

ADMINISTRATIVE PANEL DECISION

Valero Energy Corporation, Valero Marketing and Supply Company v. vanero energy, Valero Energy Corporation
Case No. D2024-1177

1. The Parties

The Complainants are Valero Energy Corporation and Valero Marketing and Supply Company, United States of America ("US"), represented by Fasthoff Law Firm PLLC, US.

The Respondent is vanero energy, Valero Energy Corporation, United Kingdom.

2. The Domain Name and Registrar

The disputed domain name <valeroenergycooperation.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 March 18, 2024. On March 19, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 19, 2024, 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 (Redacted for Privacy, Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainants on March 25, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amended Complaint on March 25, 2024.

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 26, 2024. In accordance with the Rules, paragraph 5, the due date for Response was April 15, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on April 19, 2024.

The Center appointed Federica Togo as the sole panelist in this matter on April 29, 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

The Complainants (i.e. Valero Energy Corporation and Valero Marketing and Supply Company, a wholly owned subsidiary of Valero Energy, hereinafter referred as the Complainant) operate in the field of oil and gas exploration, production, processing, and distribution services.

According to the information in the Complaint, the Complainant has continuously used the VALERO mark in commerce for at least 31 years.

The Complainant is the registered owner of many trademarks for VALERO, e.g. US Trademark Registration No. 1,314,004, registered on January 8, 1985, for services in class 42; e.g. US Trademark Registration No. 4,216,650, registered on October 2, 2012, for services in class 36.

It operates a website under the domain name <valero.com> and utilizes that domain name for company email addresses through which it communicates internally, with customers, vendors, and the public in general.

The disputed domain name was registered on January 10, 2024, and resolved to an inactive website. Furthermore, the undisputed evidence provided by the Complainant proves that the disputed domain name was used to contact third parties via email, while pretending to be a Complainant's employee, seemingly in order to obtain improper supply of products.

5. Parties' Contentions

A. Complainant

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

Notably, the Complainant contends that the disputed domain name is confusingly similar to the Complainant's trademark, since it is comprised of the Complainant's VALERO mark in its entirety, plus the generic words "energy" and "cooperation," along with the generic Top-Level domain, ".com". The Complainant further contends that its trademark VALERO is distinctive and well known.

The Complainant further contends that the Respondent has no rights or legitimate interests in the disputed domain name. According to the Complainant, the Respondent has never been commonly known by the domain name; the Complainant has not licensed to the Respondent the right to use the VALERO mark, and the Respondent is not otherwise authorized to act on the Complainant's behalf. To the contrary, the Respondent is engaged in an elaborate, criminal scheme in an attempt to commit fraud. The Respondent uses the email address connected to the disputed domain name to impersonate a purported Valero employee. In the email, the Respondent tries to persuade his victim that Valero is going to place an order for certain electronic equipment with the victim for which Valero will issue a purchase order and asks for a new customer credit application form.

Furthermore, the Complainant contends that the disputed domain name was registered and is being used in bad faith. According to the Complainant, it has owned and continually used the VALERO mark in commerce for more than 31 years. The Respondent was aware of the Complainant's prominence in the business world when it registered the disputed domain name. Notwithstanding the Respondent's knowledge of the fame

associated with the mark, it intentionally registered, for commercial gain, a domain that is comprised of the Complainant's trademark. Further, the Respondent has provided false contact information to the Registrar in an attempt to conceal his or her true identity, both of which constitute bad faith under the UDRP.

B. Respondent

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

6. Discussion and Findings

6.1 Procedural issues – Consolidation of the Complainants

The Complaint was filed by both Valero Energy Corporation and Valero Marketing and Supply Company, a wholly owned subsidiary of Valero Energy Corporation. In addition, each of the Complainants are individually the owner of registered trademarks for VALERO.

As set forth in section 4.11.1 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"): "In assessing whether a complaint filed by multiple complainants may be brought against a single respondent, panels look at whether (i) the complainants have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants in a similar fashion, and (ii) it would be equitable and procedurally efficient to permit the consolidation".

In the light of the above, the Panel finds that the Complainants have a specific common grievance against the Respondent because they share a common legal interest in the trademark rights on which this Complaint is based since both the Complainants own registrations for the trademark VALERO and allege a corporate connection. Against this background, the Panel does not see reasons why a consolidated Complaint brought by the Complainants against a single Respondent would not be fair and equitable. Moreover, the Respondent failed to come forward with any allegations or evidence to object the consolidation. For reasons of procedural efficiency, fairness and equity the Panel therefore accepts the joint Complaint.

6.2 Substantive issues

Paragraph 15(a) of the Rules instructs this Panel to "decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable". Paragraph 4(a) of the Policy requires a complainant to prove each of the following three elements in order to obtain an order that each disputed domain name be transferred or cancelled:

- (i) the disputed 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 disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

The Panel will therefore proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied.

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 the Complainant's trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms here, “energy” and “cooperation”, may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel finds the first element of the Policy has been established.

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.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant’s prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

Moreover, the evidence indicates that the disputed domain name is being used for a fraudulent email scheme aimed to impersonate the Complainant. Panels have held that the use of a domain name for illegal activity (here, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel 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.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent’s registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1. As explained above, it results from the undisputed evidence submitted by the Complainant that the disputed domain name has been used for sending a fraudulent email in the name of an alleged employee of the Complainant, seemingly in order to obtain improper supply of products on the Complainant’s account. Such use of the disputed domain name combined with the use of one of the Complainant’s names as registrant data of the disputed domain name further demonstrates that the Respondent not only knew of the

Complainant, its business, and marks, but also attempted to pass itself off as the Complainant which constitute bad faith.

Panels have held that the use of a domain name for illegal activity (here, impersonation/passing off, or other types of fraud) constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

The Panel finds that the Complainant has established the third element 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 <valeroenergycooperation.com> be transferred to the Complainant.

/Federica Togo/

Federica Togo

Sole Panelist

Date: May 13, 2024