

ADMINISTRATIVE PANEL DECISION

TotalEnergies SE v. jay maryjay
Case No. D2024-3292

1. The Parties

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

The Respondent is jay maryjay, United Kingdom.

2. The Domain Name and Registrar

The disputed domain name <instalindustry-totalquote.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 August 12, 2024. On August 13, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 13, 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 (Anonymized) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 15, 2024, 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 19, 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 August 28, 2024. In accordance with the Rules, paragraph 5, the due date for Response was September 17, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on September 18, 2024.

The Center appointed Delia-Mihaela Belciu as the sole panelist in this matter on September 25, 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 Complainant was originally created under the name of “Compagnie Française des Pétroles” in 1924. Several company names changes occurred since then, the more important ones being:

- “TOTAL – Compagnie française des pétroles” in June 21, 1985;
- “TOTAL” in June 26, 1991;
- “TotalEnergies SE” since May 28, 2021.

The term “Total” is part of the company name since 1985.

The Complainant is a worldwide company that produces and markets energies on a global scale: oil and biofuels, natural gas and green gases, renewables, and electricity, operating worldwide in more than 130 countries through a large group, and numerous subsidiaries. Its business includes all aspects of the energy industry from production to marketing, as well as in the development of next generation energy activities (biomass, wind). It is also a major actor of natural gas and a world-leading solar energy operator. For instance, in the gas field, based on the evidence available in the file, the Complainant is one of the largest global Liquefied Natural Gas players in the world.

The Complainant owns several trademarks which include the brand “TOTAL”, among which:

- French word trademark for TOTAL No. 1540708, registered on January 5, 1990, for goods and services in classes 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 13, 14, 15, 16, 17, 18, 19, 20, 21, 28, 29, 30, 31, 32, 33, and 34;
- International figurative trademark registration for TOTAL No. 1469417, registered on November 14, 2018, for goods and services in classes 1, 2, 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, having several jurisdictions designated for protection, among which United Kingdom;
- European Union figurative trademark for TOTAL No. 003180296, filed on April 28, 2003, registered on July 8, 2005, for goods and services in classes 1, 2, 3, 4, 5, 9, 11, 16, 17, 19, 35, 36, 37, 38, 39, 40, 41, 42, and 43;
- International figurative trademark registration for TE TOTALENERGIES No. 1601092, registered on May 18, 2021, for goods and services in classes 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, having several jurisdictions designated for protection, among which United Kingdom; and
- European Union word trademark for TOTAL ENERGIES No. 018308753, filed on September 17, 2020, registered on May 28, 2021, for goods and services in classes 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.

The Complainant, with its subsidiaries, hold more than 400 domain names including the term “total”, among which the domain name <total.com> since December 31, 1996 and the domain name <total.fr> since March 20, 1997. These domain names are active and resolve to the Complainant’s websites.

The disputed domain name was registered on June 14, 2024. According to the Complainant’s submissions, the disputed domain name did not resolve to an active website at the time of filing of the Complaint, however based on the available evidence in the file, the disputed domain name seems to have been used to create false email addresses destined to impersonate the Complainant and to scam the recipients.

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:

(i) the disputed domain name is confusingly similar to its trademarks, as such is reproducing in its entirety its trademark TOTAL, along with the descriptive term “industry” which corresponds to the Complainant’s activities, while the terms “quote” and “instal” are descriptive terms in the Complainant’s view, which refer, on one hand, to an estimation, on the other, to quote for an installation, that could be an industrial installation owned by the Complainant for the purpose of its activities.

(ii) in the Complainant’s view, the disputed domain name will appear as a variation of the Complainant’s earlier trademarks and domain names as it could refer for instance to the estimate costs/prices of the Complainant’s industrial installations and/or goods and services provided through the latter.

(iii) the Respondent does not have any rights or legitimate interests in the disputed domain name for a number of reasons, among which, (a) the Complainant has not authorized, licensed, or permitted anyone, including the Respondent, to use its trademarks or domain names, nor has it allowed the Respondent to reserve or use a domain name incorporating its trademark TOTAL, (b) the disputed domain name does not resolve to any website that would potentially justify any legitimate interest, (c) the registrant’s information related to the disputed domain name are hidden and that such is conducting fraudulent activities in relation to the disputed domain name. In this sense, the Complainant sustains that the disputed domain name has been used to create false email addresses destined to impersonate the Complainant and to scam the recipients. Based on the provided evidence, the Complainant’s logos and information were reproduced in the fraudulent email and documentation for quotation purposes as an obvious attempt to usurp the Complainant’s identity.

