

ADMINISTRATIVE PANEL DECISION

Barrick Gold of North America, Inc., Barrick Gold Corporation v. Name Redacted¹.

Case No. D2023-2177

1. The Parties

The Complainants are Barrick Gold of North America, Inc., Barrick Gold Corporation, United States of America (the "US"), represented by Dorsey & Whitney, LLP, US.

The Respondent is Name Redacted

2. The Domain Name and Registrar

The disputed domain name <barrickcorp.com> (the "Disputed Domain Name") is registered with NameCheap, Inc. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on May 17, 2023. On May 19, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 19, 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 (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainants on May 22, 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 May 22, 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

¹ The Respondent appears to have used the name of a third party when registering the disputed domain name. In light of the potential identity theft, the Panel has redacted the Respondent's name from this decision. However, the Panel has attached as Annex 1 to this decision an instruction to the Registrar regarding transfer of the disputed domain name, which includes the name of the Respondent. The Panel has authorized the Center to transmit Annex 1 to the Registrar as part of the order in this proceeding, and has indicated Annex 1 to this decision shall not be published due to the exceptional circumstances of this case. See *Banco Bradesco S.A. v. FAST-12785241 Attn. Bradescourgente.net / Name Redacted*, WIPO Case No. [D2009-1788](#).

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 May 25, 2023. In accordance with the Rules, paragraph 5, the due date for Response was June 14, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 15, 2023.

The Center appointed Christiane Féral-Schuhl as the sole panelist in this matter on June 22, 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 companies composing one of the largest gold mining operations in the world.

The Complainants are the owner of several trademarks (hereinafter the “BARRICK Trademarks”) and notably:

- the US word mark ‘BARRICK’ No. 4578245 registered on August 5, 2014, for products and services in classes 37 and 42;
- the US wordmark ‘BARRICK GOLD’ No. 4683358 registered on February 10, 2015, for products and services in class 42;
- the Canadian wordmark ‘BARRICK NEVADA’ No. TMA1063113 registered on November 14, 2019, for products and services in classes 37 and 42;
- the European Union wordmark ‘BARRICK’ No. 008890386 registered on August 10, 2010, for products and services in classes 6, 14 and 37.

The Complainants also own a domain name comprising of the BARRICK Trademarks: <barrick.com>.

The Disputed Domain Name was registered on May 2, 2023, and at the time of the Complaint reverted to the Complainants’ own website and was used to send email to third parties impersonating some employees of the Complainants as part of a phishing scheme. At the time of the decision, the Disputed Domain Name is inactive.

5. Parties’ Contentions

A. Complainants

First, the Complainants stand that the Disputed Domain Name is confusingly similar to their earlier BARRICK Trademarks. The Complainants assert that they are well-known in the United States and around the world by the BARRICK Trademarks. The Complainants consider that the Disputed Domain Name is confusingly similar to their BARRICK Trademarks since it is composed of the BARRICK Trademarks and of the word “corp” which is an abbreviation for the word “corporation”. For the Complainants, the Disputed Domain Name is likely to cause consumers to mistakenly believe that the Respondent is affiliated with, endorsed by, or sponsored by the Complainants.

Secondly, the Complainants support that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name since the BARRICK Trademarks were registered well before the registration of the Disputed Domain Name. The Complainants assert that the Respondent has not been licensed nor authorized to use the Disputed Domain Name nor is he well-known under the Disputed Domain Name. For the Complainants, the use of the Disputed Domain Name demonstrates that the Respondent was deliberately targeting the Complainants when registering the Disputed Domain Name. The Complainants explain that there is no evidence showing that the Respondent is making a legitimate or fair use of the Disputed Domain Name.

Lastly, the Complainants consider that the Disputed Domain Name was registered and is being used in bad faith. The Complainants assert that the Disputed Domain Name is used as part of the phishing scheme to send emails purporting to be some of their employees. For the Complainants, this is evidence that the Respondent has selected the Disputed Domain Name with knowledge of the reputation of the Complainants and their BARRICK Trademarks.

B. Respondent

The Respondent did not reply to the Complainants' contentions.

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to be entitled to a transfer of the Disputed Domain Name, the Complainants shall prove the following three elements:

- (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.

A. Identical or Confusingly Similar

According to the Policy, paragraph 4(a)(i), the Complainants shall prove that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainants have rights.

First of all, the Panel finds that the Complainants have provided evidence that they have rights in the BARRICK Trademarks.

Then, the Panel wishes to remind that the first element of the UDRP serves essentially 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. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the domain name. In cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of the UDRP (see section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#))).

Regarding the Disputed Domain Name, the Panel finds that it is composed of:

- the BARRICK Trademarks;
- the word "corp"; and

- the generic Top-Level Domain (“gTLD”) “.com”.

The gTLD in a domain name is viewed as a standard registration requirement and as such is usually disregarded for the purpose of determining whether a domain name is identical or confusingly similar to a trademark.

According to prior UDRP panel decisions, it is sufficient that the disputed domain name incorporates the entirety of a trademark, in order to consider the domain name as confusingly similar to that mark for purposes of UDRP standing. The mere addition of descriptive or geographical term to a mark does not prevent a finding of confusing similarity (see section 1.8 of the [WIPO Overview 3.0](#)).

