Decision for dispute CAC-UDRP-106945

Case number	CAC-UDRP-106945
Time of filing	2024-10-17 09:12:40
Domain names	totalenergiesfr.org, totalenergiesfr.space, totalenerg.space, totalenerg.com, totalenrg.com, totalene.com , totalenerg.org, totalenergiess.info, totaienergies.energy, oiltotalenergy.online, totalfuel.online

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	TotalEnergies SE

Complainant representative

Organization	IN CONCRETO

Respondents

Organization	MarkPoint
Name	Arnold Gribabasko
Name	david scott
Name	Andrea Thack

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain names.

IDENTIFICATION OF RIGHTS

The Complainant is the proprietor of several trademark registrations consisting of or containing the word “TOTAL” or “TotalEnergies”, inter alia:

- International trademark No. 1469417 filed and registered on November 14, 2018, 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 for multiple countries including Australia, Turkey and USA;
- European Union trademark No. 018308753 **TOTAL ENERGIES** filed on 17.09.2020 and registered 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;

- European Union trademark No. 018392850 filed on February 8, 2021, 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;
- European Union trademark No. 018392838 filed on February 8, 2021, 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;
- International trademark No. 1601110 filed on February 9, 2021 in classes 1, 4, 7, 9, 37, 39 and 40 and registered in multiple countries including Australia, Turkey, UK and USA;

(collectively referred to also as “TOTAL and TotalEnergies trademarks”).

FACTUAL BACKGROUND

The Complainant, TotalEnergies SE, established in 1924 as “Compagnie Française des Pétroles,” underwent key name changes, adopting "TOTAL" and later "TotalEnergies SE" in 2021. A global French multinational company operates across 120+ countries in energy production including oil, biofuels, natural gas, renewables, and electricity. According to the Brand Finance Global 500 2024 report, the Complainant is ranked as the 114th most valuable brand globally.

The Complainant is inter alia the holder of the domain names <totalenergies.com> since March 8, 2014, <totalenergies.group> since February 1, 2021, <totalenergies.fr> since June 29, 2017, <total.com> since December 31, 1996, and <total.fr> since March 20, 1997. All these domain names resolve to the Complainant´s websites.

The eleven disputed domain names all registered successively between June 27, 2024 and September 16, 2024 involve four domain names <totalenergiesfr.org>, <totalenergiesfr.space>, <totalenerg.space>, and <totalenerg.com> registered by Respondent Mike Ivanchuk, four domain names <totalenrg.com>, <totalene.com>, <totalenerg.org>, and <totalenergiess.info> registered by Respondent Arnold Gribabasko, two domain names <oiltotalenergy.online> and <totalfuel.online> registered by Respondent Andrea Thack and <totaienergies.energy> registered by Respondent David Scott. All domain names are collectively referred to as disputed domain names. All Respondents are also jointly referred to as “Respondent”.

At the time of the decision, none of the disputed domain names resolved to active websites.

PARTIES CONTENTIONS

The Complainant contends that the requirements of the Policy have been met and that the disputed domain names should be transferred to it.

No administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

The Complainant has successfully demonstrated that it is the rightful owner of the TOTAL and TotalEnergies trademarks. The words TOTAL and/or TotalEnergies are clearly recognisable in the disputed domain names. In particular, the word “TOTAL” is fully incorporated in ten disputed domain names, whereas one disputed domain name <totaienergies.energy> includes an obvious misspelling of the term “Total” by substituting the letter “l” with visually similar letter “i”. The second element of the Complainant´s ”TotalEnergies” trademark “energies” is also fully incorporated in most of the disputed domain names in a combination with the word “TOTAL” or with misspelling of this word, namely <totalenergiesfr.org>, <totalenergiesfr.space>, <totalenergiess.info> and <totaienergies.energy>. The remaining disputed domain names include various abbreviations or variations of the word “energies” such as <totalenerg.space>, <totalenerg.com>, <totalenrg.com>, <totalene.com>, <totalenerg.org> and <oiltotalenergy.online>.

