

## **ADMINISTRATIVE PANEL DECISION**

TotalEnergies SE v. Privacy service provided by Withheld for Privacy ehf /  
Patience Nkosi, Total Projects  
Case No. D2022-2312

### **1. The Parties**

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

Respondent is Privacy service provided by Withheld for Privacy ehf, Iceland / Patience Nkosi, Total Projects, South Africa.

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

The disputed domain name <totalenergies-projects.com> is registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 27, 2022. On June 27, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 27, 2022, 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. The Center sent an email communication to Complainant on June 28, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on July 1, 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 Respondent of the Complaint, and the proceedings commenced on July 8, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 28, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on July 29, 2022.

The Center appointed Frederick M. Abbott as the sole panelist in this matter on August 4, 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

Complainant is the owner of registration for the trademark TOTAL ENERGIES on the register of the European Union Intellectual Property Office ("EUIPO"), registration number 018308753, registration dated May 28, 2021, in international classes ("ICs") 1, 2, 3, 4, 5, 6, 7, 9, 11, 14, 16, 17, 18, 19, 20, 21, 25, 28, 35, 36, 37, 38, 39, 40, 41, 42, 43 and 45, covering, *inter alia*, petroleum and petroleum-based products, advertising and financial services. Complainant is the owner of registration for the trademark TOTALENERGIES on the register of the EUIPO, registration number 018392850, registration dated June 25, 2021, in ICs 1, 2, 3, 4, 5, 6, 7, 9, 11, 12, 14, 16, 17, 18, 19, 20, 21, 25, 28, 35, 36, 37, 38, 39, 40, 41, 42, 43 and 45, covering, *inter alia*, petroleum and petroleum-based products, advertising and financial services. Complainant is owner of registration at WIPO for the International Trademark TOTALENERGIES under the Madrid System, registration number 1601110, registration dated September 2, 2021, in ICs 1, 4, 7, 9, 37, 39 and 40, covering, *inter alia*, petroleum and petroleum-based products, and energy production. Complainant is the owner of various trademark applications for TOTALENERGIES on the register of the Companies and Intellectual Property Commission (CIPC) in South Africa, filed in May and July 2021. Complainant was established in 1924, and generally used the trademark TOTAL in its business operations from 1985 up until May 28, 2021, when the name of the company was changed to "TotalEnergies SE", and it commenced using the trademark TOTALENERGIES as successor to TOTAL. Complainant maintains a portfolio of registrations throughout the world for the TOTAL trademark, including registration as an International Trademark under the Madrid System.

Complainant is a large multinational corporation operating in more than 130 countries. It engages in a full range of activities relating to production and marketing of petroleum and petroleum-based products, as well as renewable energy products and services. Complainant is a publicly-listed company, based in France, with shares traded on the Paris and New York (American Depositary Receipt – ADR) stock exchanges. Complainant is owner of numerous domain name registrations, including for <totalenergies.com> which is directed to a commercial website maintained by Complainant.

According to the Registrar's verification, Respondent is registrant of the disputed domain name. According to an ICANN Lookup Whois report furnished by Complainant, the disputed domain name was created on April 18, 2022. There is no indication that a party other than Respondent has owned the registration of the disputed domain name.

There is no evidence that Respondent has used the disputed domain name in connection with an active website. However, Complainant has provided evidence that Respondent used the disputed domain name in connection with the transmission of a deceptive email message dated May 11, 2022. That email falsely represented the sender as a Procurement Manager of Complainant and requested bid quotations from a third party for the supply of products to Complainant in the context of a tender. In this instance, the deceptive email was flagged as suspicious by the recipient and verification of authenticity from Complainant was requested.

## **5. Parties' Contentions**

### **A. Complainant**

Complainant alleges that it owns rights in the trademarks TOTALENERGIES and TOTAL, and that the disputed domain name is confusingly similar to those trademarks.

Complainant contends that Respondent lacks rights or legitimate interests in the disputed domain name because: (1) Respondent has absolutely no rights to the disputed domain name nor legitimate interests in respect of it; (2) there is no evidence that Respondent owns rights in the trademark TOTALENERGIES; and (3) a Google search conducted by Complainant using the terms of the disputed domain name returned results referring only to Complainant.

Complainant argues that Respondent registered and is using the disputed domain name in bad faith because: (1) registration of the disputed domain name incorporating Complainant's well-known trademark in itself demonstrates bad faith; (2) the specific combination of terms forming Complainant's trademark is distinctive and Respondent's adoption of that trademark shows intent to "place itself in the wake of Complainant"; and (3) Respondent's use of the disputed domain name as the email sender's domain in a fraudulent email is evidence of bad faith.

Complainant requests the Panel to direct the registrar to transfer the disputed domain name to Complainant.

### **B. Respondent**

Respondent did not reply to Complainant's contentions.

