Decision for dispute CAC-UDRP-107111

Case number	CAC-UDRP-107111
Time of filing	2024-12-06 09:00:03
Domain names	totalenergeis.com

Case administrator

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

Complainant

Organization	TotalEnergies SE

Complainant representative

Organization	IN CONCRETO

Respondent

Name	BENITEZ ELIAS RODOLFO

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 name.

IDENTIFICATION OF RIGHTS

In these proceedings, the Complainant relies on the following trademarks:

- French trademark No. 1540708 **TOTAL** filed on December 17, 1953 (under N.436.836) and duly renewed in 2018 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 trademark No. 1469417 **TOTAL** (combined) filed 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 to cover notably several countries and territories;
- European Union trademark No. 018308753 **TOTAL ENERGIES** filed on February 17, 2020 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 **TotalEnergies** (combined) 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 **TotalEnergies** (combined) 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. 018395480 **TotalEnergies** (combined) filed on February 9, 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 **TotalEnergies** (combined) filed on February 9, 2021 in classes 1, 4, 7, 9, 37, 39 and 40 to cover 78 countries and/or territories;
- International trademark N. 1601092 **TotalEnergies** (combined) filed on May 18, 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 to cover 82 countries and/or territories.

It is worth noting that, the Complainant also owns other trademarks in various countries (including the U.S.A., where the Respondent is apparently located), which have not been cited in these proceedings.

Further, the Complainant emphasizes that TOTAL ENERGIES is also commonly used to designate its (new, since 2021) company name.

FACTUAL BACKGROUND

The Complainant is a French international company, originally founded in 1924, well-known and active in the field of production and distribution of all sorts of energies. Ever since, the Complainant has become a very large enterprise with activities all around the world and thousands of employees.

The Complainant owns a large-sized portfolio of trademarks including the wording "TOTAL" and “TOTAL ENERGIES”, among which a French national registration dating back to 1953. It also owns a multitude of related domain names, like <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.

The disputed domain name <TOTALENERGEIS.COM> was registered on September 4, 2024 by the Respondent, as confirmed by the Registrar.

PARTIES CONTENTIONS

COMPLAINANT

The Complainant contends that the disputed domain name is confusingly similar to its TOTAL ENERGIES trademark, as it is a misspelling of this wholly incorporated trademark. This last element is sufficient to support the finding that the disputed domain name is confusingly similar to the Complainant's trademark. Indeed, the mere misspelling of the Complainant’s trademark does not change the overall impression of a most likely connection with the trademark TOTAL ENERGIES of the Complainant. As to the gTLD “.com”, the Complainant suggests that it should be disregarded, as per the usual practice.

The Complainant maintains that the Respondent lacks rights or legitimate interests in the disputed domain name because the Complainant is not affiliated with nor has it ever authorised the Respondent to register its trademark as a domain name, the Complainant has never licensed its trademark to the Respondent, and because the disputed domain name does not resolve to an active website since its registration.

According to the Complainant, given the distinctiveness and reputation of the TOTAL ENERGIES trademark, the Respondent registered the disputed domain name with full knowledge of the Complainant's trademark in an intentionally designed way with the aim to create a likelihood of confusion with the Complainant’s trademarks and domain names, and this is evidence of the fact that the disputed domain name was registered in bad faith.

With respect to use in bad faith, the Complainant points out that the Respondent has not used the domain name at all, which is considered as a clear indication of bad faith. It is, indeed, impossible to conceive any actual or contemplated use that would not be illegitimate. But further, and most importantly, the Complainant alleges that the Respondent has fraudulently established a phishing scam, by impersonating the Complainant while approaching its clients via e-mails, which proves its bad faith.

For all these reasons, the Complainant concludes that the Respondent registered and used the disputed domain name in bad faith.

RESPONDENT

No administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is 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 disputed domain name consists of the Complainant's whole trademark (TOTAL ENERGIES), written in a misspelled way. The mere reversal of the letters “I” and “E” in the disputed domain name is not sufficient to escape the finding that the Disputed domain name is confusingly similar to the trademark of the Complainant. This is a clear case of typosquatting.

