

## **ADMINISTRATIVE PANEL DECISION**

**Barrick Gold of North America, Inc., Barrick Gold Corporation v. Aleksei  
Arsenev**

**Case No. D2024-1172**

### **1. The Parties**

The Complainants are Barrick Gold of North America, Inc. United States of America (“United States”) (the “Complainant 1”), and Barrick Gold Corporation, Canada (the “Complainant 2”), represented by Dorsey & Whitney, LLP, United States.

The Respondent is Aleksei Arsenev, Russian Federation.

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

The disputed domain name <barrickgold.online> (the “Domain Name”) is registered with Registrar of Domain Names REG.RU LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed in English 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 Domain Name. On March 20, 2024, the Registrar transmitted by email to the Center its verification response, disclosing registrant and contact information for the Domain Name which differed from the named Respondent (Unknown) and contact information in the Complaint. The Center sent an email communication to the Complainants on March 25, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainant filed an amended Complaint on March 25, 2024.

On March 25, 2024, the Center informed the parties in Russian and English, that the language of the registration agreement for the Domain Name is Russian. On March 25, 2024, the Complainants confirmed their request that English 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 in both English and Russian, and the proceedings commenced on April 3, 2024. In accordance with the Rules, paragraph 5, the due date for Response was April 23, 2024. The Respondent did not submit a formal response. The Center notified the Parties with the Commencement of Panel Appointment Process communication on May 10, 2024.

On April 3, 2024 the Respondent sent an informal communication to the Center, indicating that he does not need the Domain Name. Following this communication, on April 3, 2024, the Center informed the Parties about the procedure for settlement. Given that no request for suspension was received from the Complainant, as required by the Rules, the proceeding continued.

The Center appointed Piotr Nowaczyk as the sole panelist in this matter on May 16, 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**

The Complainants are a part of corporate group producing gold and other precious metals.

The Complainants claim common law rights in the BARRICK trademark. The Complainants, 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.

The Complainant 2 is also the owner of numerous BARRICK and BARRICK GOLD trademark registrations, including:

- the European Union Trade Mark Registration for BARRICK No. 018012698, registered on July 3, 2029;
- the United States Trademark Registration for BARRICK GOLD No. 4683358, registered on February 10, 2015; and
- the United States Trademark Registration for BARRICK GOLD No. 4994505, registered on April 26, 2016.

The Complainants also use the domain name <barrick.com>, incorporating the BARRIC trademark, to advertise and promote their services.

The Domain Name was registered on November 2, 2023.

At the time of submitting the Complaint the Domain Name resolved to a website displaying information primarily regarding stock and cryptocurrency trading, as well as including a link to sign in to an alleged trading panel (the "Website 1"). As of the date of this Decision, the Domain Name resolves to a website featuring overseas job offers for Filipino workers, as well as pay-per-click ("PPC") links of the third parties (the "Website 2").

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

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

The Complainants contend that they have satisfied each of the elements required under the Policy for a transfer of the Domain Name.

First, the Complainants contend that the Domain Name is confusingly similar or identical to the trademarks in which the Complainants have rights.

Second, the Complainants argue that the Respondent has neither rights nor legitimate interests in the Domain Name.

Third, the Complainants submit that the Domain Name was registered and is being used in bad faith.

## **B. Respondent**

The Respondent did not reply to the Complainants' contentions. However, on April 3, 2024, the Respondent sent an informal communication to the Center, indicating that he does not need the Domain Name.

## **6. Discussion and Findings**

### **6.1. Preliminary Matters – Language of the Proceeding**

The language of the Registration Agreement for the Domain Name is Russian. 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 Complainants request that the language of the proceeding be English for several reasons. First, the Complainants note that the Website 1 to which the Domain Name resolves is in English. Second, the Complainants submit that the Website 1 also features links to third-party webpages in the English language. Finally, the Complainants allege that it would incur substantial expense and inconvenience if the Complaint must be translated into Russian.

