Decision for dispute CAC-UDRP-107393

Case number	CAC-UDRP-107393
Time of filing	2025-03-19 09:00:29
Domain names	total-energies-se.com

Case administrator

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

Complainant

Organization	TotalEnergies SE

Complainant representative

Organization	IN CONCRETO

Respondent

Name	Jacques Philippe Foulfoin

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

The Complainant has submitted evidence, which the Panel accepts, showing that it is the registered owner of the trademarks bearing “TOTAL”, “TOTAL ENERGIES” and “TotalEnergies”, inter alia, the following:

- European Union trademark n° 018395480, registered on June 25, 2021;

- European Union trademark n° 018392838, registered on June 26, 2021;

- European Union trademark n° 018308753, registered on May 28, 2021;

- International trademark n°1601110, registered on February 9, 2021.

Moreover, the Complainant is also the owner of the domain names bearing the signs “TOTAL”, “TOTAL ENERGIES” and “TotalEnergies” such as the domain name <totalenergies.com> registered since March 8, 2014 and the domain name <totalenergies.fr> registered since June 29, 2017.

FACTUAL BACKGROUND

The Complainant TotalEnergies SE was originally created under the name of Compagnie Française des Pétroles and registered before the French Companies Registry on March 28, 1924. The Complainant produces and markets oil and biofuels, natural gas and green gases, renewables, and electricity, operating worldwide in around 120 countries through a large Group, and numerous subsidiaries. TotalEnergies SE's 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 solar energy operator.

The Complainant holds the trademark registrations "TOTAL", "TOTAL ENERGIES" and "TotalEnergies" and domain names bearing these trademarks.

On November 25, 2024; the Respondent registered the disputed domain name <total-energies-se.com>. It is currently inactive at the date of this decision, and it can be seen from the screenshot provided in the Annexes that it was "being prepared" before without any more content.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant requests the Panel to exercise its discretion and allow the language of the proceeding to be English based on the following reasons:

- The Complainant states that it is clear from the fraudulent e-mails/documentation submitted in Annexes that the Respondent speaks and understands English very well.
- Moreover, the Complainant asserts that Respondent is already known for registering domain name comprising the well-known mark and company TotalEnergies and TotalEnergies SE since he registered back in 2024 the domain name <totalenergies-fr.com>, with the same Registrar "Aerotek Bilişim Sanayi ve Ticaret A.Ş.", against which an UDRP action was filed before WIPO by the Complainant (WIPO Case no. D2024-4183) and conducted all along in English.
- The Complainant also claims that it would be unfair, time-consuming and costly for the Complainant, who already suffers repeatedly damages caused by Respondent, to translate all the annexes, current complaint and evidence of fraud/impersonation, from English to Turkish.

1. THE DISPUTED DOMAIN NAME IS CONFUSINGLY SIMILAR

The Complainant explains that the disputed domain name is confusingly similar to the Complainant's trademark "TotalEnergies" as it bears the Complainant's trademark and trade name TotalEnergies SE as a whole with the addition of two hyphens, which are not sufficient to avoid likelihood of confusion, as well as the GTLD, which would be disregarded.

2. NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAME

The Complainant states that the Respondent is neither affiliated nor authorized by the Complainant in any way. Moreover, the Complainant alleges that neither license nor authorization has been granted to the Respondent to use the Complainant's trademarks.

The Complainant states that the Respondent has unlawfully used the disputed domain name to impersonate the Complainant by sending fraudulent e-mails for fake request for quotation with the e-mail address containing the disputed domain name as the e-mail extension/signature block. This deceptive conduct is claimed to be aimed to exploit the Complainant's reputation and illegitimately trade on its fame for gaining money, while misleading the public/service provider into believing that it is the Complainant. The use of the disputed domain name to pass off as the Complainant through impersonation is stated to be not a bona fide offering of goods or services nor a legitimate non-commercial or fair use under the Policy.

