

ADMINISTRATIVE PANEL DECISION

Equinor ASA v. Sophia, Sophia
Case No. DCC2024-0025

1. The Parties

The Complainant is Equinor ASA, Norway, represented by Rouse AB (Valea AB trading as Rouse AB), Sweden.

The Respondent is Sophia, Sophia, United States of America.

2. The Domain Name and Registrar

The disputed domain name <sta-toil-mall.cc> (the “Disputed Domain Name”) is registered with Alibaba.com Singapore E-Commerce Private Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 11, 2024. On September 11, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On September 12, 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 (DT)) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 13, 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 amendment to the Complaint on September 16, 2024.

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 the Respondent of the Complaint, and the proceedings commenced on September 16, 2024. In accordance with the Rules, paragraph 5, the due date for Response was October 6, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 14, 2024.

The Center appointed Michael D. Cover as the sole panelist in this matter on October 18, 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 is Equinor ASA, a Norwegian corporation, formerly known as Statoil ASA. The Complainant is a broad international energy company with operations in more than 30 countries around the world, developing oil, gas, wind and solar energy.

Statoil ASA ("Statoil") had grown up with the emergence of the Norwegian oil and gas industry dating back to the late 1960s. Statoil was founded as The Norwegian State Oil Company (Statoil) in 1972 and the Norwegian State continues to hold 67% of the shares in Statoil.

The Complainant had decided to change its name to Equinor in 2018 and the name change was announced on March 15, 2018, and was publicized widely worldwide. The change of name reflects the shifting focus from oil and gas to renewable energy sources, such as wind and solar power.

The STATOIL trademark of the Complainant has protection through several hundred registrations worldwide. These trademark registrations include the following:

International Trademark Registration No. 1,220,682 STATOIL registered December 5, 2013

Norway Trademark Registration No. 281029 STATOIL registered March 19, 2015

The Complainant is the owner of more than 100 domain name registrations throughout the world containing the STATOIL trademark, distributed among generic Top-Level Domains ("gTLDs") and country code Top-Level Domains (ccTLDs"). These include the following:

<statoil-energi.com>

<statoil-jobs.com>

All that is known about the Respondent is that the Respondent is Sophia, Sophia, United States of America.

The Disputed Domain Name was registered on September 8, 2024. At the time of filing of the Complaint, the website to which the Disputed Domain Name resolves promoted cryptocurrency investments.

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.

Identical or Confusingly Similar

The Complainant submits that, by virtue of the Complainant's long use and the renown of the STATOIL name, the reputation associated with the STATOIL trademark is excellent by virtue of the quality of the Complainant's goods and services and the STATOIL trademark is undisputedly considered a well-known trademark within its field of business.

Notably, the Complainant also contends that the Disputed Domain Name is confusingly similar to a trademark or service mark in which the Complainant has rights. The Complainant notes that the Disputed Domain Name and the STATOIL trademark coincide in the string of letters “S-T-A-T-O-I-L” and that the addition of hyphens in the Disputed Domain Name does not alter the perception that it is, if not identical, highly similar to the STATOIL trademark and therefore causing a risk confusion.

The Complainant notes that the Disputed Domain Name contains the additional word “mall”, which does not have a crucial impact on the overall assessment of the confusingly similarity to the STATOIL trademark. The Complainant submits that, as the website linked to the Disputed Domain Name promotes cryptocurrency investments, the word “mall” could be interpreted as an indication of that website being an e-commerce site or a platform for investments referring to the Complainant. The Complainant also states that the word “statoil” is the most distinctive element of in the Disputed Domain Name and the additional word “mall” does not prevent a finding of confusing similarity and cites in support WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)), section 1.8.

The Complainant continues that its STATOIL trademark is clearly recognizable in the Disputed Domain Name and that, when reading the Disputed Domain Name as a whole, it enables an assumption that the Respondent targeted the Complainant’s trademark when registering the Disputed Domain Name, as a fraudulent attempt to mislead Internet users into believing that that the Disputed Domain Name is administered by or affiliated with the Complainant.

The Complainant notes in relation to the addition of the TLD “.cc” this is not sufficient to prevent the confusing similarity and cites section 1.11.1 of the [WIPO Overview 3.0](#).

The Complainant concludes that, bearing in mind the widespread reputation and high degree of recognition of the Complainant’s STATOIL trademark, especially in the energy sector and the lack of distinguishing factors between the Disputed Domain Name and the Complainant’s trademarks, the Disputed Domain Name should be considered to be confusingly similar to the STATOIL trademark, in which the Complainant has rights.

