

ADMINISTRATIVE PANEL DECISION

Saudi Arabian Oil Co. v. Mahesh Gurunathan
Case No. D2023-4799

1. The Parties

Complainant is Saudi Arabian Oil Co., Saudi Arabia, represented by Fish & Richardson P.C., United States of America.

Respondent is Mahesh Gurunathan, India.

2. The Domain Name and Registrar

The disputed domain name <aramco.digital> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 17, 2023. On November 20, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 20, 2023, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to Complainant on November 22, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on November 22, 2023.

The Center verified that the Complaint together with the amendment to 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 Respondent of the Complaint, and the proceedings commenced on November 29, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 19, 2023. Respondent sent an email communication to the Center on December 6, 2023. On January 5, 2024, the Center notified the Parties that it would proceed to panel appointment.

The Center appointed Stephanie G. Hartung as the sole panelist in this matter on January 10, 2024. 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 a company organized under the laws of Saudi Arabia that is active in the oil industry.

Complainant has provided evidence that it is the registered owner of numerous trademarks relating to its brand ARAMCO, including, but not limited to, the following:

- word mark ARAMCO, European Union Intellectual Property Office (EUIPO), registration number: 012676045, registration date: August 15, 2014, status: active;
- word mark ARAMCO, United States Patent and Trademark Office (USPTO), registration number: 7,029,421, registration date: April 18, 2023, status: active.

Moreover, Complainant has demonstrated to own since 1994 the domain name <aramco.com>, which resolves to Complainant's official website at "www.aramco.com", through which Complainant advertises and promotes the products and services offered under its ARAMCO website internationally.

Respondent, according to the disclosed Whois information for the disputed domain name, is a resident of India who registered the disputed domain name on April 24, 2023. The disputed domain name resolves to a typical parking website provided by the Registrar, indicating that the disputed domain name "is registered, but may still be available".

On January 30, 2023, Complainant issued a press release announcing the launch of a subsidiary company named "Aramco Digital". On June 13, 2023, Respondent contacted Complainant and made an unsolicited offer to sell the disputed domain name. On or around June 28, 2023, Complainant's legal counsel visited the domain name trading platform Sedo.com and found the disputed domain name available for sale at the minimum starting bid price of USD 200,000. On July 12, 2023, Respondent again contacted Complainant inquiring whether it was interested in purchasing the disputed domain name.

Complainant requests that the disputed domain name be transferred to Complainant.

5. Parties' Contentions

A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, Complainant contends that, with roots going back to the year 1933, it is today the largest oil company worldwide with subsidiaries and affiliates, *inter alia*, in India, and that its ARAMCO trademark (which is an acronym for "Arabian American Oil Company") due to extensive use since as early as 1944 is meanwhile famous.

Complainant submits that the disputed domain name is identical to Complainant's distinctive ARAMCO trademark, with only the mere addition of the new generic Top-Level Domain ("gTLD") ".digital". Moreover, Complainant asserts that Respondent has no rights or legitimate interests in respect of the disputed domain name since (1) Respondent apparently is not commonly known by the disputed domain name, (2) Respondent is not associated or affiliated with Complainant, and Complainant has not granted any rights to Respondent to use either its famous ARAMCO trademark or the disputed domain name, and (3) the disputed

domain name resolves to a parking page where it is offered for sale, and prior for doing so resolved to the domain name auction website Sedo.com where it was listed at a starting minimum bid price of USD 200,000, which both does not qualify as *bona fide* offering of goods or services or a legitimate noncommercial or fair use. Finally, Complainant argues that Respondent has registered and is using the disputed domain name in bad faith because (1) given Complainant's international success and its highly publicized launch of a subsidiary company named "Aramco Digital", it is clear that Respondent registered the disputed domain name with full knowledge of Complainant's rights in the ARAMCO trademark, and (2) Respondent contacted Complainant to submit an unsolicited offer to sell the disputed domain name via Sedo.com at a starting minimum bid price of USD 200,000, which is clearly in excess of the normal cost for registering and maintaining a domain name and so amounts to bad faith.

