

ADMINISTRATIVE PANEL DECISION

Barnes Europe Consulting Kft., Heidi Barnes-Watson v. Omar Yass
Case No. D2024-4290

1. The Parties

The Complainants are Barnes Europe Consulting Kft., Hungary, and Heidi Barnes-Watson, United States of America (“United States”), represented by MIIP MADE IN IP, France.

The Respondent is Omar Yass, United States of America (“United States”)

2. The Domain Name and Registrar

The disputed domain name <barnes-internationals.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 17, 2024. On October 17, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 18, 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 (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainants on October 21, 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 October 23, 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 October 25, 2024. In accordance with the Rules, paragraph 5, the due date for Response was November 14, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 15, 2024.

The Center appointed Adam Samuel as the sole panelist in this matter on November 21, 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.

The Complainants have applied to the Panel to have their Complaints consolidated. They both base their Complaint on their ownership of the same trademarks. They jointly request the transfer of the disputed domain name to the first Complainant.

The relevant parts of Paragraph 10 of the Rules say:

“(a) The Panel shall conduct the administrative proceeding in such manner as it considers appropriate in accordance with the Policy and these Rules....
(c) The Panel shall ensure that the administrative proceeding takes place with due expedition. ...
(e) A Panel shall decide a request by a Party to consolidate multiple domain name disputes in accordance with the Policy and these Rules.”

The Panel concludes that consolidation of what are identical Complaints will ensure that the proceedings take place with due expedition and so grants the application.

4. Factual Background

The first Complainant is a company within the Barnes International real estate agency group. The second Complainant is the founder of that group. The Complainants jointly own a number of trademark registrations for the name BARNES, including a United States trademark registration no. 6855266, registered on September 27, 2022. The Complainants promote their services through a number of domain names including <barnes-international.com> which was registered on July 25, 2007.

The disputed domain name was registered on June 18, 2024. It resolves to an error page and does not appear to have ever been used.

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.

The disputed domain name wholly incorporates the Complainant's trademark BARNES and merely adds the geographic term “internationals”. It thus also wholly includes the verbal elements of the Complainants' mark. The addition of the final “s” amounts to typo squatting. Where the distinctive and prominent element of a disputed domain name is the Complainant's mark and the only deviation from this is the inclusion of a geographic indicator as a prefix or a suffix, such prefix or suffix does not typically negate the confusing similarity between the disputed domain name and the mark. In this case, “BARNES” is the distinctive and prominent element of the disputed domain name and the addition of “-internationals” does nothing to negate the confusing similarity between the disputed domain name the Complainants' BARNES trademarks. It even enhances the risk of confusion, considering the domain name used for the Complainants official website <barnes-international.com>.

The Respondent has no rights including trademark rights in respect of the name BARNES. The Respondent is not commonly known as “Barnes-internationals”. The Respondent does not appear to engage in any legitimate noncommercial or fair use of the disputed domain name, nor any use in connection with bona fide

offering goods and services. There is no business or legal relationship between the Complainants and the Respondent. The Complainants have neither authorized nor licensed the Respondent to use its trademarks in any way.

The disputed domain name does not resolve to an active website. Such use does not constitute a bona fide offering of goods or services or a legitimate noncommercial or fair use and cannot under the circumstances confer on the Respondent any rights or legitimate interests in the disputed domain name.

The BARNES trademarks are well-known in several countries. A finding of bad faith use can be made where the Respondent “knew or should have known” of a complainant’s trademark rights, and nevertheless used a domain name incorporating a mark, in which it had no rights or legitimate interests. When registering the disputed domain name, the Respondent employed a privacy service in order to hide its identity and to avoid being notified of a UDRP proceeding. The non-use of a domain name does not prevent a finding of bad faith under the doctrine of passive holding. The Complainants suspect that the Respondent is intentionally attempting to take advantage of the Complainants’ trademarks in order to generate profits. Furthermore, when it registered the disputed domain name, the Respondent gave an incorrect address.

B. Respondent

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

6. Discussion and Findings

To succeed, the Complainants must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainants have rights;
- (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.

A. Identical or Confusingly Similar

The disputed domain name consists of the Complainants’ trademark, a hyphen, the word “international” which describes their group’s business, the letter “s” and the generic top-level domain (“gTLD”) “.com”.

The gTLD is irrelevant here as it is a standard registration requirement. See section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”).

Section 1.8 of the [WIPO Overview 3.0](#) says:

“Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, [...] or otherwise) would not prevent a finding of confusing similarity under the first element.”

Here, the term “international” appears to refer to the Complainant’s business activity. The letter “s” is meaningless. Neither prevents a finding of confusing similarity between the disputed domain name and the Complainant’s trademark.

For all these reasons, the Panel concludes that the disputed domain name is confusingly similar to the Complainant’s trademark.

B. Rights or Legitimate Interests

The Respondent is not called “barnes-internationals” or anything similar and has never used the disputed domain name for any purpose. There is no evidence that the Complainant has ever authorised the Respondent to use its trademarks.

For these reasons, the Panel concludes that the Complainant has met this element. See section 2.1 of the [WIPO Overview 3.0](#).

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

It is reasonable to infer from the similarity between the disputed domain name and the Complainants’ group’s domain name <barnes-international.com> that the Respondent knew of the Complainants’ business when the Respondent registered the disputed domain name. The address on the registration details of the disputed domain name does not exist.

Without a Response in this case, it is impossible to know why the Respondent registered the disputed domain name. However, it is reasonable to infer that the Respondent did this either for the purpose of selling the domain name to the Complainants for valuable consideration in excess of the Respondent’s out-of-pocket costs directly related to the domain name or for the purposes of disrupting the Complainants’ business in some way.

Section 3.3 of the [WIPO Overview 3.0](#) reads:

“From the inception of the UDRP, panelists 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.

While 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, (iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put.”

Each of the four elements mentioned here applies to this case. The Complainants’ mark reflects a business that has existed for over 20 years. There is no response. The Respondent has used a false address on its domain name registration. The addition of the letter “s” renders the second part of the disputed domain name meaningless and unusable for any good faith use. For all these reasons, 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 <barnes-internationals.com> be transferred to the first Complainant.

/Adam Samuel/

Adam Samuel

Sole Panelist

Date: November 29, 2024.