

ADMINISTRATIVE PANEL DECISION

TotalEnergies SE v. Privacy Service Provided by Withheld for Privacy ehf /
David Barrette, david enterprise
Case No. D2022-0846

1. The Parties

The Complainant is TotalEnergies SE, France, represented by In Concreto, France.

The Respondent is Privacy Service Provided by Withheld for Privacy ehf, Iceland / David Barrette, david enterprise, United Arab Emirates.

2. The Domain Name and Registrar

The disputed domain name <totalenergiesuae.com> (the “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 March 11, 2022. On March 11, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On March 11, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the 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 15, 2022 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 18, 2022.

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 22, 2022. In accordance with the Rules, paragraph 5, the due date for Response was April 11, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 12, 2022.

The Center appointed Olga Zalomiy as the sole panelist in this matter on April 20, 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 is a worldwide broad energy company. The Complainant owns numerous trademark registrations for the TOTAL and TOTALENERGIES trademarks, such as:

- French trademark registration No. 1540708 for the word mark TOTAL registered on December 12, 1988;
- European Union trademark registration No. 018308753 for the word mark TOTAL ENERGIES registered on May 28, 2021;
- European Union trademark registration No. 018392850 for the word mark TOTALENERGIES registered on June 25, 2021.

The Respondent registered the Domain Name on January 27, 2022. The Domain Name used to resolve to a website that was a copy of the Complainant's main website. The website reproduces the Complainant's official website by displaying the Complainant's TOTALENERGIES (word and design) trademark and images. The Respondent also used the Domain Name through an email address in its impersonation of a Complainant's employee to disseminate fake job offers.

5. Parties' Contentions

A. Complainant

The Complainant contends that it is a worldwide broad energy company. The Complainant alleges that it owns numerous trademark registrations for the TOTAL and TOALENERGIES trademarks. The Complainant claims that it also has numerous domain name registrations for domain names that include its trademark.

The Complainant asserts that the Domain Name is confusingly similar to its global trademark TOTALENERGIES because it incorporates the Complainant's trademark in its entirety. The Complainant contends that the addition of "UAE" as a marker of for the localization, is sufficient to demonstrate that the Domain Name is confusingly similar to the trademarks in which the Complainant has rights. The Complainant argues that the generic Top-Level Domain ("gTLDs") generally has no capacity to distinguish a domain name from a trademark.

The Complainant asserts that the Respondent has no rights or legitimate interests in the Domain Name. The Complainant alleges that its trademark search did not reveal any TOTALENERGIES trademarks belonging to the Respondent and that any search results for "totalenergiesuae" relate to the Complainant.

The Complainant alleges that the Respondent registered and is using the Domain Name in bad faith because the Domain Name is confusingly similar to its well-known TOTALENERGIES trademark. The Complainant claims that the Respondent registered the Domain Name in bad faith because the Domain Name used to resolve to a website, which was a mirror image of the Complainant's website. The Complainant claims that the Respondent is using the Domain Name through email address representing to be sent by an employee of the Complainant. The Complainant contends that the emails disseminated fake job offers with the Complainant in the United Arab Emirates ("UAE") to convince recipients to use a travel agency purportedly under the Respondent's control. The Complainant asserts that the travel agency, which appeared to be sham, is currently permanently closed.

B. Respondent

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

6. Discussion and Findings

Pursuant to paragraph 4(a) of the UDRP, to succeed in this proceeding, the Complainant must prove each of the following elements with respect to each of the Domain Names:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

Pursuant to paragraph 4(a)(i) of the UDRP, the Complainant must prove that the Domain Name is identical or confusingly similar to the trademark or service mark in which the Complainant has rights.

The submitted evidence shows that the Complainant owns numerous trademark registrations for the TOTALENERGIES trademarks. Pursuant to section 1.2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), this satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case.

The Domain Name consists of the Complainant's TOTALENERGIES trademark, the geographical abbreviation "UAE", and the gTLD ".com". "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."¹ It is well-established, that the applicable gTLD should be disregarded under the confusingly similarity test as a standard registration requirement.²

In this case, because the Complainant's TOTALENERGIES trademark is recognizable within the Domain Name, the inclusion of the geographic abbreviation "UAE" does not prevent a finding of confusing similarity between the Domain Name and the Complainant's trademark. The gTLD ".com" is disregarded from the assessment of confusing similarity. Therefore, the Domain Name is confusingly similar to the Complainant's TOTALENERGIES trademark.

