

ADMINISTRATIVE PANEL DECISION

Barnes Europe Consulting Kft., Ms. Heidi Barnes-Watson v. Muhammet Fazil Ates

Case No. D2023-5235

1. The Parties

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

The Respondent is Muhammet Fazil Ates, Türkiye.

2. The Domain Name and Registrar

The disputed domain name <barnessa.com> is registered with IHS Telekom, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 15, 2023. On December 18, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 19, 2023, 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 (GDPR Masked) and contact information in the Complaint. The Center sent an email communication to the Complainants on December 26, 2023, 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 December 27, 2023.

On December 26, 2023, the Center informed the parties in Turkish and English, that the language of the registration agreement for the disputed domain name is Turkish. On December 27, 2023, the Complainants requested English to be the language of the proceeding. The Respondent did not submit any comment on the Complainants’ submission.

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 January 3, 2024. In accordance with the Rules, paragraph 5, the due date for Response was January 23, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on January 24, 2024.

The Center appointed Ezgi Baklacı Gülkökar as the sole panelist in this matter on January 29, 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

There are two Complainants in this administrative proceeding: Barnes Europe Consulting Kft. and Heidi Barnes-Watson since the earlier trademarks on which this Complaint is based are the joint ownership of the Complainants as evidenced with Annex 1 of the Complaint, both Complainants have common grievance against the Respondent.

The Complainants are joint owners of the "BARNES" trademark registrations before the United States Patent and Trademark Office ("USPTO"), World Intellectual Property Office ("WIPO"), European Union Intellectual Property Office ("EUIPO") and different jurisdictions. The relevant BARNES trademarks are French trademark No. 3861673 registered on September 26, 2011; United Kingdom trademark No. UK00801114909 registered on March 26, 2013; United States trademark No. 90587275 registered on September 27, 2022; European Union trademark No. 018037155 registered on September 26, 2019; International trademark No. 1114909 registered on March 13, 2012, as evidenced in Annex 1 of the Complaint.

The Complainants are well-known real estate agents doing business in respect of high-end properties in a number of regions, namely 18 countries and 60 destinations. The Complainants use BARNES trademarks in relation with real-estate services and operate through various websites, including <barnes-international.com>, <barnes-turkey.com>, <barnesturkey.com>, <barnesnewyork.com>, <barnes-newyork.com>, <barnes-greece.com>, <barnes-uae.com> and <barnes-dubai.com>, as evidenced in Annex 5 of the Complaint.

The disputed domain name <barnessa.com> was registered on October 14, 2023, as evidenced with the Annex 3 of the Complaint. The website provided under the disputed domain name is not accessible.

5. Parties' Contentions

A. Complainants

The Complainants contend that they have satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainants contend that each of the three elements specified in paragraph 4(a) of the Policy is satisfied in the present case, as follows:

Identical or confusingly similar

The Complainants argue that the disputed domain name fully incorporates and is confusingly similar to BARNES trademarks, the sole difference being the addition of the two letters "sa" at the ending. The Complainants also argue that this difference fails to distinguish the disputed domain name from the

Complainants' trademark as the trademark is clearly recognizable within the disputed domain name and "sa" may be referring to "société anonyme", which is a legal form for a French company or may be referring to Saudi Arabia.

The Complainants indicate that if the main element of the disputed domain name is the Complainants' trademark and the only deviation is the addition of a geographic indicator as a prefix or a suffix, it does not eliminate the confusing similarity and also refer to earlier UDRP decisions.

Rights or legitimate interests

The Complainants argue that the Respondent has no rights and legitimate interests in the disputed domain name, has no affiliation with the Complainants, and the Complainants have not given the Respondent permission to register and/or use the Complainants' trademarks in any manner.

In addition, the Complainants argue that the Respondent is not known by the disputed domain name and the Complainants submit that the Respondent is not authorized to use the Complainant's trademark, nor the Respondent is the licensee of the mark.

The Complainants further argue that the use of the disputed domain name by the Respondent does not constitute either a bona fide use or a legitimate noncommercial or fair use as it does not resolve to an active website as evidenced with Annex 8.

The disputed domain name was registered and used in bad faith

The Complainants initially argue that the BARNES trademark registrations predate the creation date of the disputed domain name and that when the phrase "barnes" is searched on the Internet, the website of the Complainants comes first among the 405.000.000 results as evidenced with Annex 9 of the Complaint.

The Complainants also iterate that the Respondent should be presumed to have known or should have known the Complainants' trademarks given the international reputation of the BARNES marks. The Complainants also refer to an earlier panel decision which recognized the well-known nature of the Complainants' trademarks.

