

ADMINISTRATIVE PANEL DECISION

Barnes Europe Consulting Kft., Ms. Heidi Barnes-Watson v. Michael Barnes Case No. D2024-1237

1. The Parties

Complainant is Barnes Europe Consulting Kft., Ms. Heidi Barnes-Watson, United States, represented by Veronique Bichon, France.

Respondent is Michael Barnes, United States.

2. The Domain Name and Registrar

The disputed domain name <barnesusa.org> is registered with CloudFlare, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 21, 2024. On March 22, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 25, 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) and contact information in the Complaint. The Center sent an email communication to Complainant on March 26, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on March 29, 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 Respondent of the Complaint, and the proceedings commenced on April 5, 2024. In accordance with the Rules, paragraph 5, the due date for Response was April 25, 2024. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on May 1, 2024.

The Center appointed Phillip V. Marano as the sole panelist in this matter on May 11, 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

Complainants are real estate agents for high-end properties in a number of geographic regions, including in Europe and the United States of America (herein after “Complainant” or “Complainants” for ease of reference). Complainant offers information about itself and its real estate services through its official <barnes-international.com> domain name and website. Complainants are joint owners of valid and subsisting registrations for the BARNES trademark in numerous countries, including the trademark for BARNES (Int’l Reg. No. 1,114,909) registered on March 13, 2012 (based on registration in France on January 20, 2012) (with further designations in the European Union, China, and Russia, among other countries) and the design trademark for B BARNES INTERNATIONAL REALTY (Int’l Reg. No. 1,324,244) registered on August 23, 2016 (with further designation in the United States of America).

Respondent registered the disputed domain name on December 3, 2023. At the time this Complaint was filed, the disputed domain name resolved to a Registrar parking page that read, “The owner of this domain hasn’t put up a website yet. Try visiting again soon.”

5. Parties’ Contentions

A. Complainant

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

Notably, Complainant asserts ownership of the BARNES trademark and has adduced evidence of trademark registrations in numerous countries and regions around the world including in the European Union, with earliest priority dating back to January 20, 2012. The disputed domain name is confusingly similar to Complainant’s BARNES trademark, according to Complainant, because it wholly incorporates Complainant’s BARNES trademark and merely adds the geographic identifier “USA” for the United States of America.

Complainant further asserts that Respondent lacks any rights or legitimate interests in the disputed domain name based on: the lack of any Respondent trademark applications or registrations including either BARNES, BARNESUSA, or BARNES USA; the lack of any business or legal relationship between Complainant and Respondent; and Respondent’s passive holding of the disputed domain name, which includes Complainant’s well-known BARNES trademark. Complainant also asserted, “we have no proof of the identity of the Respondent,” and “he may have provided incorrect information when registering the litigious domain name.”

Complainant argues that Respondent has registered and used the disputed domain name in bad faith for numerous reasons, including: the well-known nature of Complainant’s BARNES trademarks in France and several other countries, as recognized in numerous prior decisions under the Policy; Respondent’s passive holding of the disputed domain name, which includes Complainant’s well-known BARNES trademark; Respondent’s attachment of MX records to the disputed domain name, creating a risk that “the general public receiving an email based on the disputed domain name ... would mistakenly think it came from the Complainants”; and Respondent’s pattern of cybersquatting behavior, based on the results of Complainant’s reverse Whois search of the registrant name “Michael Barnes”.

B. Respondent

Respondent did not reply to Complainant’s contentions.

6. Discussion and Findings

To succeed in its Complaint, Complainant must establish in accordance with paragraph 4(a) of the Policy:

- i. The disputed domain name is identical or confusingly similar to a trademark in which Complainant has rights;
- ii. 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.

