

ADMINISTRATIVE PANEL DECISION

Barnes Europe Consulting Kft. and Heidi Barnes-Watson v. Sebastian Estrada

Case No. D2025-1004

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 Sebastian Estrada, United States.

2. The Domain Name and Registrar

The disputed domain name <barnes-costarica.com> (the “Disputed Domain Name”) is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 12, 2025. On March 12, 2025, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On March 12, 2025, 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 March 14, 2025, 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 March 17, 2025.

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 March 19, 2025. In accordance with the Rules, paragraph 5, the due date for Response was April 8, 2025. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 11, 2025.

The Center appointed Nicholas Weston as the sole panelist in this matter on April 28, 2025. 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 First Complainant is a company within the Barnes International group which operates a real estate agency business with operations in 15 countries. The Second Complainant is the group's founder. The first and second named Complainants are referred to in this decision, collectively, as the "Complainant".

The Complainants jointly hold registrations for the trademark BARNES in numerous countries including and French trademark registration number 3861673 for the BARNES trademark, registered on January 20, 2012 and International Registration No. 1510264 for the mark BARNES, registered on June 27, 2019.

The Complainant owns the domain name <barnes-international.com> which hosts a website operated by the Complainant.

The Disputed Domain Name was registered on October 22, 2024. The Disputed Domain Name is inactive, and has been used previously to redirect Internet traffic to a pay-per-click ("PPC") webpage.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Disputed Domain Name.

Notably, the Complainant cites a number of trademark registrations for the mark BARNES, and variations of it, as prima facie evidence of ownership.

The Complainant submits that its rights in the mark BARNES predate the Respondent's registration of the Disputed Domain Name and submits that the Disputed Domain Name is identical to its trademark, for the reason that the Disputed Domain Name "wholly incorporates the Complainant's trademark BARNES and merely adds the geographic term "Costa Rica", the two elements being separated by a hyphen." generic Top-Level Domain ("gTLD") ".com".

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because it "has neither authorized nor licensed the Respondent to use its trademarks in any way" and contends that none of the circumstances set out in paragraph 4(c) of the Policy apply.

Finally, the Complainant alleges that the registration and use of the Disputed Domain Name was, and currently is, in bad faith, contrary to the Policy and the Rules having regard to the prior use and "well-known nature of the Complainant's trademarks", and advances the argument that the use of the Disputed Domain Name to display PPC links is use in bad faith.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

6.1 Consolidation

WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.11.1 states: "Paragraph 10(e) of the UDRP Rules grants a panel the power to consolidate multiple domain name disputes. At the same time, paragraph 3(c) of the UDRP Rules provides that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder. In assessing whether a complaint filed by multiple complainants may be brought against a single respondent, panels look at whether (i) the complainants have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants in a similar fashion, and (ii) it would be equitable and procedurally efficient to permit the consolidation."

The Panel accordingly concludes that it is fair and equitable for the Complaint to proceed in the name of both of the Complainants since both Complainants have a common grievance against the Respondent and it is procedurally efficient to proceed in a single Complaint.

6.2 Substantive Matters

Under paragraph 4(a) of the Policy, the Complainant has the burden of proving the following:

- (i) that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and
- (iii) that 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 Complainant has 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 Complainant has produced sufficient evidence to demonstrate that it has registered trademark rights in the mark BARNES in several countries.

Turning to whether the Disputed Domain Name is identical or confusingly similar to the BARNES trademark, the Panel observes that the Disputed Domain Name is comprised of: (a) an exact reproduction of the Complainant's trademark BARNES; (b) followed by a hyphen; (c) followed by the country name "costarica" (d) followed by the gTLD ".com".

It is well established that the gTLD used as part of a domain name is generally disregarded under the first element confusing similarity test. [WIPO Overview 3.0](#), section 1.11.1. The relevant comparison to be made is with the second-level portion of the Disputed Domain Name, specifically: "barnes-costarica".

The entirety of the mark is reproduced within the Disputed Domain Name. Accordingly, the Disputed Domain Name is identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

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 Disputed 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 Disputed 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 finds that there is no indication that the Respondent was commonly known by the term “barnes” prior to registration of the Disputed Domain Name. The Complainant has not licensed, permitted, or authorized the Respondent to use the trademark BARNES. The Panel also notes that the composition of the Disputed Domain Name carries a risk of implied affiliation (see [WIPO Overview 3.0](#), section 2.5.1).

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name. The Respondent has not rebutted the Complainant’s 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 Panel notes the evidence that the Disputed Domain Name resolves to an inactive webpage, which supports the Complainant’s evidence, and finds that this does not represent a bona fide offering of goods or services, or a legitimate noncommercial or fair use, given the substantial reputation and goodwill of the Complainant’s mark or capacity to otherwise mislead Internet users.

The Panel also notes the evidence that the Disputed Domain Name previously resolved to a PPC parking page displaying the words “réserver un séjour” (in English: “book a stay”), and “Hotels”, and finds that this does not represent a bona fide offering of goods or services, or a legitimate noncommercial or fair use, given the substantial reputation and goodwill of the Complainant’s mark or capacity to otherwise mislead Internet users.

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.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent’s registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

In the present case, the Panel finds that the evidence in the case shows the Respondent registered and has used the Disputed Domain Name in bad faith.

On the issue of registration, this Panel finds that there is no reason for the Respondent to have registered the Disputed Domain Name other than to trade off the reputation and goodwill of the Complainant’s well-known trademark. [WIPO Overview 3.0](#), section 3.1.4.

Further, a gap of several years between registration of a complainant's trademark and respondent's registration of a disputed domain name (containing the trademark) may indicate bad faith registration. In this case, the Respondent registered the Disputed Domain Name some 13 years after the Complainant established registered trademark rights in the BARNES mark. The Respondent has not come forward to rebut the Complainant's allegations or offering any alternative explanation.

On the issue of use, the Disputed Domain Name does not currently resolve to an active website.

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. [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the Complainant's well-known trademark, and the composition of the Disputed Domain Name and finds that in the circumstances of this case the passive holding of that Disputed Domain Name does not prevent a finding of bad faith under the Policy.

The Complainant's evidence is also that the Disputed Domain Name resolved, for a period of time, to a website displaying PPC links relating to accommodation. Targeting of this nature is a common example of bad faith as referred to in paragraph 4(b)(iv) of the Policy and identified in many previous UDRP decisions. [WIPO Overview 3.0](#), sections 3.1.4 and 3.2.1.

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 <barnes-costarica.com> be transferred to the Complainant.

/Nicholas Weston/

Nicholas Weston

Sole Panelist

Date: May 12, 2025.