

ADMINISTRATIVE PANEL DECISION

TotalEnergies SE v. Contact Privacy Inc., Customer 0163914228 /
Jean Mockale, totalenergiesfr
Case No. D2022-1617

1. The Parties

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

The Respondent is Contact Privacy Inc., Customer 0163914228, Canada / Jean Mockale, totalenergiesfr, Ukraine.

2. The Domain Name and Registrar

The disputed domain name <totalenergiesfr.com> is registered with Tucows Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 4, 2022. On May 4, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same day, 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. On May 16, 2022, the proceedings were suspended and reinstated on August 3, 2022. The Center sent an email communication to the Complainant on August 3, 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 August 5, 2022.

On August 3, 2022, the Center sent an email communicating in both English and French regarding the language of the proceeding. The Complainant replied on August 4, 2022, asking French to be the language of the proceeding instead of English. The Respondent did not reply.

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 in both English and French, and the proceedings commenced on August 9, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 29, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on August 30, 2022.

The Center appointed Tobias Zuberbühler as the sole panelist in this matter on September 2, 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. Further Procedural Considerations

Under paragraph 10 of the Rules, the Panel is required to ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case, and also that the administrative proceeding takes place with due expedition.

Noting that the Respondent's disclosed address appears to be in the Ukraine (whether this is indeed accurate is doubtful to the Panel), which is subject to an international conflict at the date of this Decision that may impact case notification, it is appropriate for the Panel to consider, in accordance with its discretion under paragraph 10 of the Rules, whether the proceeding should continue.

Having considered all the circumstances of the case, the Panel is of the view that it should. The Panel has reached this conclusion in part because the Panel does not believe the Respondent's purported address in the Ukraine to be genuine. The Panel notes in particular that the street name indicated by the Respondent does not exist in the indicated city and the post code does not correspond to the indicated city but rather to a city more than 600km away from the city indicated by the Respondent. The Panel also notes that the website hosted at the disputed domain name was in the French language, which may further support an inference that the Respondent is not located in the Ukraine. The Panel notes that the Center did, however, successfully send the written notice of the Complaint to the named Privacy Service. The Center also sent the Notification of Complaint by email to the Respondent at his email address as registered with the Registrar and to a postmaster email address as specified by the Rules. There is no evidence that the case notification email to the first email address was not successfully delivered.

The Panel further notes that the Complainant has specified in the Complaint that any challenge made by the Respondent to any decision to transfer or cancel the disputed domain name shall be referred to the jurisdiction of the courts of the location of the principal office of the concerned registrar. In this case, the principal office of the Registrar, Tucows Inc., is in Toronto, Canada.

It is moreover noted that, for the reasons which are set out later in this decision, the Panel has no serious doubt (albeit in the absence of any response) that the Respondent has registered and used the disputed domain name in bad faith and with the intention of unfairly targeting the Complainant's goodwill in its trademark.

The Panel concludes that the Parties have been given a fair opportunity to present their case, and for the administrative proceeding to take place with due expedition, the Panel will proceed to a decision accordingly.

5. Factual Background

The Complainant is the parent company of the TotalEnergies Group, which is one of the largest energy group of companies with presence in over 130 countries, including the Ukraine. The Complainant covers all aspects of the energy industry, from production to marketing, as well as the development of new generation energy activities (biomass, wind).

The Complainant owns trademark registrations in various jurisdictions, including the European Union trademark TOTALENERGIES (Reg. No. 018392838, registered on June 26, 2021), the French trademark TOTALENERGIES (Reg. No. 4727686, registered on February 1, 2021) and the International trademark TOTALENERGIES (Reg. No. 1601110, registered on February 9, 2021).

The Complainant further holds the domain name <total.fr> under which the official website of the Complainant is available. The Complainant also holds various domain names incorporating the TOTALENERGIES trademark, including the domain name <totalenergies.com>.

The disputed domain name was registered on March 9, 2022. According to the evidence in the Complaint, the disputed domain name resolved to a website in the French language copying content from the Complainant's official website and offering the same sort of products for which the Complainant registered the TOTALENERGIES trademark, albeit with a discount. In the meantime, the website has been deactivated.

6. Parties' Contentions

A. Complainant

The Complainant alleges that it has satisfied all elements of the Policy, paragraph 4.