Although Respondent did not reply to Complainant's contentions, the burden remains with Complainant to establish by a balance of probabilities, or a preponderance of the evidence, all three elements of paragraph 4(a) of the Policy. A respondent's default would not by itself mean that the complainant is deemed to have prevailed; a respondent's default is not necessarily an admission that the complainant's claims are true. UDRP panels have been prepared to draw certain inferences in light of the particular facts and circumstances of the case, e.g., where a particular conclusion is prima facie obvious, where an explanation by the respondent is called for but is not forthcoming, or where no other plausible conclusion is apparent. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), sections 4.2 and 4.3; see also *The Vanguard Group, Inc. v. Lorna Kang*, WIPO Case No. [D2002-1064](#) ("The Respondent's default does not automatically result in a decision in favor of the complainant. The Complainant must still prove each of the three elements required by Policy paragraph 4(a)").

Affiliates and trademark licensees can be considered to have rights in a trademark under the UDRP for the purposes of standing to file a consolidated complaint. [WIPO Overview 3.0](#), Section 1.4. Panels most often have accepted consolidated complaints in situations where multiple complainants have demonstrated common legal interests in the trademark rights on which a complaint is based, typically involving commonality based on an agency, licensing, or affiliate relationship between the co-complainants. See, e.g., *ITT Manufacturing Enterprises, Inc., ITT Corporation v. Douglas Nicoll, Differential Pressure Instruments, Inc.*, Case No. [D2008-0936](#). The Panel finds that for the purpose of this dispute, the interests of Complainants are co-extensive based on Complainants' joint ownership of their BARNES trademark and shared grievance against Respondent, such that it is appropriate for them to proceed as joint Complainants. See e.g., *Volkswagen Group of America, Inc. v. Kim Hyeonsuk a.k.a. Kim H. Suk, Domain Bar, Young N. and Kang M.N.*, Case No. [D2014-1596](#); *Starwood Hotels & Resorts Worldwide Inc., et. al. v. Media Insight a/k/a Media Insights*, Case No. [D2010-0211](#) ("The consolidation of multiple complainants in a single complaint generally should be permitted if the complainants have a truly common grievance against the respondent, and it is equitable and procedurally efficient to do so."); *Heidi Barnes-Watson, Barnes SAS v. Jean Luc Baptiste*, Case No. [D2017-2337](#); *Barnes Europe Consulting Group Kft., Heidi Barnes-Watson v. Privacy Service Provided by Withheld for Privacy ehf / Chris Byrd*, Case No. [D2022-1358](#).

A. Identical or Confusingly Similar

Ownership of a nationally or regionally registered trademark serves as prima facie evidence that Complainant has trademark rights for the purposes of standing to file this Complaint. [WIPO Overview 3.0](#), section 1.2.1. Complainant submitted evidence that the BARNES trademark has been registered in numerous jurisdictions and countries with priority dating back to January 20, 2012. Thus, the Panel finds that Complainant's rights in the BARNES trademark have been established pursuant to the first element of the Policy.

The only remaining question under the first element of the Policy is whether the disputed domain name is identical or confusingly similar to Complainant's BARNES trademark. In this Complaint, the disputed domain name is confusingly similar to Complainant's BARNES trademark because, disregarding the ".org" generic Top-Level Domain ("gTLD"), the entirety of the trademark is contained within the disputed domain name. [WIPO Overview 3.0](#), section 1.7. ("This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the domain name ... [I]n cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar..."). In regards to gTLDs, such as ".org" in the disputed domain name, they are generally viewed as a standard registration requirement and are disregarded under the first element. [WIPO Overview 3.0](#), section 1.11.

The combination with the geographically descriptive term “usa” does not prevent a finding of confusing similarity between Complainant’s BARNES trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.8 (Additional terms “whether descriptive, geographic, pejorative, meaningless, or otherwise” do not prevent a finding of confusing similarity under the first element”); see also *AT&T Corp. v. WorldclassMedia.com*, WIPO Case No. [D2000-0553](#) (“Each of the domain names in dispute comprises a portion identical to [the ATT trademark] in which the Complainant has rights, together with a portion comprising a geographic qualifier, which is insufficient to prevent the composite domain name from being confusingly similar to Complainant’s [ATT trademark]”). Indeed, the Panel concurs with Complainant that the additional term “usa” does not dispel the confusing similarity between Complainant’s BARNES trademark and the disputed domain name.

