

## **ADMINISTRATIVE PANEL DECISION**

Equinor ASA v. James Andrew  
Case No. D2022-3846

### **1. The Parties**

The Complainant is Equinor ASA, Norway, represented by Valea AB, Sweden.

The Respondent is James Andrew, United States of America (“United States” or “US”).

### **2. The Domain Name and Registrar**

The disputed domain name <us-equinor.com> (the “Disputed Domain Name”) is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 13, 2022. On October 14, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On October 15, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the 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 October 18, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 7, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 9, 2022.

The Center appointed Mariya Koval as the sole panelist in this matter on November 15, 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.

#### 4. Factual Background

The Complainant, founded in 1972, formerly known as Statoil ASA, is a Norwegian multinational energy company with operations in more than 30 countries around the world developing oil, gas, wind and solar energy. In the 2020 the Complainant was ranked as the 169th-largest public company in the world by Forbes Global 2000. As of 2021, the company has more than 21,000 employees throughout the world.

The Complainant is the owner of a large EQUINOR Trademark (the “EQUINOR Trademark”) registrations portfolio throughout the world, among which are:

- International Trademark Registration No. 1444675, registered on July 4, 2018, in respect of goods and services in classes 1, 2, 4, 6, 7, 9, 16, 17, 19, 25, 28, 35, 36, 37, 39, 40, 41, 42;
- European Union Trademark Registration No. 017900772, registered on January 18, 2019, in respect of goods and services in classes 1, 2, 4, 6, 7, 9, 16, 17, 19, 25, 28, 35, 36, 37, 39, 40, 41, 42;
- United States Trademark Registration No. 6436681, registered on August 3, 2021, in respect of goods and services in classes 1, 2, 4, 6, 7, 9, 16, 17, 19, 25, 28, 35, 36, 37, 39, 40, 41, 42.

The Complainant operates more than 100 domain names throughout the world containing the EQUINOR Trademark with generic Top-Level Domains (“gTLD”) and country code Top-Level Domains (“ccTLDs”).

The Disputed Domain Name was registered on October 12, 2022. As of the date of this decision, the Disputed Domain Name resolves to an inactive website. According to the evidence presented by the Complainant (Annex I to the Complaint) the Disputed Domain Name has active MX-records, which indicates that Disputed Domain Name may be used for phishing.

#### 5. Parties' Contentions

##### A. Complainant

The Complainant contends that the Disputed Domain Name is confusingly similar to the EQUINOR Trademark as the Disputed Domain Name incorporates the Trademark in its entirety. The Complainant considers that the fact that the Disputed Domain Name starts with “us” and a hyphen does not prevent a confusingly similarity with its EQUINOR Trademark. The Respondent has intended to impersonate the Complainant’s US website by adding two letters “us”. Upon entering the Complainant’s website “www.equinor.us” the Internet users are redirected to the Complainant’s official website “www.equinor.com”.

Bearing in mind in particular the following factors, (a) the widespread reputation and high degree of recognition of the Complainant’s EQUINOR Trademark especially in the energy sector and (b) the lack of distinguishing factors between the Disputed Domain Name and the Complainant’s Trademark, the Disputed Domain Name should be considered as confusingly similar, not to say identical, to the EQUINOR Trademark in which the Complainant has rights. Considering the brand awareness of the EQUINOR Trademark worldwide, an Internet user would most probably assume a connection of the Disputed Domain Name with the Complainant and its business.

The Complainant further claims that the Respondent has no rights to or legitimate interests in respect of the Disputed Domain Name based on the Complainant’s prior use of its EQUINOR Trademark and company name. The Respondent is not affiliated or related to the Complainant in any way, or licensed or otherwise authorized to use the EQUINOR Trademark in connection with a website, a domain name or for any other purpose. The Respondent is not using the Disputed Domain Name in connection with any legitimate non-commercial or fair use without intent for commercial gain, is not generally known by the Disputed Domain Name and has not acquired any rights in the Complainant’s company name or Trademark. The Complainant further submits that the Respondent is neither using the Disputed Domain Name in connection with a *bona fide* offering of goods or services.

The Complainant asserts that the Respondent has intentionally registered and is using the Disputed Domain Name in bad faith. It is apparent from the composition of the Disputed Domain Name that the Respondent chose to register the Disputed Domain Name which is confusingly similar to the Complainant's EQUINOR Trademark and the Complainant's registered company name, and that the Respondent was fully aware of the fact that it incorporated a well-recognized and distinctive EQUINOR Trademark in which the Respondent had absolutely no prior rights.

