

ADMINISTRATIVE PANEL DECISION

Barrick Gold North America Inc., Barrick Gold Corporation v. Paul Buckley
Case No. D2023-0684

1. The Parties

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

The Respondent is Paul Buckley, South Africa.

2. The Domain Names and Registrar

The disputed domain names <barricklumwana.com>, and <lumwanagroup.com> are registered with Lexsynergy Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 14, 2023. On February 15, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On February 15, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainants on February 16, 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 the same day.

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 February 24, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 16, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 20, 2023.

The Center appointed Luca Barbero as the sole panelist in this matter on March 27, 2023. 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

Barrick Gold North America, Inc (hereinafter, the first Complainant) and Barrick Gold Corporation (hereinafter, the second Complainant) are part of a conglomerate that explores gold mining around the world.

The Complainants, 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 1983.

The Complainants are the owners and operators of a copper mine located in the town of Lumwana, Zambia. In 2021, the Complainants produced nearly 242 million pounds of copper ore, selling at USD 2.25 a pound, equally nearly USD 545 million, from the mine of Lumwana.

The second Complainant is the owner of several trademark registrations for BARRICK, including the following, as per trademark certificates submitted as annexes to the Complaint:

- European Union trademark registration no. 008890386 for BARRICK (word mark), filed on February 17, 2010, and registered on August 10, 2010, in international classes 6, 14, and 37;
- European Union trademark registration no. 018012698 for BARRICK (figurative mark), filed on January 21, 2019, and registered on July 3, 2019, in classes 14, 37, and 42;
- United States trademark registration no. 6225225 for BARRICK (word mark), filed on November 3, 2019 and registered on December 22, 2020, in international classes 6, 14, 37, and 42; and
- United States trademark registration no. 6592636 for BARRICK (figurative mark), filed on January 18, 2019, and registered on December 21, 2021, in international classes 14, 37, and 42.

The Complainants operate their main website at the domain name <barrick.com>, registered on October 6, 1995, that they use to advertise and promote a variety of mining services, business initiatives, and other commercial endeavors under the trademark BARRICK.

The disputed domain names respectively registered on October 21, 2022, and May 19, 2022, are both pointed to websites displaying an inaccessible “cgi-bin” folder. According to the evidence submitted by the Complainants – which has not been challenged by the Respondent – both disputed domain names have been used for the creation of email addresses used to conduct an active email phishing and scam campaign. In particular, according to the present records, email communications based on addresses created on the disputed domain names and using the Complainants’ trademarks have been addressed by individuals pretending to represent the procurement of the Complainants’ affiliated company in Zambia who requested recipients to provide their information to register as vendor of the Complainants or sent out request for quotations and invoices for the supply of industrial motors and pumps.

5. Parties’ Contentions

A. Complainant

The Complainants contend that the first disputed domain name is confusingly similar to the trademark BARRICK in which the Complainant has rights as it reproduces the trademark in its entirety with the mere addition of the geographical term “lumwana”, referring to a mining location based in Zambia, and the generic Top-Level Domain (“gTLD”) “.com”.

The Complainants also state that, in 2011, it acquired a 100 percent interest in a mine located in Lumwana and that, for over a decade, the term “lumwana” has been exclusively used to reference the Complainants’ mining operations at this particular mine in Zambia.

The Complainants further asserts that, although the Lumwana mine is located in Zambia, the Complainants have acquired significant common law rights in the name LUMWANA in the United States.

The Complainants submits the following statements to substantiate its claims for common law rights in the name LUMWANA:

- i) the Complainants exclusively refer to its copper mine in Zambia as LUMWANA, as shown by screenshots of the Complainants’ website at Annex 7 to the Complaint;
- ii) the Complainants have a Facebook profile dedicated to its LUMWANA mine, accessible to consumers in the United States, with over 8,000 followers, as shown in Annex 13 to the Complaint;
- iii) LUMWANA only references the Complainants’ copper mine and the corresponding mining town, as it has no other significance to the consumer public, as evidenced by a search engine search that only yields results relating to the Complainants, as shown in Annex 9 to the Complaint;
- iv) the Complainants actively advertise their services associated with the LUMWANA mines in the United States, and the resources from those mines to consumers and investors in the United States, as shown by the screenshots of the Complainants’ website in Annex 5 to the Complaint;
- v) the price per pound of the copper mined from the LUMWANA mine is reflected in U.S. Dollars, as shown in Annex 7 to the Complaint; and
- vi) the Complainants are promoting in their LUMWANA mine such as “unlock[ing] further value at Lumwana through investment in an owner miner fleet”, referencing to LUMWANA as a “growth engine” for the Complainants, as shown by copy (in Annex 14 to the Complaint) of a presentation presented to potential investors during the Complainants’ “2022 Investor Day” on November 18, 2022, an event broadcast live from the New York Stock Exchange in New York City.

