

ADMINISTRATIVE PANEL DECISION

Valero Energy Corporation, Valero Marketing and Supply Company v. Mike Farnworth

Case No. D2022-2768

1. The Parties

Complainants are Valero Energy Corporation and Valero Marketing and Supply Company, United States of America (“United States”) (hereinafter referred to as “Complainant”), represented by Fasthoff Law Firm PLLC, United States.

Respondent is Mike Farnworth, United States.

2. The Domain Name and Registrar

The disputed domain name <valerooilgas.com> is registered with Hosting Concepts B.V. d/b/a Registrar.eu. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 27, 2022. On July 28, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 29, 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 August 3, 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 August 3, 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 August 8, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 28, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on August 30, 2022.

The Center appointed Timothy D. Casey as the sole panelist in this matter on September 21, 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 two companies operating under the VALERO brand (the “Companies”). The Companies are one of the largest businesses in the United States and have been using the VALERO mark for more than 31 years at least related to oil and gas exploration, production, processing, and distribution. The Companies have spent tens of millions (USD) advertising, marketing and promoting the VALERO brand in a wide variety of media formats related to retail store services convenience stores, chemical processing, fuels and credit card services. Complainant owns a number of trademark registrations related to the same goods and services that comprise or include VALERO including the following representative marks (the “VALERO Marks”) registered in the United States:

Mark	International Classes	Registration No.	First Use Date
VALERO	42	1,314,004	February 1983
VALERO	35	2,560,091	June 2000
VALERO	35, 37	2,656,971	August 2000
VALERO V (DESIGN)	35, 37	2,656,973	August 2000
VALERO V (DESIGN)	40	3,688,322	September 2005
VALERO V (DESIGN)	36	2,938,790	December 2002
VALERO	36	4,216,650	December 2002
VALERO V (DESIGN)	4	2,927,757	August 2000
VALERO	35	3,108,715	November 2002

Complainant owns the <valero.com> domain name and has operated a website under the domain name for many years.

The disputed domain name was registered on February 21, 2022. The disputed domain name has been used in connection with an under-construction website branded as “valerooilgas.com”.

5. Parties’ Contentions

A. Complainant

Complainant contends that the disputed domain name, which includes “valero,” “oil,” and “gas” is confusingly similar to the VALERO Marks because it is comprised of the VALERO Marks in their entirety and the additional words “oil” and “gas” are generic. Complainant also contends that generic Top-Level Domain (“gTLD”) extension is merely a necessary component of the disputed domain name and does not give it any distinctiveness.

Complainant contends that Respondent has no rights or legitimate interests in the disputed domain name, has never been commonly known by the disputed domain name, has not used or made demonstrable preparations to use the disputed domain name, and is not making any legitimate noncommercial or fair use of the disputed domain name. Complainant states that it has not licensed Respondent the right to use the

VALERO Marks and Respondent is not otherwise authorized to act on Complainant's behalf.

Complainant provided a copy of an email exchange from Respondent with a third party using the disputed domain name and posing as an employee of Complainant, in which Respondent made a false job offer to the third party in an attempt to collect personal identifying information from the third party. The third party, being concerned with the validity of the job offer, contacted Complainant, and provided Complainant with the email exchange. Complainant contends that the email exchange reflects Respondent's fraudulent and criminal conduct and was not a *bona fide* offering of goods or services or a legitimate noncommercial or fair use.

Complainant also provided proof that the disputed domain name resolves to a landing page, fully incorporating the VALERO Marks, for a website allegedly under construction, which Complainant contends further illustrates that Respondent is making no preparation to use the disputed domain name for any legitimate purpose.

Complainant believes Respondent registered and is using the disputed domain name in bad faith because: (1) Respondent had to know of Complainant's rights in the VALERO Marks prior to registration of the disputed domain name; (2) Respondent's criminal conduct and non-use of the disputed domain name; (3) Respondent's use of the disputed domain name prevents Complainant from registering the same domain name; and (4) Respondent provided false contact information to the Registrar.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

Complainant's use of the VALERO Marks as early as 1983, almost more than 40 years prior to registration of the disputed domain name, and Complainant's registration of many VALERO Marks since then, are more than sufficient to establish that Complainant has trademark rights in the VALERO Marks.

Complainant contends that the disputed domain name is confusingly similar to the VALERO Marks. Complainant contends that the addition of the words "oil" and "gas," and use of a gTLD, does not prevent a finding of confusing similarity to Complainant's VALERO Marks.

The Panel agrees and finds that the disputed domain name is confusingly similar to the VALERO Marks.

B. Rights or Legitimate Interests

The Panel finds that Respondent has no rights or legitimate interests in the disputed domain name. Respondent does not appear to be commonly known by the disputed domain name or the VALERO Marks. Complainant has not licensed or authorized Respondent to use or register the disputed domain name or any of the marks on Respondent's website. Regardless of what Respondent's true intention may have been in contacting a third party with a job offer for Complainant's business, use of the disputed domain name to create an association with Complainant or Complainant's business and/or to confuse or scam Internet users is not a legitimate noncommercial or fair use and does not constitute a *bona fide* offering of goods or services. Respondent has not rebutted Complainant's *prima facie* case and has provided no arguments or evidence showing potential rights or legitimate interests in the disputed domain name.

Furthermore, the nature of the disputed domain name, comprising substantially all of the VALERO Marks with added words "oil" and "gas," which are descriptive of the goods/services provided by Complainant, carries a risk of implied affiliation with Complainant as it effectively impersonates or suggests sponsorship or endorsement by Complainant, and accordingly cannot constitute a fair use in these circumstances. See

section 2.5.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)).

Finally, Complainant has provided evidence that the disputed domain name is being used in connection with potentially fraudulent and criminal attempt to collect personal identifying information from third parties, which use cannot confer rights or legitimate interests on Respondent.

For these reasons, the Panel finds that Respondent has no rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

Given i) the timing of Complainant’s first use and first registration of the VALERO Marks and Complainant’s use of the VALERO Marks in association with the noted goods and services, ii) the additional descriptive words used in the disputed domain name in combination with the VALERO Marks, iii) the subsequent timing of the registration of the disputed domain name, iv) Complainant’s prior trademark rights in the United States, and v) evidence of Respondent’s subsequent usage, the Panel finds that Respondent clearly knew of the VALERO Marks at the time of registration of the disputed domain name. Respondent’s registration of the disputed domain name was therefore in bad faith.

In addition, the Panel finds the subsequent potentially fraudulent or criminal usage of the disputed domain name and the sending of an email communication impersonating an employee of Complainant in an attempt to scam an Internet user, to constitute use in bad faith consistent with paragraph 4(b)(iv) of the Policy.

Furthermore, although Complainant did not specify the nature of the false contact information provided to the Registrar, the Panel notes that there is no city in California named “London,” which was the contact address provided by Respondent. Respondent’s provision of false address information to the Registrar further points to bad faith intent.

The Panel concludes that the disputed domain name was 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 <valeroilgas.com> be transferred to Complainant.

/Timothy D. Casey/

Timothy D. Casey

Sole Panelist

Date: October 4, 2022