The registration of the Disputed Domain Name took place on October 12, 2022, more than four years after the Complainant announced its name change to Equinor in March 2018. As a result, the registration of the Disputed Domain Name has been done in bad faith, and a simple search on the word "Equinor" generates Internet results referring to the Complainant.

The presence of the Complainant also has to be clear to the Respondent as the Respondent has used the Complainant's figurative registered Trademark in email correspondence, impersonating himself as the Complainant.

Furthermore, the Disputed Domain Name has active MX-records: the Respondent has proceeded with the additional step besides registering the Disputed Domain Name to also set up MX-records, which can inflict severe damages for the Complainant if phishing attacks are made or fake invoices are created. At least one email has been sent out from the Disputed Domain Name, in which the Respondent has also used the Complainant's figurative EQUINOR Trademark. The Respondent has conducted research as to what name to enter and was clearly aware of the Complainant prior to registering and using the Disputed Domain Name. The person who supposedly sent the email appears to be an actual employee upon searching his name, further enhancing the confusion that the phishing email might actually be from the Complainant: the Respondent has used the Complainant's actual address in the email to further have the Internet user to believe that this email actually was sent from the Complainant.

The Respondent's registration and use of the Disputed Domain Name incorporating the Complainant's EQUINOR Trademark indicates that the Respondent has intentionally attempted to attract, for commercial gain, information from companies working with the Complainant by creating a likelihood of confusion with the Complainant's EQUINOR Trademark in the email address.

## **B. Respondent**

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

## **6. Discussion and Findings**

Under paragraph 4(a) of the Policy, in order for the complainant to succeed it must satisfy the Panel that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which complainant has rights; and
- (ii) the respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name was registered and is being used in bad faith.

### **A. Identical or Confusingly Similar**

The Complainant has properly asserted its rights in the EQUINOR Trademark. The Panel notes that the registration of the Complainant's Trademark predates the registration of the Disputed Domain Name for four years.

The Disputed Domain Name completely reproduces the Complainant's EQUINOR Trademark in combination with the term "us", hyphen and the gTLD ".com". According to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8, 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. In this case, the addition of the term "us", which is a standard abbreviation for the United States or a pronoun, to the EQUINOR Trademark does not prevent a finding of confusing similarity.

According to the [WIPO Overview 3.0](#), section 1.11, the applicable gTLD in a domain name (e.g., ".com", ".club", ".nyc") is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.

Pursuant to section 1.7 of the [WIPO Overview 3.0](#), in cases where a domain name incorporates the entirety of a trademark, the domain name will normally be considered identical or confusingly similar to that mark for purposes of UDRP standing.

Furthermore, the use of hyphens in the Disputed Domain Name is irrelevant in a finding of confusing similarity, see e.g. *Royale Indian Rail Tours Limited v. Divino Indian Memoirz Tours Pvt. Ltd.*, WIPO Case No. [D2010-2107](#) ("In the present case, the Panel finds that... adding a hyphen between the two words "maharaja" and "express" in the disputed domain name are insignificant modifications that do not reduce the confusing similarity between the disputed domain name and the Complainant's mark").

Accordingly, the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant's Trademark pursuant to paragraph 4(a)(i) of the Policy.

## **B. Rights or Legitimate Interests**

In accordance with section 2.1 of the [WIPO Overview 3.0](#) while the overall burden of proof in UDRP proceedings is on the Complainant, the Complainant is required to make out a *prima facie* case that the Respondent lacks rights or legitimate interests. If such *prima facie* case is made, the burden of production shifts to the Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the Disputed Domain Name. If the Respondent fails to come forward with such relevant evidence, the Complainant is generally deemed to have satisfied the second element.

The Complainant has used its EQUINOR Trademark for more than four years, which is long before the Respondent registered the Disputed Domain Name in 2022.

The Panel finds that the Complainant has made out a *prima facie* case, clearly contending that it has never licensed or authorized the Respondent to use its EQUINOR Trademark in the Disputed Domain Name or in any other manner. Moreover, the Panel finds that there is no evidence that the Respondent is commonly known by the Disputed Domain Name.