As far as the gTLD ".com" is concerned, it is generally recognized that top level domains do not have any bearing in the assessment of identity or confusing similarity, according to paragraph 4(a)(i) of the Policy.

Hence, the Panel is satisfied that the first requirement under the Policy is met.

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 name (within the meaning of paragraph 4(a)(ii) of the Policy).

Since proving a negative fact is almost impossible, panelists in UDRP proceedings have generally agreed that it is sufficient for the complainant to establish a prima facie case that the respondent lacks rights or legitimate interests in the disputed domain name to shift the burden of proof to the respondent.

In the case at issue, the Complainant argued that it had never authorised the Respondent to register the TOTAL ENERGIES trademark in a domain name, and that it had never licensed its trademark to the Respondent.

Furthermore, the disputed domain name resolves to an inactive website, while the Respondent has also engaged himself in a fraudulent e-mail scheme, and therefore the Respondent cannot demonstrate any use of the disputed domain name in connection with a bona fide offering of goods and services or a legitimate non-commercial or fair use of the disputed domain name.

Finally, there is no other evidence in the case file that could demonstrate that the Respondent has been commonly known by the disputed domain name.

In view of the foregoing, the Panel is satisfied that the Complainant has established a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name. In order to rebut the Complainant's arguments, the Respondent had the possibility to make his own defense. However, the Respondent has chosen not to file a Response.

Therefore, the Panel is satisfied that also the second requirement under the Policy is met.

BAD FAITH

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

As far as registration in bad faith is concerned, given the reputation of the Complainant's trademark and the fact that the disputed domain name fully incorporates this trademark (even in a misspelled way), it is quite evident that, at the time of the registration of the disputed domain name, the Respondent was well aware of the Complainant's trademark. The registration as domain name of a third party's well-known trademark with full knowledge of the fact that the rights over this trademark belong to a third party amounts to registration in bad faith.

With respect to use in bad faith, the disputed domain name resolves to an inactive website. Such non-use of a domain name can show bad faith under some circumstances, such as when the complainant’s trademark has such a strong reputation that it is widely known, and when it is impossible to conceive any plausible actual or contemplated active use of the domain name by the Respondent that would not be illegitimate. This fact is to be combined with the full incorporation of the Complainant’s reputable trademark in the disputed domain name. These are exactly the circumstances that apply in the case at issue. The trademark TOTAL ENERGIES enjoys wide and extensive reputation. Therefore, it is impossible to conceive any plausible active use of the disputed domain name that would be legitimate.

The above conclusion is further reinforced by the fraudulent e-mail use of the disputed domain name by the Respondent. As it has been shown by the Complainant’s evidence, not refuted by the Respondent, it seems that the Respondent has engaged in an important phishing scam, by sending e-mails requesting large amounts of money to clients of the Complainant, where signatures and names of employees of the Complainant appeared at the bottom.

Therefore, the Panel finds it clear that the disputed domain name was used in bad faith.

For all circumstances mentioned above, the Panel is satisfied that also the third requirement under the Policy is satisfied.

PROCEDURAL FACTORS

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 disputed domain name incorporates the Complainant's trademark, written in a misspelled way. The disputed domain name is therefore confusingly similar to the Complainant's trademark.

The Respondent was not authorised to include the Complainant's trademark in the disputed domain name, and the Complainant never licensed its trademarks to the Respondent. The Respondent is not using the disputed domain name in connection with a bona fide offering of goods or services, or a legitimate non-commercial or fair use.

The Respondent registered the disputed domain name with full knowledge of the Complainant's well-known trademark. His use of the disputed domain name as an inactive website and as a basis for phishing through fraudulent e-mails is in bad faith, as there is no conceivable use of the disputed domain name that could amount to a legitimate use.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **totalenergeis.com**: Transferred

PANELLISTS

Name	**Sozos-Christos Theodoulou**

DATE OF PANEL DECISION 2025-01-15

Publish the Decision