The addition of descriptive English terms that relate to the Complainant's line of business or country of origin in some of the disputed domain names, in particular "fr", "oil” or "fuel" is not sufficient to avoid confusion on the part of internet users. The confusing similarity is also not prevented by the graphic representation of some of the Complainant's marks, given that figurative, stylised or design elements in a mark generally cannot be represented in a domain name (see "Article 1.10 of the WIPO Jurisprudence Overview 3.0").

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of

the disputed domain names (within the meaning of paragraph 4(a)(ii) of the Policy).

A complainant is required to establish a prima facie case that the respondent lacks rights or legitimate interests. Once such a case is made, the burden of proof shifts to the respondent to demonstrate their rights or legitimate interests in the disputed domain name. Failure to do so results in the complainant satisfying paragraph 4(a)(ii) of the Policy (as per Article 2.1 of WIPO Jurisprudential Overview 3.0).

Based on the Complainant's contentions, the Panel concludes that the Complainant has successfully established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain names. The Panel concurs with the Complainant's arguments that the use of the disputed domain names demonstrates impersonation and passing off, which cannot be considered fair use (see also Section 2.5 of the WIPO Overview 3.0).

Both the composition of the disputed domain names and the nature of their use suggest impersonation, particularly the prior use of the Complainant's stylized trademarks, images of the Complainant's CEO, and articles related to the Complainant on the associated websites.

Given the Respondent's failure to provide any relevant evidence to demonstrate rights or legitimate interests, the Panel finds that the Complainant has satisfied the second element of the Policy.

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names have been registered and are being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

Bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark (see Article 3.1. of WIPO Jurisprudential Overview 3.0).

Registration in bad faith

The Panel considered the following factors in determining bad faith registration of the disputed domain names, in particular:

(a) the long history and reputation of the Complainant, Complainant's TOTAL and TotalEnergies trademarks, which were registered long before the disputed domain names;

(b) The Respondent's registration of the domain names in a short successive period of time using the same pattern, in particular the different variations or misspellings of the Complainant´s trademark and its company name including their combinations with the descriptive terms relating to the Complainant's industry which are clearly targeting the Complainant.

Based on the foregoing, the Panel concludes that the Respondent must have been aware of the Complainant and its trademarks when it registered the disputed domain names. In light of the foregoing, the Panel finds that the Respondent has registered the disputed domain names in bad faith.

Bad faith use

The evidence submitted by the Complainant demonstrates that the disputed domain names were associated with websites designed to give the impression of being official websites of the Complainant or of being affiliated with or endorsed by the Complainant. This impression was created through the use of the Complainant's stylized trademarks, images of the Complainant's CEO, and similar elements.

The Panel finds that the content of these websites clearly targets the Complainant, which constitutes evidence of bad faith use. By creating the impression of affiliation or endorsement, the Respondent's use of the disputed domain names is intended to mislead internet users.

The Panel further concludes that such use does not constitute a bona fide offering of goods or services but is rather an attempt to attract internet users for commercial gain by creating a likelihood of confusion with the Complainant's trademark regarding the source, sponsorship, affiliation, or endorsement of the websites.

Accordingly, the Panel finds that the disputed domain names are being used in bad faith.

PROCEDURAL FACTORS

Procedural issues - consolidation

Where a complaint is filed against multiple respondents, panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. Procedural efficiency would also underpin panel consideration of such a consolidation scenario.

Panels have considered a range of factors, typically present in some combination, as useful to determining whether such consolidation is appropriate, such as similarities in or relevant aspects of (i) the registrants' identity(ies) including pseudonyms, (ii) the registrants' contact information including email address(es), postal address(es), or phone number(s), including any pattern of irregularities, …. (iv) the content or layout of websites corresponding to the disputed domain names, (v) the nature of the marks at issue (e.g., where a registrant targets a specific sector), (vi) any naming patterns in the disputed domain names (e.g., <mark-country> or <mark-goods>), (vii) the relevant language/scripts of the disputed domain names particularly where they are the same as the mark(s) at issue, (viii) any changes by the respondent relating to any of the above items following communications regarding the disputed domain name(s), (ix) any evidence of respondent affiliation with respect to the ability to control the disputed domain name(s), (x) any (prior) pattern of similar respondent behavior. (see Article 4.11.2 of WIPO Jurisprudential Overview 3.0).