## **6. Discussion and Findings**

The registration agreement between Respondent and the Registrar subjects Respondent to dispute settlement under the Policy. The Policy requires that domain name registrants submit to a mandatory administrative proceeding conducted by an approved dispute resolution service provider, one of which is the Center, regarding allegations of abusive domain name registration and use (Policy, paragraph 4(a)).

It is essential to Policy proceedings that fundamental due process requirements be met. Such requirements include that a respondent have notice of proceedings that may substantially affect its rights. The Policy and the Rules establish procedures intended to ensure that respondents are given adequate notice of proceedings commenced against them and a reasonable opportunity to respond (see, e.g., Rules, paragraph 2(a)).

The Center formally notified the Complaint to Respondent at the email and physical addresses provided in its record of registration. Courier delivery of the Complaint to Respondent could not be successfully completed because of inaccurate contact information provided in its record of registration. There is no indication of technical difficulties in the transmission to Respondent of email. The Center took those steps prescribed by the Policy and the Rules to provide notice to Respondent, and those steps are presumed to satisfy notice requirements.

Paragraph 4(a) of the Policy sets forth three elements that must be established by a complainant to merit a finding that a respondent has engaged in abusive domain name registration and use and to obtain relief. These elements are that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which complainant has rights;
- (ii) 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**

Complainant has provided substantial evidence of rights in the trademark TOTALENERGIES, including by registration at the EUIPO, by registration as an International Trademark, and through use in commerce. Complainant has provided substantial evidence of rights in the trademark TOTAL, including by registration as an International Trademark, and through use in commerce. See Factual Background *supra*. Respondent has not challenged Complainant's assertion of trademark rights. The Panel determines that Complainant owns rights in the trademarks TOTALENERGIES and TOTAL.

For purposes of assessing confusing similarity, the Panel does not consider it necessary to refer to the TOTAL trademark.

The disputed domain name directly and fully incorporates Complainant's TOTALENERGIES trademark. The direct and full incorporation of Complainant's trademark by Respondent in the disputed domain name is sufficient to establish confusing similarity within the meaning of the Policy. The addition of the term "projects" and a hyphen to Complainant's trademark in the disputed domain name does not prevent a finding of confusing similarity. The Panel determines that the disputed domain name is confusingly similar to Complainant's TOTALENERGIES trademark.

Complainant has established that it owns rights in the trademark and that the disputed domain name is confusingly similar to that trademark TOTALENERGIES. This holding is without prejudice to Complainant's rights in the trademark TOTAL.

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

Complainant's allegations to support Respondent's lack of rights or legitimate interests in the disputed domain name are outlined above, and the Panel finds that Complainant has made a *prima facie* showing that Respondent lacks rights or legitimate interests in the disputed domain name.

Respondent has not replied to the Complaint and has not attempted to rebut Complainant's *prima facie* showing of lack of rights or legitimate interests.

Respondent's use of the disputed domain name as the sender's email domain in a message designed to deceptively appear as originating from an employee of Complainant, soliciting offers from a third party to supply products to Complainant, is almost certainly an attempt by Respondent to fraudulently acquire goods from that third party by falsely assuming Complainant's identity. Respondent's intent may also have been to secure commercially valuable information from Respondent and/or Complainant, or to otherwise take unfair advantage of the identity of Complainant. These activities do not constitute a *bona fide* offering of goods or services prior to notice of this dispute.

Respondent's use of the disputed domain name does not otherwise manifest rights or legitimate interests.

The Panel determines that Complainant has established that Respondent lacks rights or legitimate interests in the disputed domain name.

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

In order to prevail under the Policy, Complainant must demonstrate that the disputed domain name “has been registered and is being used in bad faith” (Policy, paragraph 4(a)(iii)). Paragraph 4(b) of the Policy states that “for the purposes of paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith”. These include that, “(iv) by using the 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”.

Complainant’s TOTALENERGIES trademark was well-established when the disputed domain name was registered and used by Complainant. As evidenced by Respondent’s use of Complainant’s trademark in its deceptive email scheme – that specifically referred to Complainant’s business operations – Respondent must have been aware of Complainant’s trademark when it registered and used the disputed domain name.

Respondent has used the disputed domain name intentionally for purposes of commercial gain to establish Internet user confusion regarding Complainant as the source of email communication intended by Respondent to deceive a prospective supplier to Complainant. Respondent has not attempted to justify this activity. Respondent’s registration and use of Complainant’s trademark in the disputed domain name constitutes bad faith within the meaning of the Policy.

The Panel determines that Respondent registered and is using the disputed domain name in bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

### **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, <totalenergies-projects.com>, be transferred to Complainant

*/Frederick M. Abbott/*

**Frederick M. Abbott**

Sole Panelist

Date: August 18, 2022