

ADMINISTRATIVE PANEL DECISION

Barnes Europe Consulting Kft., Heidi Barnes-Watson v. Roy Ackerman
Case No. D2024-1547

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 Roy Ackerman, United States.

2. The Domain Name and Registrar

The disputed domain name <barnesmauritius.com> is registered with Wild West Domains, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 11, 2024. On April 11, 2024, the Center emailed the Registrar a request for registrar verification in connection with the disputed domain name. On April 12, 2024, the Registrar transmitted by email to the Center its verification response disclosing the registrant and contact information for the disputed domain name, which differed from the named Respondent (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainants on April 17, 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 April 19, 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 April 22, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 12, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 21, 2024.

The Center appointed William F. Hamilton as the sole panelist in this matter on May 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

The Complainants operate a well-known real estate enterprise that sells and rents exclusive properties in several world locations, including Europe and the United States. The Complainants operate in over 15 countries and 60 destinations.

The Complainants are the joint owners of the BARNES trademark (the "Mark"). The Complainants own French, European Union, United Kingdom, Canadian, United States, and International trademark registrations and/or registration applications for the Mark (and trademarks that incorporate the Mark), the earliest of which is French trademark registration No. 3861673, dated January 20, 2012.

The Complainants also own numerous domain names composed of the Mark followed by a geographical term. The Complainants offer Mauritius real estate services.

The disputed domain name was registered on January 24, 2024. The disputed domain name does not resolve to an active website. However, mail exchanger ("MX") services utilizing the disputed domain name have been enabled.

5. Parties' Contentions

A. Complainants

The Complainants contend that the disputed domain name is confusingly similar to the Mark because the disputed domain name is composed of the Mark and a geographical term. The Complainants assert that the Complainants never authorized the Respondent to use the Mark or to register the disputed domain name, that the Respondent is not commonly known by the disputed domain name, and never engaged in any bona fide commercial activity or legitimate noncommercial or fair use in connection with the disputed domain name. Although the disputed domain name does not resolve to an active website, the Complainants assert that the Respondent knew of the Mark and has registered and used the disputed domain name in bad faith as evidenced by the fame and reputation of the Mark, the registration of the disputed domain name using a privacy service, and the implementation of MX services based on the disputed domain name.

B. Respondent

The Respondent did not reply to the Complainants' contentions.

6. Discussion and Findings

Under paragraph 4(a) of the Policy, to succeed the Complainants must satisfy the Panel that:

- (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 was registered and is being used in bad faith.

The Panel finds that the Complainants appropriately brought this case jointly. The Complainants own a joint interest in the Mark. Allowing consolidation will not prejudice the Respondent and will increase the efficiency and prompt resolution of the claims presented in the proceeding.

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 Complainants' trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7. The Complainants have shown rights in the Mark for the purposes of the Policy by virtue of the Mark's registration. [WIPO Overview 3.0](#), section 1.2.1.

The disputed domain name adopts the Mark entirely and adds a geographical term as a suffix. The Mark is prominently featured in the disputed domain name and is immediately recognizable. Adding a geographical term to the Mark does not prevent a finding of confusing similarity between the disputed domain name and the Mark. The Panel finds that the disputed domain name is confusingly similar to the Mark.

The Panel finds that 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.

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 disputed domain name does not resolve to an active website. The mere passive holding of a domain name does not establish rights or legitimate interests.

The Panel finds that 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.

Panels have found that the non-use of a domain name does not prevent a finding of bad faith under the doctrine of passive holding. 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 (i) the worldwide reputation of the Complainants' Mark, (ii) the composition of the disputed domain name, which merely adds the geographical term "Mauritius" to the Mark, (iii) the fact that the Complainants offer services in Mauritius, (iv) the enabling of an MX capability based on the disputed domain name, and (v) the Respondent's failure to respond to the Complaint, and finds that in the circumstances of this case, that the Respondent has registered and used the disputed domain name in bad faith.

The Panel finds that the third element of the Policy has been established.

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, <barnesmauritius.com>, be transferred to the Complainant Barnes Europe Consulting Kft.

/William F. Hamilton/

William F. Hamilton

Sole Panelist

Date: June 7, 2024