It has been further argued by the Complainants that the fact that the disputed domain name resolves to an inactive website does not prevent the finding of bad faith due to passive holding doctrine.

The Complainants also argue that, given the reputation of the BARNES trademarks, the Respondent has knowingly registered the disputed domain name in order to mislead the consumers and create an impression of an association with the Complainants.

In summary, the Complainants assert that they have established all three elements required under paragraph 4(a) of the Policy for a transfer of the disputed domain name.

B. Respondent

The Respondent did not reply to the Complainants' contentions.

6. Discussion and Findings

6.1 Language of the Proceeding

The language of the Registration Agreement for the disputed domain name is Turkish. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise

in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English. The Complainant requested that the language of the proceeding be English for several reasons, including the fact that the domain extension “.com” is a supranational character and targets consumers from all over the world and familiar with English language, that English is the business language, that the Complainants operate notably in English speaking countries and that the Panel has already accepted English as the language of proceeding in cases involving IHS Telekom, Inc. – the registrar of the disputed domain name, and that according to a reverse whois search, the Respondent seems to be the owner of domain names redacted in English, meaning that the Respondent is familiar with English.

The Respondent did not make any specific submissions with respect to the language of the proceeding.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties’ ability to understand and use the proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 4.5.1).

The Panel also bears in mind the need to ensure the proceeding is conducted in a timely and cost-effective manner. The Panel finds that it would be inappropriate, given the circumstances of this case, to conduct the proceeding in Turkish and request a Turkish translation of the Complaint while the Respondent has failed to raise any objection or even to respond to the Complaint or respond to the Center’s communication about the language of the proceeding, even though communicated in Turkish and in English.

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

6.2. Substantive Issues

In accordance with paragraph 4(a) of the Policy, the Complainant must prove that each of the three following elements is satisfied:

- (i) the disputed domain name is identical or confusingly similar to the trademarks or service marks in which the Complainants have rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (ii) the disputed domain name has been registered and 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 3.0](#), section 1.7.

Based on the available record, the Panel finds the Complainants have 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 Panel finds the mark is recognizable 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. “The applicable Top-Level Domain (“TLD”) in a domain name (e.g., “.com”, “. club”, “.nyc”) is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.” [WIPO Overview 3.0](#), section 1.11. Here, the TLD “.com” may be disregarded.

Although the addition of the term “sa” at the ending may bear on assessment of the second and third elements, the Panel finds the addition of such term 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.

Based on the available record, 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.

The Panel notes that there is no evidence showing that the Respondent holds any rights for the trademark or name “barnes”. The Panel also notes that there is no evidence showing that the Respondent is authorized or licensed to use the Complainants’ trademarks.

Having reviewed the available record, the Panel finds the Complainants have established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainants’ 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.

The case file also does not contain any evidence that the Respondent has been commonly known by the disputed domain name as an individual, business, or other organization. Further, the Panel notes that there is no evidence of the Respondent’s use of, or preparation to use the disputed domain name in connection with a bona fide offering of goods or services; and there is also no evidence that the Respondent is making a legitimate noncommercial or fair use under the disputed domain name.

The Panel notes that the disputed domain name does not resolve to an active website, which constitutes passive holding and, as such, considering the circumstances of the case has not been used in connection with a bona fide offering of goods or services.

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 Respondent more likely than not was aware of the trademark BARNES, as the Complainants’ trademark registrations predate the registration date of the disputed domain name. According to the evidence submitted by the Complainants, the Panel finds that the Respondent knew or should have known about the Complainants’ rights (and such information could readily have been reached by a quick online search; see *Compart AG v. Compart.com / Vertical Axis Inc.*, WIPO Case No. [D2009-0462](#)).

In addition, previous UDRP panels have held that the mere registration of a domain name that is confusingly similar (particularly domain names incorporating the mark plus a descriptive term) to a famous or widely known trademark by an unaffiliated entity can by itself create a presumption of bad faith ([WIPO Overview 3.0](#), section 3.1.4).

Panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the non-use of the disputed domain name does not prevent a finding of bad faith 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.

Having reviewed the available record, the Panel notes the distinctiveness or reputation of the Complainants' trademark, and the composition of the disputed domain name, and 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 <barnessa.com> be transferred to the Complainants.

/Ezgi Baklacı Gülkökar/

Ezgi Baklacı Gülkökar

Sole Panelist

Date: February 12, 2024