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 section 4.5.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Panel finds that substantial additional expense and delay would likely be incurred if the Complainant had to be translated into Russian. Moreover, the Panel notes that the Respondent did not comment or let alone object to the Complainants' arguments concerning the language of the proceeding.

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 Matters – Three Elements**

Paragraph 4(a) of the Policy places a burden on the Complainants to prove the presence of three separate elements, which can be summarized as follows:

- (i) the 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 the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

The requested remedy may only be granted if the above criteria are met. At the outset, the Panel notes that the applicable standard of proof in UDRP cases is the "balance of probabilities" or "preponderance of the evidence". See section 4.2 of the [WIPO Overview 3.0](#).

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

Under the first element, the Complainants must establish that the Domain Name is identical or confusingly similar to the trademark in which the Complainants have rights.

The Complainants claim common law rights in the BARRICK trademark which the Panel considers to be established for purposes of the UDRP. However, the Complainant 2 holds also valid BARRICK GOLD trademark registrations. The Domain Name incorporates this trademark in its entirety. As numerous UDRP panels have held, incorporating a trademark in its entirety is sufficient to establish that a domain name is identical or confusingly similar to that trademark (see *PepsiCo, Inc. v. PEPSI, SRL (a/k/a P.E.P.S.I.) and EMS COMPUTER INDUSTRY (a/k/a EMS)*, WIPO Case No. [D2003-0696](#)).

The generic Top-Level Domain (“gTLD”) “.online” in the Domain Name is viewed as a standard registration requirement and as such is disregarded under the first element test. See section 1.11.1 of the [WIPO Overview 3.0](#).

Given the above, the Panel finds that the Domain Name is identical to the Complainants’ BARRICK GOLD trademark for purposes of the Policy. Thus, the Complainants have satisfied the requirements under paragraph 4(a)(i) of the Policy.

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

Under the second element, the Complainants must prove that the Respondent has no rights or legitimate interests in the Domain Name.

The Respondent may establish a right or legitimate interest in the Domain Name by demonstrating in accordance with paragraph 4(c) of the Policy any of the following:

- (i) that it has used or made preparations to use the Domain Name or a name corresponding to the Domain Name in connection with a bona fide offering of goods or services prior to the dispute; or
- (ii) that it is commonly known by the Domain Name, even if it has not acquired any trademark rights; or
- (iii) that it is making a legitimate noncommercial or fair use of the Domain Name without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark.

Although given the opportunity, the Respondent has not submitted any evidence indicating that any of the circumstances foreseen in paragraph 4(c) of the Policy are present in this case.

On the contrary, it results from the evidence on record that the BARRICK GOLD trademark registrations of the Complainant 2 predate the Respondent’s registration of the Domain Name. There is no evidence in the case record that the Complainant 2 has licensed or otherwise permitted the Respondent to use the BARRICK GOLD trademark or to register the Domain Name incorporating this trademark. There is also no evidence to suggest that the Respondent has been commonly known by the Domain Name.

Moreover, it results from the evidence on record that the Respondent does not make use of the Domain Name in connection with a bona fide offering of goods or services, nor does it make a legitimate noncommercial or fair use of the Domain Name. On the contrary, at the time of submitting the Complaint the Domain Name resolved to the Website 1, displaying information primarily regarding stock and cryptocurrency trading, as well as including a link to sign in to an alleged trading panel. As of the date of this Decision, the Domain Name resolves to the Website 2 featuring overseas job offers for Filipino workers and PPC links. Such use of the Domain Name does not confer rights or legitimate interests on the Respondent.

While specific case factors have led previous panels to find that fair use need not always be categorically noncommercial in nature, unambiguous evidence that the site is not primarily intended for commercial gain,

e.g., the absence of commercial or PPC links, would tend to indicate a lack of intent to unfairly profit from the complainant's reputation. See section 2.5.3, [WIPO Overview 3.0](#). As indicated above, as of the date of this Decision, the Domain Name resolves to the Website 2 featuring PPC links. These links allow the Respondent to profit from the attracted web traffic and collect click-through revenue from advertising links. Such use further demonstrates that the Respondent has used the Domain Name to derive a commercial benefit.