Consequently, the Complainants submit that the second disputed domain name is confusingly similar to the trademark LUMWANA in which it has common law rights as it reproduces the trademark in its entirety with the mere addition of the word “group” and the gTLD “.com”. The Complainants contend that, considering their common law rights on LUMWANA and the fact that there is no other plausible commercial use for the mark LUMWANA if not that associated to their mine, the disputed domain name is still being used to create an association with the Complainants.

With reference to rights or legitimate interests in respect of the disputed domain names, the Complainants state that their use of the trademark BARRICK dates back to at least as early as 1983 and their earliest registration for the trademark BARRICK was issued on September 18, 2013, while their earliest use of the trademark LUMWANA dates back to at least as early as 2011. The Complainants highlight that both of these dates in any case, predate the Respondent’s registration of the disputed domain names by nearly four decades, as the disputed domain names were not registered until 2022.

The Complainants state that the Respondent is not a licensee of the Complainants, has not been commonly known by the disputed domain names or by the trademarks BARRICK or LUMWANA and has in no way been authorized by the Complainants to register the disputed domain names or otherwise use the Complainants’ trademarks BARRICK or LUMWANA.

Moreover, the Complainants submit that they have no relationship or affiliation with the Respondent and that the Respondent is attempting to intentionally confuse potential consumers by misrepresenting such an affiliation. Indeed, according to reports provided to the Complainants, the Respondent succeeded in

confusing, deceiving and defrauding consumers. The Complainants conclude that the Respondent's use of the disputed domain names does not amount to a *bona fide* offering of goods or services.

The Complainants further submit that the Respondent appears to be using the disputed domain names in an active email phishing campaign in an attempt to induce payment or engagement from the Complainants' customers. The Complainants were informed that individuals are using email addresses under the disputed domain names to send out fake invoices and requests for proposals using the Complainants' trademarks BARRICK and LUMWANA and purporting to be the Complainants.

The Complainants further explain that one of their potential suppliers received an email inviting the recipient to "be a vendor with us at the Lumwana Copper Mine west of Solwezi in Zambia's copperbelt". The email goes on to state "we are currently registering new suppliers from across Zambia, Africa, and the Globe". Some of these suppliers, believing the email came from the Complainants, provided goods and services, but never received any payment. Instead, they showed up at the Complainants' corporate office for the LUMWANA-branded mine, hoping to be paid, only to learn that the person they had communicated was not affiliated with the Complainants, and they had been scammed out of payment.

The Complainants highlight that they never even authorized the Respondent to use the disputed domain names or corresponding email address to contact their suppliers and confirm that no employee at the Complainants shares the name of the person mentioned in the phishing email communication sent from such email address.

The Complainants also states that, in addition to the above fraudulent activities, the prospective suppliers and vendors were receiving requests for quotations and purchase orders using the BARRICK logo from an individual who claimed to be a project manager. The purchase order, in particular, listed the Complainant's Zambia address (P.O. Box 50628 Ridgeway in Lusaka, Zambia). The Complainants confirm that there is no employee at the Complainants with such name and submit that the Respondent, using the fraudulent email address and BARRICK logos, has been attempting to deceive suppliers into providing them with equipment valuing at nearly USD 300,000 without ever providing payment, all while purporting to be the Complainants.

In view of the above, the Complainants claim that, using the disputed domain names in an email phishing scheme in relation to the issuance of processing of invoices is clear evidence of illegitimate activities and proves the Respondent does not have rights or legitimate interests in the disputed domain names.

With reference to the circumstances evidencing bad faith, the Complainants indicate that it is inconceivable that the Respondent registered the disputed domain names containing the Complainants' well-known and distinctive trademark BARRICK and the exclusive trademark LUMWANA, without the intent of capitalizing on the goodwill the Complainants own in the BARRICK trademarks. The Complainants further asserts that the same is true for the LUMWANA term, which can only reference the Complainants' copper mining services.