In view of the foregoing, the Panel concludes that Complainant has established the first element of the Policy.

B. Rights or Legitimate Interests

Complainant must first make out a prima facie case that Respondent lacks rights or legitimate interests in the disputed domain name, shifting the burden of production on this element to Respondent to come forward with evidence demonstrating such rights or legitimate interests. Where, as in this Complaint, Respondent fails to come forward with any relevant evidence, Complainant is deemed to have satisfied the second element of the Policy. [WIPO Overview 3.0](#), section 2.1.

As a threshold matter, it is unclear from the record whether Respondent, identified by registration data for the disputed domain name as “Michael Barnes”, is commonly known by the disputed domain name or Complainant’s BARNES trademark. Purely on the face of the registration data for the disputed domain name, it is conceivable that the disputed domain name constitutes the surname of Respondent plus the geographic location of Respondent. Complainant has not directly addressed this possibility under Paragraph 4(c)(ii) of the Policy. Nevertheless, when a respondent is commonly known by a domain name, that is a defense that respondents must make and support (not merely assert) with concrete credible evidence, such as some form of identification, correspondence with third parties, invoices, articles of incorporation, etc., as weighed against other indicia of cybersquatting. [WIPO Overview 3.0](#), section 2.3. Here, the record is devoid of any such defense or corroborating evidence (beyond what Respondent has chosen to put in the registration data) to support that conclusion. Based on the balance of the uncontroverted evidence in the record, the Panel is satisfied that Respondent is not commonly known by the disputed domain name for purposes of Paragraph 4(c)(ii) of the Policy.

Based on the undisputed facts and circumstances in the record before it, the Panel finds that Respondent is not using the disputed domain names in connection with a bona fide offering of goods or services. This is especially the case where a disputed domain name is so obviously connected with a complainant and its services, the very use by a registrant with no connection to a complainant suggests opportunistic bad faith. The Panel concludes from the record that Respondent had Complainant’s BARNES trademark in mind when registering the disputed domain name, and that Respondent most likely registered domain name in order to create confusion with Complainant’s trademark rights. Indeed, a respondent who knowingly adopted a third party’s well-known mark as a domain name cannot claim the benefit of Paragraph 4(c)(i) of the Policy to establish rights to the domain name based on its mere use of the domain name to offer goods or services prior to the notice of a dispute. *Scania CV AB v. Leif Westlye*, WIPO Case No. [D2000-0169](#); see also *Drexel University v. David Brouda*, WIPO Case No. [D2001-0067](#) (rights or legitimate interests cannot be created where the user of the domain name at issue would not choose such a name unless he was seeking to create an impression of association with the complainant).

Furthermore, passively holding a domain name which fully incorporates a mark plus a geographic term does not constitute a bona fide offering of goods or services. *Philip Morris USA Inc. v. Gabriel Hall*, WIPO Case No. [D2015-1779](#); *Teachers Insurance and Annuity Association of America v. Wreaks Communications Group*, WIPO Case No. [D2006-0483](#) (“[A]bsent some contrary evidence from Respondent, passive holding

of a Domain Name does not constitute legitimate noncommercial or fair use”). In this Complaint, the evidence indicates that Respondent has since December 2023, configured the disputed domain name: (i) to resolve to a Registrar parking page that reads, “The owner of this domain hasn’t put up a website yet” and contains hyperlink ads for supplemental services offered by the Registrar; and (ii) with MX records to send and receive emails from an “@barnesusa.org” email address.