The Complainant submits that the first element of the Policy has been established.

Rights or Legitimate Interests

The Complainant submits that the Respondent has no rights to or legitimate interests in respect of the Disputed Domain Name, based on the Complainant’s prior use of its trademark STATOIL. The Complainant continues that the Respondent is not affiliated with or related to the Complainant in any way or licensed or otherwise authorized to use the STATOIL trademark in connection with a website, a domain name or for any other purpose.

The Complainant submits that the Respondent is not using the Disputed Domain Name in connection with any legitimate noncommercial or fair use without intent for commercial gain, is not generally known by the Disputed Domain Name and has not acquired any trademark or service mark rights in that name or mark. The Complainant further submits that the Respondent is neither using the Disputed Domain Name in connection with a bona fide offering of goods or services.

The Complainant therefore concludes that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

Registered or Used in Bad Faith

The Complainant submits that the Respondent has intentionally registered and is using the Disputed Domain Name in bad faith and that it is apparent from the composition of the Disputed Domain Name that the Respondent chose to register a domain name that contains a mark that is identical to the Complainant’s trademark STATOIL. The Complainant submits that the Respondent was fully aware of the fact that the

Disputed Domain Name incorporated a well-recognised and distinctive trademark in which the Respondent had absolutely no rights.

The Complainant notes that the Disputed Domain Name was registered on September 8, 2024, and submits that, given the long use of the STATOIL trademark across the world and trademark registrations predating the registration of the Disputed Domain Name, the Complainant finds that the Respondent has registered and is using the Disputed Domain Name in bad faith.

Furthermore, continues the Complainant, the Disputed Domain Name displays a crypto currency website, which actually uses the Complainant's other trademark EQUINOR. The Complainant notes that the Complainant has not endorsed the Dispute Domain Name and is in no aspect affiliated with the Disputed Domain Name. The Complainant also notes that the first page of the website to which the Disputed Domain Name resolves shows several images of the Complainant's Norwegian office and that there is a log in page where the EQUINOR trademark is used, which the Complainant submits further enhances the impression that the Disputed Domain Name is affiliated with the Complainant. The Complainant submits that the current use of the Disputed Domain Name is use in bad faith, as is it taking unfair advantage of the Complainant's trademark in an attempt to attract Internet users into investing in crypto currencies.

The Complainant notes that there is currently no active server connected to the Dispute Domain Name. The Complainant states that it believes that, if the email servers were to be activated, a receipt of a potential sent from "@sta-toli.mall.cc" would be likely to assume that the email had been sent in connection with the Complainant.

The Complainant concludes that the Respondent has intentionally attempted to attract Internet traffic, for commercial gain by creating a likelihood of confusion with the Complainant's trademark STATOIL. The Complainant also notes that the Respondent would have registered the Dispute Domain Name in bad faith given that the Complainant has a prior right in the trademark STATOIL over the Dispute Domain Name.

The Complainant requests that the Panel decide that the Disputed Domain Name be transferred to the Complainant.

B. Respondent

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

6. Discussion and Findings

The Complainant must establish on the balance of probabilities that the Disputed Domain Name is identical or confusingly similar a trademark or service mark in which the Complainant has rights; that the Respondent has no rights or legitimate interests in the Disputed Domain Name; and 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 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 STATOIL trademark is reproduced within the Disputed Domain Name. Accordingly, the Disputed Domain Name is confusingly similar to the STATOIL trademark of the Complainant for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms, such as “mall”, may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the Disputed Domain Name and the STATOIL trademark of the Complainant for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

It is also well-established in UDRP jurisprudence to ignore the applicable TLD when it does not form part of the relevant trademark for comparison purposes. The addition of the TLD, in this case “.cc”, is to be disregarded when considering confusing similarity. [WIPO Overview 3.0](#), section 1.11.1.

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.

Previous Panels have held that the use of a domain name for illegal activities, 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 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.

In the present case, the Panel notes that the Respondent has intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's STATOIL trademark and to disrupt the business of the Complainant.

Panels have held that the use of a domain name for illegal activity, here passing off, 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 <sta-toil-mall.cc> be transferred to the Complainant.

/Michael D. Cover/

Michael D. Cover

Sole Panelist

Date: November 1, 2024