For the purpose of assessing the consolidation request, the Panel notes that the following four domain names <totalenergiesfr.org>, <totalenergiesfr.space>, <totalenerg.space>, and <totalenerg.com> registered by Respondent Mike Ivanchuk, and four domain names <totalenrg.com>, <totalene.com>, <totalenerg.org>, and <totalenergiess.info> registered by Respondent Arnold Gribabasko, share the same contact email address and phone number. Based on this alone, the Panel concludes without doubt that this group of domain names is under common control.

With respect to the domain names <oiltotalenergy.online>, <totalfuel.online>, and <totaienergies.energy>, the Panel observes the following similarities with the first group of domain names:

- Pattern in Contact Email Addresses. The contact email addresses of the second group follow a similar pattern to those of the first group. Specifically, the usernames in these emails combine names or nicknames (e.g., "justya," "gogol," "gandreas") with numeric sequences (e.g., "777," "334," "7878"). This pattern strongly suggests a common underlying actor or method.
- Conceptual Similarity. Both groups of disputed domain names prominently feature terms such as "total" and "energy," or related variations. This demonstrates a clear intent to imitate the branding of the Complainant, TotalEnergies as in the event of the first group of disputed domain names.
- Both groups display characteristics typical of domains used for phishing or impersonation. Specifically mimicking legitimate businesses to deceive users and diverting traffic by attracting visitors who mistakenly believe these domains are official websites.
- The domain names in both groups were registered within a short timeframe of three months. This temporal proximity further indicates a coordinated effort targeting the Complainant.
- None of the four respondents objected to the consolidation request or the complaints themselves. The Panel considers this lack of objection relevant to its decision to consolidate (see also WIPO Case No. D2023-0012 and WIPO Case No. D2022-1777).
- Deactivation of Websites. All respondents have already deactivated the websites associated with the disputed domain names. This behavior is further indicative of a coordinated effort and common control.

Based on these considerations, the Panel concludes that there is sufficient evidence to establish common control over all the disputed domain names. This supports the decision to consolidate the proceedings without the need for a detailed examination of the content of the associated websites, which are no longer active. The Panel further concurs with the Complainant that such consolidation is both fair and equitable to all parties involved.

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

The Panel has determined that the disputed domain names are confusingly similar to the Complainant's trademarks.

Based on the contentions presented by the Complainant, the Panel has found that the Complainant has satisfactorily made a prima facie case that the Respondent lacks rights or legitimate interests. As the Respondent has failed to provide relevant evidence demonstrating any such rights or legitimate interests, the Complainant is deemed to have satisfied the second element.

The Panel finds that, based on the Complainant's contentions and evidence, it can be concluded that the Respondent must have been aware of the Complainant's trademarks when it registered the disputed domain names, and as such, the Respondent has registered the disputed domain names in bad faith.

Lastly, the Panel has concluded that the Complainant has successfully proven that the disputed domain names are being used in bad faith.

Therefore, for the aforementioned reasons, the Panel orders that the disputed domain names be transferred to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **totalenergiesfr.org**: Transferred
2. **totalenergiesfr.space**: Transferred
3. **totalenerg.space**: Transferred
4. **totalenerg.com**: Transferred
5. **totalenrg.com**: Transferred
6. **totalene.com** : Transferred
7. **totalenerg.org**: Transferred
8. **totalenergiess.info**: Transferred
9. **totaienergies.energy**: Transferred
10. **oiltotalenergy.online**: Transferred
11. **totalfuel.online**: Transferred

PANELLISTS

Name	**Karel Šindelka**

DATE OF PANEL DECISION 2024-12-02

Publish the Decision