ADMINISTRATIVE PANEL DECISION

**Barrick Gold of North America, Inc. and Barrick Gold Corporation v. Mui
Laurence Zwane
Case No. D2024-1181**

1. The Parties

The Complainant is Barrick Gold of North America, Inc. and Barrick Gold Corporation, United States of America, represented by Dorsey & Whitney, LLP, United States of America.

The Respondent is Mui Laurence Zwane, South Africa.

2. The Domain Name and Registrar

The disputed domain name <barrickzam.com> is registered with DNS Africa Ltd (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 name. Reminders were sent on March 25, 2024 and March 26, 2024. On April 4, 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) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 9, 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 April 9, 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 April 12, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 11, 2024.

Due to an administrative oversight, it appears that the written notice was not sent on April 12, 2024. The Center sent the written notice on May 6, 2024 and granted the Respondent a five-day period, through May 11, 2024, to indicate whether it wishes to participate in the proceeding. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on May 15, 2024.

The Center appointed Marina Perraki as the sole panelist in this matter on May 27, 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

First Complainant, along with its parent, affiliates and subsidiaries, including Second Complainant (collectively Complainant) is one of the largest gold mining operations in the world. Complainant, and its affiliates and subsidiaries, have used the trademark BARRICK in connection with gold and copper mining and precious metal goods and services in over thirteen countries since at least as early as 1983. Complainant owns and operates a copper mine in Zambia, Africa.

Complainant's group owns trademark registrations for BARRICK, including the United States of America Trademark Registration No. 4578245, BARRICK (figurative), filed on June 1, 2012, with priority August 7, 2011, and registered on August 5, 2014, for goods and services in international classes 37 and 42; and the United States of America Trademark Registration No. 6225225, BARRICK (word), filed on March 11, 2019 and registered on December 22, 2020, for goods and services in international classes 6, 14, 37 and 42.

Complainant has used the domain name <barrick.com> since 1995 to host its website and advertise and promote a variety of mining services, business initiatives, and other commercial endeavors under the BARRICK trademarks. Complainant's LinkedIn page has over 601,000 followers, Facebook page over 193,000 followers, and Twitter over 58,000 followers.

The Domain Name was registered on December 14, 2023, and leads to a parking page indicating the website is currently under construction stating that "something amazing will be constructed here".

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

Paragraph 4(a) of the Policy lists the three elements which Complainant must satisfy with respect to the Domain Name:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name has been registered or is being used in bad faith.

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 of WIPO Panel Views on Selected UDRP Questions, Third Edition, (["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 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, the letters "zam", may bear on assessment of the second and third elements, the Panel finds the addition of such letters 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 generic Top-Level Domain ("gTLD") ".com" is disregarded, as gTLDs typically do not form part of the comparison on the grounds that they are required for technical reasons (*Rexel Developpements SAS v. Zhan Yequn*, WIPO Case No. [D2017-0275](#); *Hay & Robertson International Licensing AG v. C. J. Lovik*, WIPO Case No. [D2002-0122](#), see also [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.

Respondent did not demonstrate any prior to the notice of the dispute use of the Domain Name or a trademark corresponding to the Domain Name in connection with a bona fide offering of goods or services.

On the contrary, as Complainant demonstrated, the Domain Name resolves to an "under construction" page.

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.

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.

To the extent that the website at the Domain Name displays a text stating that a website is under construction, which is equivalent to a passive holding, the Panel notes that 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.

Complainant's BARRICK trademark is well known in its field of gold and copper mining. Because the BARRICK mark had been used and registered by Complainant at the time of the disputed domain name registration, the Panel finds it more likely than not that Respondent had Complainant's trademark in mind when registering the disputed domain name (*Parfums Christian Dior v. Javier Garcia Quintas and Christiandior.net*, WIPO Case No. [D2000-0226](#)). Furthermore, the whole of Complainant's trademark is included in the disputed domain name. Last, the Domain Name includes the letters "zam", which is short for ZAMBIA, a country where Complainant has important mining activity. The above are a clear indication that Respondent knew of Complainant and its trademarks and chose the Domain Name having those in mind.

Having reviewed the available record, the Panel finds the non-use of the disputed domain name does not prevent a finding of bad faith use in the circumstances of this proceeding. 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.

In the present case the Panel notes a) the reputation of the Complainant's trademark in its field of business, b) the fact that Respondent has not submitted a response, c) the composition of the disputed domain name, which incorporates Complainant's trademark entirely, and d) the addition of the letters "zam", short for ZAMBIA, a country where Complainant has mining presence and activity. Taking all the above into account, the Panel finds that in the circumstances of this case the passive holding 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 <barrickzam.com> be transferred to the Complainant.

/Marina Perraki/

Marina Perraki

Sole Panelist

Date: June 10, 2024