

ADMINISTRATIVE PANEL DECISION

Barnes Europe Consulting Kft. and Ms. Heidi Barnes-Watson v. Nganji Bernard Tume

Case No. D2023-0556

1. The Parties

The Complainants are Barnes Europe Consulting Kft., Hungary (“First Complainant”) and Ms. Heidi Barnes-Watson, United States of America (“United States”) (“Second Complainant”), both represented by Inlex IP Expertise, France.

The Respondent is Nganji Bernard Tume, India.

2. The Domain Name and Registrar

The disputed domain name <barnes-realestate.com> is registered with OwnRegistrar, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 7, 2023. On February 7, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 10, 2023, 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 (WhoisSecure) and contact information in the Complaint. The Center sent an email communication to the Complainants on February 10, 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 February 10, 2023.

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 Complaints, and the proceedings commenced on February 13, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 5, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 8, 2023.

The Center appointed Assen Alexiev as the sole panelist in this matter on March 15, 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

The Complainants are real estate agents for high-end residential real estate in the popular cities and top holiday destinations in over 15 countries. They also provide a range of other luxury services, including private jet and yacht charter, art advisory, interior decoration, and brokerage services.

The Complainants are joint owners of the following trademark registrations for the sign “BARNES” (the “BARNES trademark”):

- the French Trademark BARNES with registration No. 3861673, registered on September 26, 2011, for services in International Classes 36, 37, and 42;
- the International Trademark BARNES with registration No. 1114909, registered on March 13, 2012, for services in International Classes 36, 37, and 42; and
- the European Union Trademark BARNES with registration No. 018037155, registered on September 26, 2019, for services in International Classes 35, 36, 37, and 42.

The Complainants are also the owners of the domain name <barnes-international.com>, registered on July 25, 2007, which resolves to the Complainants’ main website.

The disputed domain name was registered on November 12, 2022. It is currently inactive. At the time of filing of the Complaint, it resolved to a website describing the services of a real estate company under the name Barnes Real Estate, based in Sweden.

5. Parties’ Contentions

A. Complainants

The Complainants state that the disputed domain name is confusingly similar to their BARNES trademark, because it wholly incorporates this trademark with the addition of the dictionary words “real” and “estate”, separated by a hyphen.

According to the Complainants, the Respondent has no rights or legitimate interests in respect of the disputed domain name, because it has no trademark rights for BARNES or BARNES REAL ESTATE, there is no relationship between the Parties, and the Complainants have not authorized the Respondent to use the BARNES trademark. The Complainants add that a simple search on Google with the keywords “barnes real estate” returns no pertinent results related to the Respondent, and all results are related to the Complainants. According to the Complainants, there is no reason why the Respondent would register the disputed domain name except for taking unfair advantage of the reputation of the Complainants’ trademark and for diverting the Complainants’ customers for its own advantage.

The Complainants contend that the disputed domain name was registered and is being used in bad faith. According to them, the BARNES trademark is well-known in France and in several countries and enjoys a wide reputation worldwide. The Complainants maintain that the disputed domain name was registered with the aim of taking advantage of the BARNES trademark. They point out that the website at the disputed domain name states that “Barnes Real Estate is a Swedish based leading active real estate and private equity with over 15 large scale investment projects* in Asia [...]”. There is however no company called “Barnes Real Estate” based in Sweden. The website at the disputed domain name presents the CEO of the

alleged Swedish company, who is said to be called “Jonathan Barnes”. A simple search through Google Lens however shows that the photo is of a Luxembourgian businessman with a completely different name. The Complainants add that mail exchange records have been activated for the disputed domain name, and a third person receiving an email based on the disputed domain name would mistakenly think it came from the Complainants, so the disputed domain name may be used for misleading consumers.

B. Respondent

The Respondent did not reply to the Complainants’ contentions.

6. Discussion and Findings

6.1. Procedural issue – Consolidation of the Complainants

The Complainants have jointly filed the Complaint and submit a request for consolidation of their disputes with the Respondent in respect of the disputed domain name. They maintain that they are joint owners of the BARNES trademark to which the disputed domain name is confusingly similar, and that the Complainants are the target of common conduct by the Respondent. The Complainants submit that it would be equitable and procedurally efficient to permit consolidation of their complaints against the Respondent.

Paragraph 10(e) of the Rules grants a panel the power to consolidate multiple domain name disputes. The Policy and the Rules do not directly regulate the consolidation of multiple Complainants in a single Complaint. As discussed in section 4.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), in assessing whether a complaint filed by multiple complainants may be brought against a single respondent, panels look at whether 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 whether it would be equitable and procedurally efficient to permit the consolidation.

