

ADMINISTRATIVE PANEL DECISION

Barrick Gold North America, Inc. and Barrick Gold Corporation v. Withheld for Privacy / Ndubuisi Somtochukwu
Case No. D2022-0166

1. The Parties

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

The Respondent is Withheld for Privacy, Iceland / ndubuisi somtochukwu, Nigeria.

2. The Domain Name and Registrar

The disputed domain name <barrickgold.ltd> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 19, 2022. On January 19, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 19, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on January 20, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on January 24, 2022.

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 26, 2022. In accordance with the Rules, paragraph 5, the due date for Response was February 15, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 16, 2022.

The Center appointed Wilson Pinheiro Jabur as the sole panelist in this matter on February 18, 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.

On February 25, 2022, the Panel issued the Procedural Order No. 1 requesting the Complainant to submit evidence of authorization from the trademark owner, Barrick Gold Corporation to proceed with this Complaint or to amend the Complaint to add such entity as co-Complainant. On March 2, 2022, the Complainant submitted a Second Amended Complaint asking the addition of the trademark owner as Second Complainant. The Respondent did not submit any comments.

4. Factual Background

The Complainants are part of a conglomerate that explores gold mining around the world. The Second Complainant is the owner, amongst others, of the following trademark registrations (Annex 4 to the Second Amended Complaint):

- United States Trademark Registration No. 4,578,245 for the word & device mark, BARRICK, registered on August 5, 2014, in classes 37 and 42;
- United States Trademark Registration No. 4,683,358 for the word & device mark, BARRICK GOLD, registered on February 10, 2015, in class 42;
- United States Trademark Registration No. 4,944,505 for the word & device mark, BARRICK GOLD, registered on April 26, 2016, in class 37; and
- United States Trademark Registration No. 6,225,225 for the word & device mark, BARRICK, registered on December 22, 2020, in classes 6, 14, 37 and 42.

The disputed domain name <barrickgold.ltd> was registered on October 24, 2021 and is being used in connection with a webpage offering platform for cryptocurrency trading and investment.

5. Parties' Contentions

A. Complainant

The Complainants assert to compose one of the largest gold mining operations in the world, having used the BARRICK trademark in connection with gold and copper mining and precious metal goods and services in over thirteen countries since at least as early as 1983. Also counting with an Internet presence given the Complainants' "barrick.com" website, registered since 1995, and presence in social media.

Due to the success in the mining of gold and other precious metals, the Complainants affirm to have developed tremendous goodwill and name recognition amongst a large base of commercial and consumer industries, including the banking industry as well as professional and personal investment communities.

In the Complainants' view, the disputed domain name incorporates their BARRICK trademark, creating consumer confusion, being the addition of the descriptive term "gold" inherent to the Complainants' activities in the gold mining services.

According to the Complainants, the Respondent has no rights or legitimate interests in the disputed domain name given that:

- (i) the Respondent is not a licensee of the Complainants, nor have Complainants otherwise authorized the Respondent to register the disputed domain name or otherwise use Complainants' BARRICK trademarks;

(ii) the Respondent is using the disputed domain name in connection with an online cryptocurrency trading and investment platform in an attempt to pass off as the Complainants or at least as a Complainants' authorized entity, by implying it has affiliations with the mining industry (stating that it "has direct contracts with professional traders and miners around the world") as well as disclosing an address that is affiliated with Nevada Gold Mines, the single largest gold-producing complex in the world, a joint venture of the Second Complainant with Newmont Goldcorp (Annex 7 to the Second Amended Complaint);

(iii) the webpage available at the disputed domain name displays contradictory information about the Respondent and its company details, stating to be officially registered in Estonia, but listing a Nevada address as well as an address in the United Kingdom to which it appears not be affiliated with; and

(iv) the Respondent is not commonly known by the disputed domain name

The Complainants contend that the disputed domain name was registered and used in bad faith given the Respondent's evident knowledge of the Complainants' well-known trademark, displaying the webpage available at the disputed domain name numerous references intended to elicit a connection with the Complainants, including that it has "contacts with miners around the world", and listing the Elko, Nevada address of Nevada Gold Mines, a joint-venture to which the Second Complainant is a majority owner.