B. Respondent

Respondent did not file a formal response, but sent an informal email communication to the Center on December 6, 2023, re-emphasizing that he had no intention to host a website or to use trademark names associated with Complainant's ARAMCO trademark and that he was open to transfer the disputed domain name if Complainant wished to acquire it, while the terms of transfer could be discussed.

6. Discussion and Findings

Under paragraph 4(a) of the Policy, Complainant carries the burden of proving:

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

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned, but relatively straightforward comparison between Complainant's ARAMCO trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Complainant has shown rights in respect of the ARAMCO trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1. The entirety of the ARAMCO trademark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical to such trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. Moreover, it has been held in many UDRP decisions and has become a consensus view among UDRP panels (see [WIPO Overview 3.0](#), section 1.11) that the applicable TLD in a domain name is generally viewed as a standard registration requirement and as such is disregarded under the first element test, though the meaning of such TLD may be relevant to a panel assessment of the second or third element of the UDRP. Accordingly, the existence of the new gTLD ".digital" (which directly refers to Complainant's subsidiary company named "Aramco Digital") does not dispel the finding of identity arising from the entire incorporation of Complainant's ARAMCO trademark in the disputed domain name.

The Panel, therefore, finds that Complainant has satisfied paragraph 4(a)(i) and, thus, the first element of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

The Panel is convinced on the basis of Complainant’s undisputed contentions that Respondent has not made use of the disputed domain name in connection with a *bona fide* offering of goods or services, nor has Respondent been commonly known by the disputed domain name nor can it be found that Respondent has made a legitimate noncommercial or fair use thereof without intent for commercial gain.

Respondent has not been authorized to use Complainant’s ARAMCO trademark, either as a domain name or in any other way. Also, there is no reason to believe that Respondent’s name somehow corresponds with the disputed domain name and Respondent does not appear to have any trademark rights associated with the term “Aramco” on its own. Finally, Respondent so far obviously has neither used the disputed domain name for a *bona fide* offering of goods or services nor for a legitimate noncommercial or fair purpose, but rather to offer it to both Complainant and on the Internet for at least USD 200,000. UDRP panels have recognized that holding a domain name for resale can be *bona fide* and is not *per se* illegitimate under the UDRP (see [WIPO Overview 3.0](#), section 2.1), but have also found that the mere registration of such a domain name does not by itself automatically confer rights or legitimate interests (see [WIPO Overview 3.0](#), section 2.10.1). Moreover, given that the disputed domain name incorporates Complainant’s undisputedly famous ARAMCO trademark in its entirety and also directly refers to Complainant’s subsidiary company named “Aramco Digital”, the disputed domain name carries, as such, a high risk of implied affiliation with Complainant and said trademark which is why offering the disputed domain name for online sale cannot constitute fair use and, thus, cannot confer rights or legitimate interests therein (see [WIPO Overview 3.0](#), section 2.5.1).

Therefore, the Panel finds that Complainant has also satisfied paragraph 4(a)(ii) and, thus, the second element of the Policy.

C. Registered and Used in Bad Faith

The Panel, finally, notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

The circumstances to this case leave no serious doubts that Respondent was fully aware of Complainant’s rights in its undisputedly famous ARAMCO trademark when registering the disputed domain name and that the latter clearly is directed thereto, which is, among others, demonstrated by the fact that on June 13, 2023, Respondent contacted Complainant and made an unsolicited offer to sell the disputed domain name not too long after Complainant issued a press release announcing the launch of a subsidiary company named “Aramco Digital”. Moreover, the fact that the disputed domain name is used by Respondent for no other purpose but to be offered to both Complainant and on the Internet for at least USD 200,000 is a clear indication that Respondent registered the disputed domain name primarily for the purpose of selling it to Complainant in excess of Respondent’s documented out-of-pocket costs directly related to the disputed domain name. Such circumstances are evidence of registration and use of the disputed domain name in bad faith within the meaning of paragraph 4(b)(i) of the Policy.

Therefore, the Panel concludes that Complainant has also satisfied the third element under the Policy as set forth by paragraph 4(a)(iii).

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 <aramco.digital> be transferred to Complainant.

/Stephanie G. Hartung/

Stephanie G. Hartung

Sole Panelist

Date: January 24, 2024