The Complainants have shown that they are joint owners of the BARNES trademark, and they have brought forward certain common grievances against the Respondent in the Complaint. The Respondent has not objected to the consolidation of the Complainants and has not advanced any reasons why it may not be equitable and procedurally efficient to consolidate the Complainants. Therefore, the Panel decides to allow the consolidation of the Complainants in this proceeding.

6.2. Substantive issues

Pursuant to the Policy, paragraph 4(a), the Complainants must prove each of the following to justify the transfer of the disputed domain name:

- (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 Respondent has registered and is using the disputed domain name in bad faith.

A. Identical or Confusingly Similar

The Complainants have provided information that they are joint owners of the BARNES trademark and have thus established their trademark rights for the purposes of the Policy.

The Panel notes that a common practice has emerged under the Policy to disregard in appropriate circumstances the generic Top-Level Domain (“gTLD”) for the purposes of the comparison under the Policy,

paragraph 4(a)(i). See section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). The Panel sees no reason not to follow the same approach here, so it will disregard the ".com" gTLD section of the disputed domain name.

The relevant part of the disputed domain name is therefore the sequence "barnes-realestate", in which the elements "barnes", "real" and "estate" can easily be distinguished. The first of these elements reproduces the BARNES trademark in its entirety, while the second and third are additional words, and the trademark is easily recognizable in the disputed domain name. As discussed in section 1.8 of the [WIPO Overview 3.0](#), where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.

Therefore, the Panel finds that the disputed domain name is confusingly similar to the BARNES trademark in which the Complainants have rights.

B. Rights or Legitimate Interests

While 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 often-impossible 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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. See section 2.1 of the [WIPO Overview 3.0](#).

The Complainants maintain that the Respondent has no rights or legitimate interests in the disputed domain name, as it is not connected to them and has not been authorized by them to use the BARNES trademark, and has no relevant trademark rights. Rather, the Respondent is using the disputed domain name for a website featuring a non-existent Swedish real estate company and a fake photo of its alleged CEO, and has set up an email account with the disputed domain name which may be used to send fraudulent emails to third parties. Thus, 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 submitted a Response and has not denied the statements of the Complainants or submitted any evidence of rights or legitimate interests in the disputed domain name.

The disputed domain name is confusingly similar to the BARNES trademark of the Complainants and its composition may lead Internet users to believe that it belongs to them. The evidence in the case confirms that it has been associated to a website of an alleged Swedish company with the name "Barnes Real Estate", and the Complainants have submitted evidence showing that no such company has been registered in Sweden and that the photo of the alleged CEO of this company belongs to another person with a different name. The Complainant has also shown that mail exchange settings have been activated for the disputed domain name.

Taking all this together, and in the absence of any contrary evidence, the Panel concludes that it is more likely than not that the Respondent must have registered the disputed domain name due to its confusing similarity to the Complainants' BARNES trademark in an attempt to mimic itself as the Complainants and thus confuse Internet users as to its real identity using a fake identity and photo. The Panel does not regard such conduct as legitimate or giving rise to rights or legitimate interests in the disputed domain name.

Therefore, the Panel finds that the Respondent does not have rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists four illustrative alternative circumstances that shall be evidence of the registration and use of a domain name in bad faith by a respondent, namely:

“(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the 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 you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location.”

The provisions of paragraph 4(b) of the Policy are without limitation, and bad faith registration and use may be found on grounds otherwise satisfactory to the Panel.

The disputed domain name is confusingly similar to the Complainant’s BARNES trademark, which was first registered more than ten years earlier. The Respondent does not deny the statements of the Complainant that the disputed domain name was used for a website advertising the services of a non-existent real estate company and to set up email accounts with the disputed domain name. The evidence confirms that such company does not exist and that its alleged CEO is an unrelated person with a different name. It should be expected that a party resorting to such means to deceive Internet users is likely to be doing this for financial gain. Furthermore, the words “real estate” creates a likelihood of confusion with the BARNES trademark, because they describe the field of activity of the Complainants, protected by the BARNES trademark.

In view of the above, the Panel accepts as more likely than not that the Respondent has registered the disputed domain name with knowledge of the Complainants and targeting their BARNES trademark, and that by using the disputed domain name for advertising the services of a non-existent real estate company and for setting up email accounts, the Respondent has intentionally attempted to mislead Internet users that it is related to the Complainant for financial gain as per paragraph 4(b)(iv) of the Policy.

Therefore, the Panel finds that the disputed domain name has been registered and used in bad faith.

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-realestate.com>, be transferred to the First Complainant, Barnes Europe Consulting Kft.

/Assen Alexiev/

Assen Alexiev

Sole Panelist

Date: March 28, 2023