B. Respondent

The Respondent did not reply to the Complainants' contentions.

6. Discussion and Findings

Paragraph 4(a) of the Policy sets forth the following three requirements, which have to be met for this Panel to order the transfer of the disputed domain name to the Complainants:

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

The Complainants must prove in this administrative proceeding that each of the aforesaid three elements is present in order to obtain the transfer of the disputed domain name.

A. Identical or Confusingly Similar

The Complainants have established rights in the BARRICK and BARRICK GOLD trademarks, duly registered.

The Panel finds that the disputed domain name reproduces the Complainants' trademarks in their entirety.

The first element of the Policy has therefore been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a non-exclusive list of circumstances that indicate a respondent's rights to or legitimate interests in a disputed domain name. These circumstances are:

- (i) before any notice of the dispute, the respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide*

offering of goods or services; or

- (ii) the respondent (as an individual, business, or other organization) has been commonly known by the disputed domain name, in spite of not having acquired trademark or service mark rights; or
- (iii) the respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Respondent has failed to invoke any of the circumstances which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights to and/or legitimate interests in the disputed domain name. This entitles the Panel to draw any such inferences from such default as it considers appropriate pursuant to paragraph 14(b) of the Rules. Nevertheless, the burden is still on the Complainants to first make a *prima facie* case against the Respondent.

In that sense, the Complainants indeed indicate that the Respondent is not a licensee of the Complainants, nor have Complainants otherwise authorized the Respondent to register the disputed domain name or otherwise use Complainants' BARRICK trademarks.

Also, the absence of any indication that the Respondent has rights in a term corresponding to the disputed domain name, or any possible link between the Respondent and the disputed domain name that could be inferred from the details known of the Respondent or the webpage relating to the disputed domain name that existed, corroborate with the Panel's finding of the absence of rights or legitimate interests.

Another element to consider is the fact that at the webpage that resolves from the disputed domain name, the Respondent make references that elicit a connection with the Complainants, including that it has "contacts with miners around the world", and listing the Elko, Nevada address of Nevada Gold Mines, a joint-venture to which the Second Complainant is a majority owner and yet making no disclaimer as to the lack of relationship between the Respondent and the Complainants, which clearly does not characterize a *bona fide* offering of goods or services under the Policy or a legitimate noncommercial or fair use of the disputed domain name.

Under these circumstances and absent evidence to the contrary, the Panel finds that the Respondent does not have rights or legitimate interests with respect to the disputed domain name.

C. Registered and Used in Bad Faith

The Policy indicates in paragraph 4(b) that bad faith registration and use can be found in view of:

- (i) circumstances indicating that the Respondent has registered or acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring it to the Complainant who is the owner of a trademark relating to the disputed domain name or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the disputed domain name; or
- (ii) the Respondent has registered the disputed domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the Respondent has engaged in a pattern of such conduct; or
- (iii) the Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's website or other location, by creating a likelihood of confusion with the Complainants' mark as to the source, sponsorship, affiliation, or endorsement of the

Respondent's website or location or of a product or service on the Respondent's website or location.

The Panel is satisfied that the disputed domain name has been registered and used in bad faith seeking to create a likelihood of confusion with the Complainants' mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on the Respondent's website or location. Further, the Respondent's choice to retain a privacy protection service so as to conceal its true identity supports a finding of bad faith in the circumstances of this case.

For the reasons stated above, the Respondent's conduct amounts, in this Panel's view, to bad faith registration and use of the disputed domain name.

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 <barrickgold.ltd> be transferred to the Complainants.

/Wilson Pinheiro Jabur/

Wilson Pinheiro Jabur

Sole Panelist

Date: March 14, 2022