The Complainants emphasize that the Respondent's registration of both the disputed domain names was apparently done in concert to portray some semblance of legitimacy or impersonation of the Complainants, as further evidenced by the use of the Complainants' BARRICK logo at the top of the documents provided via the fraudulent email address.

The Complainants further underline that the Respondent's use of the disputed domain names for phishing purposes supports a finding of bad faith registration and use with the intent to pass itself off as the Complainants and create an improper affiliation.

Based on the foregoing, the Complainants conclude that the Respondent undoubtedly registered the disputed domain names (i) with the specific intent to cause consumer confusion and to free ride on the vast, internationally-recognized goodwill associated with the Complainants' trademark BARRICK and the exclusive use of the trademark LUMWANA; and/or (ii) for the purpose of creating the false impression that the Respondent is member, licensee, or representative of the Complainants, which the Respondent is not.

B. Respondent

The Respondent did not reply to the Complainants' contentions.

6. Discussion and Findings

According to paragraph 15(a) of the Rules: "A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable." Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

- (i) that the disputed domain names registered by the Respondent are identical or confusingly similar to a trademark or service mark in which the Complainants have rights;
- (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain names; and
- (iii) that the disputed domain names have been registered and are being used in bad faith.

A. Identical or Confusingly Similar

The Panel finds that the Complainants have established rights over the trademark BARRICK based on the trademark registrations cited under section 4 above and the related trademark certificates submitted as annex 4 to the Complaint.

As highlighted in section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), the first element functions primarily as a standing requirement, and the threshold test for confusing similarity typically involves a side-by-side comparison of the domain names and the textual components of the relevant trademarks to assess whether the mark is recognizable within the disputed domain names. Moreover, as stated in section 1.8 of the [WIPO Overview 3.0](#), where the relevant trademark is recognizable within the disputed domain names, the addition of other, e.g., descriptive or geographical terms would not prevent a finding of confusing similarity under the first element.

In the case at hand, the Panel finds that the first disputed domain name is confusingly similar to the Complainants' trademark BARRICK as it reproduces the trademark in its entirety within the gTLD ".com", which can be disregarded when comparing the similarities between a domain name and a trademark, and the mere addition of the geographical term "lumwana", which does not prevent a finding of confusing similarity.

The Complainant also rely on common law rights on LUMWANA. As stated in Section 3.1 of the [WIPO Overview 3.0](#), "To establish unregistered or common law trademark rights for purposes of the UDRP, the complainant must show that its mark has become a distinctive identifier which consumers associate with the complainant's goods and/or services. Relevant evidence demonstrating such acquired distinctiveness (also referred to as secondary meaning) includes a range of factors such as (i) the duration and nature of use of the mark, (ii) the amount of sales under the mark, (iii) the nature and extent of advertising using the mark, (iv) the degree of actual public (e.g., consumer, industry, media) recognition, and (v) consumer surveys. [...] Specific evidence supporting assertions of acquired distinctiveness should be included in the complaint; conclusory allegations of unregistered or common law rights, even if undisputed in the particular UDRP case, would not normally suffice to show secondary meaning".

The Panel has reviewed the documents and statements submitted by the Complainants (detailed under section 5A above) and finds that, in the particular circumstances of this case, they have provided sufficient evidence for the Panel to conclude that they hold rights in the term LUMWANA for purposes of standing in this proceeding.

The Panel also finds that the second disputed domain name is confusingly similar to the trademark LUMWANA in which the Complainants have established rights as it reproduces the trademark in its entirety with the mere addition of the word “group” and the gTLD “.com”, which the Panel finds insufficient to exclude the confusing similarity.

Therefore, the Panel finds that the Complainants have proven that the disputed domain names are confusingly similar to trademarks in which the Complainants have established rights according to paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainants must show that the Respondent has no rights or legitimate interests in respect of the disputed domain names. The Respondent may establish a right or legitimate interest in the disputed domain names by demonstrating in accordance with paragraph 4(c) of the Policy any of the following:

- “(i) before any notice to you of the dispute, your use of, or demonstrable 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; or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are 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 or service mark at issue.”

In the case at hand, the Panel finds that the Complainants have made a *prima facie* case and the Respondent, by not submitting a Response, has failed to invoke any circumstance that could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in the disputed domain names.