In view of the foregoing, the Panel concludes that Complainant has established the second element of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy proscribes the following non-exhaustive circumstances as evidence of bad faith registration and use of the disputed domain name:

- i. Circumstances indicating that Respondent has registered or Respondent has acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to Complainant who is the owner of the trademark to a competitor of that Complainant, for valuable consideration in excess of Respondent’s documented out of pocket costs directly related to the disputed domain name; or
- ii. Respondent has registered the disputed domain name in order to prevent the owner of the trademark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or
- iii. Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- iv. By using the disputed domain name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent’s website or other online location, by creating a likelihood of confusion with Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of Respondent’s website or location or of a product or service on Respondent’s website or location.

Where a complainant’s trademark is widely known, including in a particular industry, or highly specific, and respondents cannot credibly claim to have been unaware of complainant, panels have inferred that respondents knew, or should have known, that their registration would be identical or confusingly similar to a complainant’s trademark. Furthermore, where parties are both located in the United States and the complainant has obtained a trademark registration pre-dating a respondent’s domain name registration, panels have applied the concept of constructive notice, subject to the strength or distinctiveness of the complainant’s trademark, or circumstances that corroborate respondent’s awareness of the complainant’s trademark. [WIPO Overview 3.0](#), section 3.2.2. In this Panel’s view, when the disputed domain name was registered on December 3, 2023, in particular noting the composition of the disputed domain name which is the mark plus a geographic term, Respondent would have had knowledge of Complainant’s pre-existing rights in Complainant’s BARNES trademark.

The mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating a descriptive term) to a famous or widely known trademark by an unaffiliated entity can by itself create a presumption of bad faith (particularly where no conceivable good faith use could be made). [WIPO Overview 3.0](#), Section 3.1.4. Complainant has adduced evidence of recognition of the BARNES trademark and cited several WIPO panel determinations in agreement that Complainant’s BARNES trademark is considered to be “well-known” or “famous.” See e.g., *Barnes Europe Consulting Kft., and Heidi Barnes-Watson v. jianhua Wang*, Case No. [D2022-3059](#); *Barnes Europe Consulting Kft., Heidi Barnes-Watson v. Privacy Service Provided by Withheld for Privacy ehf / Chris Byrd*, Case No. [D2022-1358](#); *Barnes Europe Consulting Kft. and Ms. Heidi Barnes-Watson v. Antoine Bauch*, Case No. [D2023-0711](#); *Barnes Europe Consulting Kft., Ms. Heidi Barnes-Watson v. Hubert VOISIN*, Case No. [D2023-0734](#); *Barnes Europe Consulting Kft., Ms. Heidi Barnes-Watson v. Muhammet Fazil Ates*, Case No. [D2023-5235](#); *Barnes*

Europe Consulting Kft. et Mme. Heidi Barnes-Watson contre Thibault Favre, EIRL LOM, Case No. [D2023-5229](#). As such, the Panel finds it is unconceivable that Respondent could have registered the disputed domain name without knowledge of Complainant's BARNES trademark, and without any intention to benefit from confusion with Complainant's BARNES trademark.

Passively holding a domain name does not prevent a finding of bad faith. [WIPO Overview 3.0](#), section 3.3. This includes domain names that do not resolve to any website content as well as domain names that are parked with a "coming soon" message or other similar content like "The owner of this domain hasn't put up a website yet". Where a domain name is being passively held, as alleged in this case, bad faith registration and use exists based upon: (i) the degree of distinctiveness or reputation of the complainant's mark; (ii) the failure of the respondent to submit any response or offer any credible evidence of rights or legitimate interests; (iii) the respondent's concealing its identity or use of false contact details; and (iv) the implausibility of any good faith use which the domain name may be put. See *Id.* See also *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#) ("A remedy can be obtained under the Policy only if those circumstances show that the Respondent's passive holding amounts to acting in bad faith."). To that end, the Panel acknowledges the multitude of above-cited panel determinations that Complainant's BARNES trademark is "famous" or "well known" for purposes of the Policy. In the Panel's view, these same prior panel determinations, coupled with Complainant's extensive portfolio of worldwide trademark registrations for Complainant's BARNES trademark, make any good faith use of the disputed domain name relatively implausible. Furthermore, the Panel acknowledges Respondent's failure file any informal or formal Response and failure to offer any credible evidence of rights or legitimate interests. And finally, the Panel acknowledges Respondent's either intentional or default use of a proxy registration service, thus concealing its identity from Complainant. Where it appears that a respondent intentionally employs a proxy service, or selects a registrar that applies default proxy services, merely to avoid being contacted by a complainant, or notified of a UDRP proceeding filed against it, UDRP panels tend to find that this supports an inference of bad faith. [WIPO Overview 3.0](#), section 3.6. Use of a privacy or proxy registration service to shield a respondent's identity and elude or frustrate enforcement efforts by a legitimate complainant demonstrates bad faith use and registration of a disputed domain name. See *Fifth Third Bancorp v. Secure Whois Information Service*, WIPO Case No. [D2006-0696](#) (the use of a proxy registration service to avoid disclosing the identity of the real party in interest is also consistent with an inference of bad faith when combined with other evidence of evasive, illegal, or irresponsible conduct).

