

## **ADMINISTRATIVE PANEL DECISION**

### **Barnes Europe Consulting Kft., and Heidi Barnes-Watson v. jianhua Wang Case No. D2022-3059**

#### **1. The Parties**

The Complainants are Barnes Europe Consulting Kft. (“First Complainant”), Hungary, and Heidi Barnes-Watson (“Second Complainant”), United States of America, represented by Inlex IP Expertise, France.

The Respondent is jianhua Wang, China.

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

The disputed domain name <barnesnewyork.com> is registered with MAFF Inc. (the “Registrar”).

#### **3. Procedural History**

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on August 18, 2022. On August 19, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 23, 2022, 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.

On August 24, 2022, the Center transmitted an email communication to the Parties in English and Chinese regarding the language of the proceeding. On August 25, 2022, the Complainants confirmed their request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

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 in Chinese and English of the Complaint, and the proceedings commenced on August 31, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 20, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 21, 2022.

The Center appointed Deanna Wong Wai Man as the sole panelist in this matter on September 27, 2022. 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 international luxury real estate sector, and provide their clientele with real estate consultancy services in over 15 countries and 60 destinations.

The Complainants provide evidence that they own an international portfolio of trademark registrations for BARNES, including, but not limited to, French trademark registration number 3861673 for the word mark BARNES, registered on September 26, 2011 and International trademark registration number 1114909 for the word mark BARNES, registered on March 13, 2012 and designating *inter alia* China and Israel. The Panel notes that the Complainants also have an extensive online presence and that they host their main website under the domain name <barnes-international.com>, registered on July 25, 2007, and their official website for their real estate agency in New York under the domain name <barnes-newyork.com>, registered on September 8, 2011.

The disputed domain name was registered on June 10, 2022, and is therefore of a later date than the abovementioned trademarks of the Complainants. The Panel notes that the disputed domain name is linked to an active webpage containing gambling and explicit pornographic content.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainants contend that the disputed domain name is identical or confusingly similar to their trademark for BARNES, that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and that the disputed domain name was registered, and is being used in bad faith to divert Internet users to the Respondent's webpage containing pornographic material.

The Complainants essentially contend that the disputed domain name is confusingly similar to the Complainant's trademarks as it incorporates the Complainants' BARNES trademark in its entirety, with the only differing element being the addition of the geographical term "newyork" to the disputed domain name. The Complainants also provide evidence that the disputed domain name is linked to an active webpage containing pornographic content, which, the Complainants argue, is likely to tarnish the Complainants' marks. The Complainants contend that such use does not confer any rights or legitimate interests in respect of the disputed domain name, and that it constitutes use in bad faith of the disputed domain name. The Complainants also argue that the Respondent has clearly registered the disputed domain name to target the Complainants' brand and that the registration of the disputed domain name was therefore conducted in bad faith. Finally, the Complainants refer to their evidence containing reverse WhoIs results from which it appears that the Respondent is associated with a large amount of domain names which point to websites containing sexually explicit content.

The Complainants request the transfer of the disputed domain name to the First Complainant, Barnes Europe Consulting Kft.

##### **B. Respondent**

The Respondent did not reply to the Complainants' contentions.

## **6. Discussion and Findings**

### **6.1 First Preliminary Issue: Consolidation of Complainants**

The Complainants in this administrative proceeding request consolidation in regard to the Complainants. In this regard, the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (the "[WIPO Overview 3.0](#)") states in section 4.11.1: "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 Panel has carefully reviewed all elements of this case, giving particular weight to the evidence provided by the Complainants that the trademarks on which they rely in this proceeding are jointly owned by them. The Panel concludes from such evidence that both Complainants are the target of common conduct by the Respondent and both have common grievances regarding the use of their BARNES trademarks in the disputed domain name by the Respondent. The Panel accepts that permitting the consolidation would be fair and equitable to all Parties involved and would safeguard procedural efficiency. The Panel therefore grants the request for consolidation of the Complainants and shall hereafter refer to the Complainants jointly as "the Complainant".

### **6.2 Second Preliminary Issue: Language of the Proceeding**

Pursuant to paragraph 11(a) of the Rules, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

According to the Registrar's verification response, the language of the Registration Agreement for the disputed domain name is Chinese. Nevertheless, the Complainant filed its Complaint in English, and requests that English be the language of the proceeding. The Panel notes that the Respondent did not comment on the language of the proceeding and did not submit any arguments on the merits of this proceeding.

In considering this request, the Panel has carefully reviewed all elements of this case, and deems the following elements particularly relevant: the Complainant's request that the language of the proceeding be English; the lack of comment on the language of the proceeding and the lack of response on the merits of this proceeding by the Respondent (the Panel notes that the Respondent was invited by the Center in Chinese and in English and in a timely manner to present its comments and response in either Chinese or English, but chose not to do so); the fact that the disputed domain name is written in Latin letters and not in Chinese characters and that it contains the Complainant's trademark for BARNES and the English word "newyork"; and, finally, the fact that Chinese as the language of proceeding could lead to unwarranted delays and additional costs for the Complainant. In view of all these elements, the Panel grants the Complainant's request, and decides that the language of this proceeding shall be English.