Also, there is no evidence that the Respondent is using the Disputed Domain Name to offer *bona fide* goods and services or making a legitimate noncommercial or fair use of the Disputed Domain Name. On the contrary, the website under the Disputed Domain Name is inactive and according to the evidence presented by the Complainant (Annexes I and J to the Complaint) the Disputed Domain Name has active MX-records and at least one email has been sent from it. Moreover, in this email the Respondent has used the Complainant's figurative EQUINOR Trademark and impersonated himself as an actual employee of the Complainant, having even used the Complainant's actual address. Therefore, the Panel agrees with the Complainant that this creates a risk that the Respondent may be engaged in a phishing scheme aiming to deceive Internet users and make them believe that they are dealing with the Complainant. In pursuance of section 2.13.1 of the [WIPO Overview 3.0](#) "Panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent." With respect to the circumstances of this case, the Panel

considers that it is obvious that the Respondent registered the Disputed Domain Name with the sole intention of commercial gain by creating a likelihood of confusion with the Complainant's EQUINOR trademark as to the source of the email communication sent using the Disputed Domain Name.

Moreover, in accordance with the [WIPO Overview 3.0](#), section 2.5.1, even where a domain name consists of a trademark plus an additional term (at the second- or top-level), UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. Therefore, the addition of the term "us", which is the two-letter country code for the United States where the Complainant has a longstanding history of conducting business, to the Complainant's EQUINOR Trademark in the Disputed Domain Name, is further evidence, that the Respondent was very well aware of the Complainant's EQUINOR Trademark and business at the time of registration of the Disputed Domain Name and has done so for the only purpose of creating an impression that the Disputed Domain Name is connected with the Complainant's EQUINOR Trademark.

The Respondent did not file any response to the Complaint and did not participate in this proceeding, respectively, the Respondent did not present any evidence for supporting any rights or legitimate interests in the Disputed Domain Name.

In view of the foregoing, the Panel finds that the Panel finds that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name and that the Complainant succeeds under the second element of paragraph 4(a) of the Policy.

### **C. Registered and Used in Bad Faith**

Paragraph 4(b) of the Policy sets out a non-exhaustive list of circumstances that indicate bad faith conduct on the part of the respondent, namely:

(i) circumstances indicating that the respondent has registered or has acquired the disputed 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 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 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.

The EQUINOR Trademark has been in use more than four years before the Disputed Domain Name was registered and that the Complainant has actively promoted its EQUINOR Trademark all these four years. Furthermore, the Complainant's EQUINOR Trademark is original and highly distinctive, and it is obvious that the Respondent could not have registered the Disputed Domain Name, which incorporates the Complainant's EQUINOR Trademark in its entirety, accidentally. Therefore, the Panel is of opinion that the Respondent was likely well aware of the Complainant's EQUINOR Trademark when he registered the Disputed Domain Name.

The Panel also concludes that addition of the term “us” to the EQUINOR Trademark does not change an impression of strong association of the Disputed Domain Name with the Complainant's EQUINOR Trademark, but on the contrary, taking into consideration that the Complainant has an active business activity in the United States, even strengthens such association.

The Complainant claims that the Disputed Domain Name did not resolve to an active website at the time of filing the Complaint. The Panel notes that the Respondent's non-use of the Disputed Domain Name does not prevent a finding of bad faith under the doctrine of passive holding. However, according to the evidence presented by the Complainant (Annex I to the Complaint) the website under the Disputed Domain Name has active MX-records, which means that Disputed Domain Name may be used for phishing. Moreover, the Respondent sent a fraudulent email from the Disputed Domain Name. Impersonating one of the Complainant's employee and use of the Complainant's EQUINOR Trademark in a fraudulent email scam is further evidence of bad faith registration and use. In accordance with the [WIPO Overview 3.0](#), section 3.4, UDRP 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 (in some such cases, the respondent may host a copycat version of the complainant's website). 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.

Accordingly, the Panel concludes that the Respondent registered and is using the Disputed Domain Name in bad faith in creating a likelihood of confusion with the Complainant's EQUINOR Trademark and to disrupt the Complainant's business.

Finally, the Respondent, not participating in these proceedings, has failed to indicate any facts and/or evidence, which would show the good faith registration and use of the Disputed Domain Name.

In view of the foregoing, the Panel finds that the paragraph 4(a)(iii) of the Policy has been satisfied by the Complainant and accordingly, the Disputed Domain Name has been registered and is being 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 <us-equinor.com> be transferred to the Complainant.

*/Mariya Koval/*

**Mariya Koval**

Sole Panelist

Date: November 29, 2022