Regarding the Disputed Domain Name, the Panel finds that it incorporates the BARRICK Trademark in its entirety and considers that the insertion of the word “corp” as an abbreviation for the word “corporation”, does not prevent a finding of confusing similarity. Therefore, the Panel finds that these elements do not prevent the BARRICK Trademarks to be recognizable in the Disputed Domain Name.

Therefore, the Panel holds that the Disputed Domain Name is confusingly similar to the Complainants’ BARRICK Trademarks, and that the Complainants have established the first element of paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

According to the Policy, paragraph 4(a)(ii), the Complainants shall demonstrate that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

The Policy, paragraph 4(c), outlines circumstances that if found by the Panel to be proved shall demonstrate the Respondent’s rights or legitimate interests in the Disputed Domain Name.

These circumstances are:

- before any notice of the dispute to the respondent, the respondent’s 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
- the respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or
- the respondent is 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.

According to prior UDRP panel decisions, it is sufficient that a complainant shows *prima facie* that a respondent lacks rights or legitimate interests in a domain name in order to shift the burden of production to the respondent (see *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#)).

Indeed, while the overall burden of proof in a UDRP proceeding is on the complainant, previous UDRP 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 *prima facie* that a 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](#)).

According to the Panel, the Complainants have shown *prima facie* that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. Indeed, it appears that the Respondent have not received any authorization to use the BARRICK Trademarks in any manner, including in domain names. Moreover, the Panel finds that there is no evidence that the Respondent is commonly known by the Disputed Domain Name or that the Respondent has the intent to use the Disputed Domain Name in connection with a *bona fide* offering of goods or services. On the contrary, the Complainants have provided evidence that the Disputed Domain Name is used as part of a phishing scheme via the sending of emails using the Disputed Domain Name by people impersonating employees of the Complainants.

In any case, the Respondent did not reply to the Complainants' contentions, and consequently, did not rebut the Complainant's *prima facie* case.

Therefore, according to the Policy, paragraphs 4(a)(ii) and 4(c), the Panel considers that the Complainants have established that the Respondent does not have any rights or legitimate interests in the Disputed Domain Name.

C. Registered and Used in Bad Faith

According to the Policy, paragraph 4(a)(iii), the Complainants shall prove that the Disputed Domain Name has been registered and is being used in bad faith.

Thus, paragraph 4(b) provides that any one of the following non-exclusive scenarios constitutes evidence of a respondent's bad faith:

- (i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name to the complainant who is the owner of the trademark or service mark or to a competitor of that the complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or
- (ii) the respondent has 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 the respondent has engaged in a pattern of such conduct; or
- (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 the respondent's website or location or of a product or service on the respondent's website or location.

According to prior UDRP decisions, particular circumstances panels may take into account in assessing whether the respondent's registration of a domain name is in bad faith include: (i) the nature of the domain name (e.g., a typo of a widely known mark, or a domain name incorporating the complainant's mark plus an additional term such as a descriptive or geographic term, or one that corresponds to the complainant's area of activity or natural zone of expansion), (ii) the chosen top-level domain (e.g., particularly where corresponding to the complainant's area of business activity or natural zone of expansion), (iii) the content of any website to which the domain name directs, including any changes in such content and the timing thereof [...], (vii) a clear absence of rights or legitimate interests coupled with no credible explanation for the respondent's choice of the domain name, or (viii) other indicia generally suggesting that the respondent had somehow targeted the complainant (see section 3.2.1 of the [WIPO Overview 3.0](#)).

Prior panels have also 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.

(In some such cases, the respondent may host a copycat version of the complainant's website.) (see section 3.4 of the [WIPO Overview 3.0](#)).

First of all, the Panel finds that it is established that the Complainants' BARRICK Trademarks were registered and used before the registration of the Disputed Domain Name. Therefore, there is a presumption of bad faith registration of the Disputed Domain Name given that it reproduces the Complainants' BARRICK Trademarks entirely.

Moreover, the Panel points out that the Disputed Domain Name used to resolve to the Complainants' own website. Moreover, the Disputed Domain Name was used to send email to third parties using the identity of some of the Complainants' employees as part of a phishing scam.

Accordingly, the Panel finds that the Complainants have provided evidence that the Disputed Domain Name was registered and used by the Respondent in an attempt to pass off as the Complainants or someone affiliated to the Complainants as part of a phishing scheme.

Finally, the Complainants demonstrate that the registrant of the Disputed Domain Name has given false contact details and impersonated an employee of the Complainants to register the Disputed Domain Name.

Considering all of the above, it is not possible to conceive any plausible actual or contemplated good faith registration and use of the Disputed Domain Name by the Respondent.

Therefore, in view of all the circumstances of this case, the Panel holds that the Respondent has registered and is using the Disputed Domain Name in bad faith according to the Policy, paragraphs 4(a)(iii) and 4(b).

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, <barrickcorp.com> be transferred to the Complainants.

/Christiane Féral-Schuhl/

Christiane Féral-Schuhl

Sole Panelist

Date: July 6, 2023