The Panel also considers configuration of an email server on the disputed domain name as additional circumstantial evidence that the disputed domain name has been registered and use in bad faith. The disputed domain name contains in its entirety Complainant's BARNES trademark, and the record is devoid of any evidence (beyond what Respondent has used as registration data for the disputed domain name) to suggest that Respondent has any legitimate interest in sending or receiving emails using the disputed domain name. Conversely, Complainant has made a plausible argument that Respondent's proactive configuration of an email server, creates a risk that Respondent intends to create confusion between Respondent and Complainant, thereby using an email address associated with Complainant to try to impersonate Complainant. Prior WIPO panel determinations have recognized the same risk, and considered it as additional evidence of bad faith. See e.g., *Accor SA v. Domain Admin, C/O ID#10760, Privacy Protection Service INC d/b/a PrivacyProtect.org / Yogesh Bhardwaj*, WIPO Case No. [D2017-1225](#); *Carrefour S.A. v. WhoisGuard, Inc / Gaudet Jose*, Case No. [DCO2018-0041](#) ("The Panel concurs with the Complainant that the connection of the disputed domain name with an email server configuration enhances a likelihood of confusion and presents a risk that the Respondent is engaged in a phishing scheme.")

Finally, Complainant has argued that Respondent has engaged in a pattern of bad faith registration and use within paragraph 4(b)(ii) of the Policy. [WIPO Overview 3.0](#), section 3.1.2. ("This may include a scenario where a respondent, on separate occasions, has registered trademark-abusive domain names, even were directed at the same brand owner."). Complainant has provided a reverse Whois search and cited to over 840 domain names registered to "Michael Barnes", which appear to wholly incorporate certain third-party trademarks like BANK OF AMERICA. Complainant has argued that these domain names demonstrate that Respondent has repeatedly targeted in bad faith well-known trademarks that include BARNES and other brands. However, the probative value of Complainant's reverse Whois search for the name "Michael

Barnes” is limited, and as such the Panel declines to consider it as additional indicia of bad faith. More specifically, the Panel conducted a limited independent investigation¹ to (i) confirm that the same reverse Whois service website used by Complainant yields zero hits when Respondent’s email address is queried, and (ii) there are over 1,000 individuals living in the United States of America with some formulation of the name “Michael Barnes”.

In view of the foregoing, the Panel concludes that 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 <barnesusa.org> be transferred to Complainant.

/Phillip V. Marano/

Phillip V. Marano

Sole Panelist

Date: May 25, 2024

¹ A panel may undertake limited factual research into matters of public record where it considers such information useful to assessing the case merits and researching a decision. This includes visiting the website linked to the disputed domain name in order to obtain more information about the respondent or its use of the domain name, consulting historical resources like the Internet Archive, reviewing dictionaries, encyclopedias, or accessing trademark registration or other governmental databases. [WIPO Overview 3.0](#), Section 4.8.