The Complainant has satisfied the first element of the UDRP.

B. Rights or Legitimate Interests

To prove the second UDRP element, the Complainant must make out a *prima facie* case³ in respect of the lack of rights or legitimate interests of the Respondent.

Pursuant to paragraph 4(c) of the Policy, any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on the evidence, shall demonstrate a respondent's rights or legitimate interests to a domain name for the purposes of paragraph 4(a)(2) of the Policy:

- (i) before any notice of the dispute, 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

¹ Section 1.8., WIPO Overview 3.0.

² Section 1.11.1, WIPO Overview 3.0.

³ Section 2.1, WIPO Overview 3.0.

(ii) 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

(iii) 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.

The Complainant submitted evidence that shows that the Respondent has not been commonly known by the Domain Name. The evidence shows that the Complainant did not authorize the Respondent's use of the Complainant's trademark in the Domain Name. Further, the evidence on record shows that the Domain Name used to resolve to a website, which was a carbon copy of the Complainant's official website. The Respondent also used the Domain Name in its impersonation of a Complainant's employee most likely to defraud third parties. Prior UDRP panels have held that the use of a domain name for illegal activity, such as impersonation, or other types of fraud "can never confer rights or legitimate interests on a respondent"⁴.

Based on the foregoing evidence, the Panel finds that the Complainant has made out a *prima facie* case in respect of the lack of rights or legitimate interests of the Respondent in the Domain Name. Once a complainant makes a *prima facie* case, the burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name.⁵ The Respondent has failed to do so, and, consequently, the Panel finds that in this proceeding the Complainant has satisfied paragraph 4(a)(ii) of the UDRP.

C. Registered and Used in Bad Faith

Pursuant to paragraph 4(a)(iii) of the Policy, the Complainant must prove that the Domain Name was registered and is being used in bad faith.

First, prior UDRP panels have found that "the mere registration of a domain name that is identical or confusingly similar [...] to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith". Here, evidence shows that the Complainant's TOTALENERGIES mark has been ranked as 128th most valuable brand in the world.⁶ Therefore, the Respondent's registration of the Domain Name confusingly similar to the Complainant's well-known mark creates a presumption of bad faith.

Second, paragraph 4(b) of the UDRP sets forth circumstances, which shall be considered evidence of the registration and use of a domain name in bad faith. The examples of bad faith registration and use set forth in paragraph 4(b) of the UDRP are not meant to be exhaustive of all circumstances from which such bad faith may be found. Prior 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. [...] 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"⁷.

The Panel finds that the Respondent registered the Domain Name in bad faith, because the Respondent registered the Domain Name to commit a fraud. The Respondent's use of the Domain Name for a website, which was a copy of the Complainant's official website in connection with fraudulent emails to lure third parties into using a sham travel agency's service, constitutes bad faith use of the Domain Name. See, e.g., *Admiral Group Plc and EUI Limited v. Cimpress Schweiz, Cimpress Schweiz GmbH*, WIPO Case No. [DCO2017-0043](#), where the panel stated that, "[r]espondent has used the disputed domain name as a fake

⁴ Section 2.13.1, WIPO Overview 3.0.

⁵ Section 2.1, WIPO Overview 3.0.

⁶ Annex 8 to the Complaint.

⁷ Section 3.4, WIPO Overview 3.0.

email address in order to impersonate the CFO of Complainant A and mislead some employees, recipients of the emails. The fraudulent intentions of the Respondent are hereby clearly unveiled, and enable the Panel to conclude that the disputed domain name is used in bad faith". Similarly, it is likely that the Respondent in this case used the Domain Name in attempt to defraud third parties of money and to obtain their personal information⁸. Therefore, the Respondent is using the Domain Name in bad faith.

Therefore, the Panel finds that the Complainant has established the third element of paragraph 4(a) of the UDRP.

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 Domain Name <totalenergiesuae.com> be transferred to the Complainant.

/Olga Zalomiy/

Olga Zalomiy

Sole Panelist

Date: April 23, 2022

⁸ Annex 12.5 and 12.6 to the Complaint.