B. Respondent

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

7. Discussion and Findings

On the basis of the facts and evidence introduced by the Complainant, and with regard to paragraphs 4(a), (b) and (c) of the Policy, the Panel concludes as follows:

A. Language of the Proceeding

While the registration agreement for the disputed domain name is in English, the Complainant has submitted arguments in its Complaint that the Respondent is conversant in French because the website available at the disputed domain name was in the French language and directed at French customers of the Complainant, as set out in the Complaint. Therefore, the Complainant has requested French to be the language of the proceeding.

Paragraph 11(a) of the Rules stipulates that, "unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding".

Since the Registrar has confirmed that the language of the registration agreement as used by the registrant for the disputed domain name is English, the language of the proceeding shall be English. Taking into account the circumstances of this case, the Panel does not consider it prejudicial to the Complainant if English is the language of the proceeding. However, the Panel finds that substantial additional expense and delay would likely be incurred if the Complaint and annexes thereto had to be translated from French into English. In view of the Policy with the aim of facilitating a time and cost-efficient procedure for the resolution of domain name disputes, the Panel finds it appropriate to exercise its discretion according to paragraph 11(a) of the Rules and decides that, while the proceeding will be conducted in English, the Complaint and annexes thereto do not have to be translated into English.

B. Identical or Confusingly Similar

The Complainant has submitted sufficient evidence to demonstrate its registered rights in the TOTALENERGIES trademark.

The TOTALENERGIES trademark is wholly reproduced in the disputed domain name.

A domain name is “identical or confusingly similar” to a trademark for the purposes of the Policy when the domain name includes the trademark, or a confusingly similar approximation, regardless of other terms in the domain name (*Wal-Mart Stores, Inc. v. Richard MacLeod d/b/a For Sale*, WIPO Case No. [D2000-0662](#)). As stated in the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.8, “[w]here 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. The nature of such additional term(s) may however bear on assessment of the second and third elements”. Hence, the Panel holds that the addition of the term “fr” to the Complainant’s TOTALENERGIES trademark does not prevent a finding of confusing similarity between the disputed domain name and the Complainant’s trademark.

The Complainant has thus fulfilled the requirements of paragraph 4(a)(i) of the Policy.

C. Rights or Legitimate Interests

There are no indications before the Panel of any rights or legitimate interests of the Respondent in respect of the disputed domain name. The Complainant contends that the Respondent is neither affiliated with the Complainant nor making any *bona fide* use of the disputed domain name.

The Respondent used the disputed domain name to offer alleged products in connection to the Complainant’s business and trademark. The Complainant has credibly alleged that the Respondent used the disputed domain name for generating revenue by offering the same sort of products for which the Complainant registered the TOTALENERGIES trademark while taking advantage of the Complainant’s trademark notoriety. This cannot be considered as a *bona fide* offering of goods or services or noncommercial use.

Furthermore, the composition of the disputed domain name, wholly incorporating the Complainant’s trademark and the term “fr” (an abbreviation suggesting a connection to France), cannot constitute fair use in these circumstances as it effectively impersonates or suggests sponsorship or endorsement by the Complainant. See [WIPO Overview 3.0](#), section 2.5.1.

The Panel notes that the Respondent has listed “totalenergiesfr” as its organization name with the Registrar. Given, however, that the Respondent has been made aware of these proceedings but has not submitted a formal response to the serious allegations made against him, the Panel is unable to ascertain any possible relation of such name to any purported organization of the Respondent. Therefore, the Panel infers that the inclusion of such name could indicate that it was done as a pretext to give the false impression of authenticity.

The Panel finds that the Complainant, having made out a *prima facie* case which remains unrebutted by the Respondent, has fulfilled the requirements of paragraph 4(a)(ii) of the Policy.

D. Registered and Used in Bad Faith

Under the circumstances of this case, including the composition of the disputed domain name and reputation of the Complainant’s trademark, it can be inferred that the Respondent was aware of the Complainant’s trademark when registering the disputed domain name.

The Panel finds that the reproduction of the Complainant's trademark along with the term "fr" creates a likelihood of confusion between the Complainant's trademark and the disputed domain name.

The evidence and allegations submitted by the Complainant support a finding that the Respondent was engaged in an attempt to pass himself off as the Complainant by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of his website for his own commercial benefit. The Respondent has therefore used the disputed domain name in bad faith (see *Claudie Pierlot v. Yinglong Ma*, WIPO Case No. [D2018-2466](#)).

Accordingly, the Complainant has also fulfilled paragraph 4(a)(iii) of the Policy.

8. 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 <totalenergiesfr.com> be transferred to the Complainant.

/Tobias Zuberbühler/

Tobias Zuberbühler

Sole Panelist

Date: September 16, 2022