### **6.3. Discussion and Findings on the Merits**

The Policy requires the Complainant to prove three elements:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has 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.

Based on the evidence and arguments submitted, the Panel's findings are as follows:

### **A. Identical or Confusingly Similar**

The Panel finds that the Complainant has shown that it has valid rights in the mark BARNES, based on its use and registration of the same as a trademark in multiple jurisdictions.

Moreover, as to whether the disputed domain name is identical or confusingly similar to the Complainant's trademarks, in the Panel's view, the disputed domain name consists of two parts, namely the Complainant's registered trademark for BARNES, followed by the term "newyork". The Panel refers to the [WIPO Overview 3.0](#), section 1.8, which states: "[w]here the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element". The Panel concludes that the disputed domain name contains the Complainant's trademark for BARNES in its entirety, which remains clearly recognizable within the disputed domain name, and that the addition of the term "newyork" does not prevent a finding of confusing similarity. The Panel also considers that the generic Top-Level Domain (gTLD), which is ".com" in this case, is viewed as a standard registration requirement, and may as such be disregarded by the Panel (see, [WIPO Overview 3.0](#), section 1.11.1).

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the Complainant's registered trademark for BARNES, and concludes that the Complainant has satisfied the requirements of the first element under the Policy.

### **B. Rights or Legitimate Interests**

On the basis of the evidence and arguments submitted, the Panel finds that the Complainant makes out a *prima facie* case that the Respondent is not, and has never been, an authorized reseller, service provider, licensee or distributor of the Complainant, is not a *bona fide* provider of goods or services under the disputed domain name, and is not making legitimate noncommercial or fair use of the disputed domain name. The Panel also notes that the Respondent is not commonly known by the disputed domain name. As such, the Panel finds that the burden of production regarding this element shifts to the Respondent (see [WIPO Overview 3.0](#), section 2.1). However, no evidence or arguments have been submitted by the Respondent in reply.

Moreover, upon review of the facts and evidence, the Panel notes that the disputed domain name directs to an active webpage containing gambling and pornographic content and links. In the Panel's view, no rights or legitimate interests derive from using another's registered trademark to divert Internet users to a pornographic and gambling website, see in this regard also several prior UDRP decisions such as *Seintec Norte, S.L. v. Yu Liu, wangluochuanmei*, WIPO Case No. [D2021-1815](#); *Andrey Ternovskiy dba Chatroulette v. Protection of Private Person / Aleksandr Katkov*, WIPO Case No. [D2017-0381](#); and *Averitt Express, Inc. v. Protection of Private Person / Roman Emec*, WIPO Case No. [D2018-0249](#).

On the basis of the foregoing, the Panel considers that none of the circumstances of rights or legitimate interests envisaged by paragraph 4(c) of the Policy apply, and that the Complainant has satisfied the requirements of the second element under the Policy.

### **C. Registered and Used in Bad Faith**

Given the distinctiveness and well-known nature of the Complainant's trademarks for BARNES, which predate the registration date of the disputed domain name by over a decade, the Panel considers that the Respondent has intentionally and opportunistically targeted the Complainant's trademark for BARNES. The Panel also notes that the disputed domain name is very similar to the Complainant's official domain name <barnes-newyork.com>, which was registered many years prior to the disputed domain name, the only difference being the hyphen. Accordingly, the Panel considers that the Respondent intends to mislead and divert unsuspecting Internet users away from the Complainant's official website and to the disputed domain

name where it hosts a website showing pornographic and gambling content. In the Panel's view, the preceding elements indicate that the Respondent knowingly targeted the Complainant's trademarks in registering the disputed domain name, and the Panel therefore finds that it has been demonstrated that the Respondent registered the disputed domain name in bad faith.

As to use of the disputed domain name in bad faith, the website linked to the disputed domain name currently displays gambling and pornographic content and links, which shows that the Respondent is abusing the Complainant's trademark to mislead and divert consumers for commercial gain to such website, and thereby also tarnishes the Complainant's marks, see in this regard also previous UDRP decisions such as *Seintec Norte, S.L. v. Yu Liu, wangluochuanmei*, WIPO Case No. [D2021-1815](#) and *Averitt Express, Inc. v. Protection of Private Person / Roman Emec*, WIPO Case No. [D2018-0249](#). On the basis of the foregoing elements, the Panel finds that the Respondent is using the disputed domain name in bad faith.

Moreover, the Respondent has failed to provide any response or evidence to establish its good faith or absence of bad faith.

The Panel therefore finds that the Complainant has satisfied the requirements of the third element under 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 <barnesnewyork.com> be transferred to the First Complainant, Barnes Europe Consulting Kft.

*/Deanna Wong Wai Man/*

**Deanna Wong Wai Man**

Sole Panelist

Date: October 10, 2022