(iv) the disputed domain name was registered and is being used in bad faith for a number of reasons, among which that, (a) the disputed domain name is confusingly similar to its TOTAL well-known trademark, (b) the reproduction of the well-known trademarks TOTAL in the disputed domain name shows the will of the Respondent to place itself in the wake of the Complainant. The adjunction of the common descriptive terms “install”, “industry”, “quote” prove the deliberate will of the Respondent to impersonate the Complainant and its services by creating a look-alike domain name, (c) the Respondent is using the disputed domain name and associated email addresses for fraudulent and malicious intents for quotation purposes. In this sense, the Respondent reproduces in the fraudulent documentation accurate contact details, namely the address of the registered office of the Complainant’s subsidiary in the United Kingdom and it explicitly refers to the Complainant’s trademarks, company name and information so that the recipients of this e-mail believe that the Respondent is related to the Complainant whereas this is not the case.

B. Respondent

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

6. Discussion and Findings

In order for the Complainant to succeed, such must prove, according to paragraph 4(a) of the Policy, that:

(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 with respect to the disputed domain name; and

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

In case all three elements above have been fulfilled, the Panel is able to grant the remedy requested by the Complainant. Thus, the Panel will deal with each of the requirements in turn.

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 of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[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 Panel finds that the TOTAL mark is recognizable within the disputed domain name. The entirety of the TOTAL mark is reproduced within the disputed domain name having in front the terms "instal" and "industry" separated from the mark TOTAL by a dash, followed by the term "quote". 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 the terms "instal", "industry" and "quote", 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, as the TOTAL trademark is recognizable within the disputed domain name. [WIPO Overview 3.0](#), section 1.8.

In what concerns the addition of the generic Top-Level Domain ("gTLD") "com" this is not to be taken into consideration when examining the confusing similarity between the Complainant's trademarks and the disputed domain name, as such is viewed as a standard registration requirement and such is disregarded under the first element confusing similarity test. [WIPO Overview 3.0](#), section 1.11.1.

The Panel therefore finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

Based on the available record, 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.

The Respondent is not a licensee of, nor has received any authorization from the Complainant to make use of its TOTAL trademarks in the disputed domain name. The disputed domain name comprises the Complainant's TOTAL mark in its entirety in combination with the terms "industry", "instal" which could correspond to the Complainant's activities, while the other used term "quote" could correspond to a request for a quotation for the Complainant's activities. Based on the available evidence, the disputed domain name has been used to create false email addresses destined to impersonate the Complainant and to scam the

recipients. From the evidence available in the file, it appears that the Complainant's logos and information were reproduced in the fraudulent email and documentation for quotation purposes as an attempt to usurp the Complainant's identity.

Panels have held that the use of a domain name for illegal activity, in this case, impersonation/passing off, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

The above does not amount to a bona fide offering of goods or services, or to a legitimate noncommercial or fair use of the disputed domain name.

Based on the available record, 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.

In the present case, the Panel notes that the Complainant's rights to the TOTAL trademark predate the registration date of the disputed domain name.

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.

In this case, the disputed domain name comprises the Complainant's TOTAL mark in its entirety in combination with the descriptive terms "industry" and "instal", which could correspond to the Complainant's activities, while the other used descriptive term "quote" could correspond to a request for a quotation for the Complainant's activities. From the available evidence, it appears that the Respondent is using the disputed domain name and has associated email addresses for fraudulent and malicious intents for quotation purposes. To this end, the Respondent reproduces in the fraudulent documentation accurate contact details, namely the address of the registered office of the Complainant's subsidiary in the United Kingdom and it explicitly refers to the Complainant's trademarks, company name and information so that the recipients of this e-mail believe that the Respondent is related to the Complainant whereas this is not the case. Thus, from the available evidence, it results that the disputed domain name has been used to create false email addresses destined to impersonate the Complainant and to scam the recipients.

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

Thus, 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 <instalindustry-totalquote.com> be transferred to the Complainant.

/Delia-Mihaela Belciu/

Delia-Mihaela Belciu

Sole Panelist

Date: October 9, 2024