Moreover, it has been repeatedly stated that, when a respondent does not avail himself of its right to respond to a complaint, it can be assumed in appropriate circumstances that the respondent has no rights or legitimate interests in the disputed domain names.

The Panel notes that there is no relation, disclosed to the Panel or otherwise apparent from the record, between the Respondent and the Complainants. The Respondent is not a licensee of the Complainants, nor has the Respondent otherwise obtained an authorization to use the Complainants’ trademarks.

Furthermore, there is no indication before the Panel that the Respondent is commonly known by the disputed domain names, has made preparations to use the disputed domain names in connection with a *bona fide* offering of goods or services, or that it intends to make a legitimate, noncommercial or fair use of the disputed domain names.

As mentioned above under section 4, the disputed domain names have been pointed to websites displaying an inaccessible “cgi-bin” folder, and – according to the evidence submitted by the Complainants, which has not been contested by the Respondent - have been used for the creation of email addresses used to send out email communications with fake invoices and requests for proposals or request for registration as a vendor of the Complainants, reproducing the Complainants’ trademarks and mentioning also the address of the Complainants’ affiliated company in Zambia.

In view of the above, the Panel finds that the Respondent’s use of the disputed domain names does not amount to a *bona fide* offering of goods or services or a legitimate noncommercial or fair use without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainants’ trademarks.

Indeed, as stated in section 2.13.1 of the [WIPO Overview 3.0](#), prior panels have categorically held that the

use of a domain name for illegal activity, such as phishing, impersonation/passing off, or other types of fraud, can never confer rights or legitimate interests on a respondent.

Therefore, the Panel finds that the Complainants have proven that the Respondent has no rights or legitimate interests in the disputed domain names according to paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy requires that the Complainants prove that the disputed domain names were registered and are being used by the Respondent in bad faith.

The Panel finds that, in light of the prior registration and use of the Complainants' trademarks BARRICK and LUMWANA in connection with the Complainants' products and services, including online via the Complainants' website at the domain name <barrick.com>, and considering the confusing similarity of the disputed domain names with the Complainants' trademarks, the Respondent very likely registered the disputed domain names having the Complainants and their trademarks in mind.

Furthermore, the circumstance that, according to the present records, the disputed domain names have been used for the creation of email addresses used to contact potential suppliers and vendors of the Complainants for phishing and/or scam purposes, whilst featuring the Complainants' trademarks and address in Zambia and providing information about the Complainants' products and services, demonstrates that the Respondent was indeed well aware of the Complainants and their trademarks at the time of registering the disputed domain names.

The disputed domain names have been pointed to webpages displaying only an inaccessible "cgi-bin" folder. It is well established that passive holding of a domain name does not prevent a finding of bad faith under certain circumstances as decided, *i.a.*, in *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#).

In the present case, in view of i) the confusing similarity of the disputed domain names to the Complainants' trademarks; ii) the absence of any documented rights or legitimate interests of the Respondent in the disputed domain names; and iii) the use of the disputed domain names in connection with phishing or scam email communications, as demonstrated by the evidence submitted by the Complainants – which has not been challenged by the Respondent – the Panel finds that the current passive holding of the disputed domain names does not prevent a finding of bad faith registration and use. See section 3.3 of the [WIPO Overview 3.0](#).

Moreover, the Respondent's use of the disputed domain names for the sending of fraudulent email communications apt to induce recipients to believe that they were dealing with the Complainants' affiliated company clearly demonstrates the Respondent's bad faith intentions.

As stated in section 3.4 of the [WIPO Overview 3.0](#), "Panels have held that the use of a domain name for purposes other than to host a website may constitute bad faith. Such purposes include sending email, phishing, identity theft, or malware distribution. [...] Many such cases involve the respondent's use of the domain name to send deceptive emails, e.g., to obtain sensitive or confidential personal information from prospective job applicants, or to solicit payment of fraudulent invoices by the complainant's actual or prospective customers".

Therefore, the Panel finds that the Complainants have also proven that the Respondent registered and is using the disputed domain names in bad faith according to 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 disputed domain names, <barricklumwana.com>, and <lumwanagroup.com>, be transferred to the Complainants.

/Luca Barbero/

Luca Barbero

Sole Panelist

Date: April 10, 2023