Furthermore, the Respondent's use of the Domain Name will fundamentally not be considered "fair" if it falsely suggests affiliation with the trademark owner; the correlation between the Domain Name and the Complainants' mark is often central to this inquiry. Generally speaking, UDRP panels have found that domain names identical to a complainant's trademark, such as in the case at hand, carry a high risk of implied affiliation. See sections 2.5 and 2.5.1, [WIPO Overview 3.0](#).

Given the above, the Respondent has failed to invoke any circumstances, which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in respect of the Domain Name. Thus, there is no evidence in the case file that refutes the Complainants' prima facie case. The Panel concludes that the Complainants have also proved the requirement under paragraph 4(a)(ii) of the Policy.

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

Under the third element, the Complainants must prove that the Domain Name has been registered and is being used in bad faith.

Bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's trademark. See section 3.1 of the [WIPO Overview 3.0](#).

Under paragraph 4(b) of the Policy, evidence of bad faith registration and use includes without limitation:

- (i) circumstances indicating the domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the owner of a trademark or to a competitor of the trademark owner, for valuable consideration in excess of the documented out-of-pocket costs directly related to the domain name; or
- (ii) circumstances indicating that the domain name was registered in order to prevent the owner of a trademark from reflecting the mark in a corresponding domain name, provided it is a pattern of such conduct; or
- (iii) circumstances indicating that the domain name was registered primarily for the purpose of disrupting the business of a competitor; or
- (iv) circumstances indicating that the domain name has intentionally been used in an attempt to attract, for commercial gain, Internet users to a website or other online location, by creating a likelihood of confusion with a trademark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on a website or location.

As indicated above, the rights of the Complainant 2 in the BARRICK GOLD trademark predate the registration of the Domain Name. This Panel finds that the Respondent was or should have been aware of this trademark at the time of registration. Such a finding is supported by the composition of the Domain Name consisting exclusively of the BARRICK GOLD trademark and the gTLD. Moreover, it has been proven to the Panel's satisfaction that the BARRICK GOLD trademark is well known and unique to the Complainants. Thus, the Respondent could not likely reasonably ignore the reputation of products and services under this trademark. In sum, the Respondent in all likelihood registered the Domain Name with the expectation of taking advantage of the reputation of the BARRICK GOLD trademark.

The Panel notes that at the time of submitting the Complaint the Domain Name resolved to the Website 1, displaying information primarily regarding stock and cryptocurrency trading, as well as including a link to sign in to an alleged trading panel. Noting the nature of the disputed domain name including the BARRICK GOLD trademark in its entirety, the Panel finds that the Respondent registered the disputed domain name in the knowledge of the BARRICK GOLD trademark and business with the intention of taking unfair advantage of the Complainant's goodwill attaching to those trademarks. Additionally, the Panel finds that the Respondent most likely used the disputed domain name in order to create confusion in the minds of Internet users for the purpose of attracting Internet traffic for commercial gain.

Furthermore, the Domain Name is currently being used in bad faith by the Respondent to attract Internet users to the Website 2 which, i.a., features PPC links. With respect to "automatically" generated PPC links, panels have held that a respondent cannot disclaim responsibility for content appearing on the website associated with its domain name. Neither the fact that such links are generated by a third party such as a registrar or auction platform (or their affiliate), nor the fact that the respondent itself may not have directly profited, would by itself prevent a finding of bad faith. See section 3.5, [WIPO Overview 3.0](#).

For the reasons discussed above, the Panel finds that the Complainants have proved the requirements under paragraph 4(a)(iii) 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 Domain Name <barrickgold.online> be transferred to the Complainant 1.

*/Piotr Nowaczyk/*

**Piotr Nowaczyk**

Sole Panelist

Date: May 30, 2024