Moreover, the Complainant pointed out that the Respondent is either the prior owner or a related person to the prior owner of domain name <totalenergies-fr.com> which was used for fraud and against which an UDRP action was filed before WIPO by Complainant (WIPO Case no. D2024-4183).

The following reasons were stated as to why the Complainant has strong reasons to believe both domain names related:

- The registrar is/was the exact same one
- Both domain names are/were composed of Complainant's earlier rights on TotalEnergies
- Both domain names are/were used in a fraudulent scheme with the sending of malicious e-mails.
- The structure of these e-mails is very similar: First party in French then a line and the second party (reproducing the first one) in English beginning with "Dear Mrs, Mr, As part of the renewal of the equipment of…". Also, the telephone number reproduced in the signature block is identical namely, "Phone : +331 84 20 15 07".
- Sending of fraudulent e-mails with identically structured e-mail addresses <achat@totalenergiesfr.com>/<achat@total-energies-se.com>. "achat" is the French word for "purchase".

The Complainant states that further to the Registrar verification, it now knows that Respondent is Foulfoin Jacques Philippe - foulfoinphilippe406@gmail.com - N/A - 3 sentier des Clamart - ile de France – Turkey - 92140 +90.0644676633. As a consequence, the Complainant now has the official proof that the Respondent is the exact same person who is the prior owner of domain name <totalenergies-fr.com>.

Given the above, the Complainant asserted that the Respondent has had a history of registering domain names comprising the well-known mark and company TotalEnergies and TotalEnergies SE and using the malicious domain names to create e-mail addresses and then sending fraudulent e-mails for requests for quotation and impersonating the Complainant.

In consequence, the Complainant argues that the Respondent cannot possibly acquire a right or have a legitimate interest in the disputed domain name.

3. THE DISPUTED DOMAIN NAME WAS REGISTERED AND IS USED IN BAD FAITH

The Complainant states that the reservation of a domain name identical or highly similar to a trademark in which the Complainant has rights while the Respondent has no right to the domain name or legitimate interests in this respect and without authorization, demonstrates in itself that the Respondent is in bad faith.

Moreover, the Complainant also claims that since its trademarks are well-known and acquired a worldwide reputation in the field of industry in which it specializes since several decades, the Respondent could not have ignored the existence of the Complainant's trademarks at the time of the registration of the disputed domain name, with which it is confusingly similar. Also, the Complainant points out that a simple Google search would have necessarily forwarded the Respondent to the websites of the Complainant, which predate the disputed domain name and are also well-known.

The Complainant also contends that the disputed domain name is used for the creation of a messaging server. More than that, the Respondent has unlawfully used the disputed domain name to impersonate the Complainant by sending fraudulent e-mails for fake requests for quotation. This deceptive conduct aimed to exploit the Complainant's reputation and illegitimately trade on its fame for gaining money, while misleading the public/service provider into believing that it is the Complainant.

Moreover, the Complainant claims that the Respondent is either the prior owner or a related person to the prior owner of domain name <totalenergies-fr.com>, which was used for fraud and against which an UDRP action was filed before WIPO by Complainant (WIPO Case no. D2024-4183).

As a consequence, the Complainant states that the registration of the disputed domain name <total-energies-se.com> is highly prejudicing for the Complainant but also the random recipients, as the Respondent of this deceptive and misleading domain name used the company name and trademarks of the Complainant, in a bad faith manner and targeted the victim by sending fraudulent e-mails and requesting for quotations while impersonating the Complainant. It can therefore deeply impact the image of the Complainant if the victims are confused regarding the source of these e-mails. Given the distinctiveness and reputation of the Complainant, the Complainant states that a random recipient will easily consider that the fraudulent e-mails originate from the Complainant and as a consequence, deliver the required quotations and thereafter send the required merchandise. As such, the fraudulent e-mails/purchase order have been reported by the recipients themselves to the Complainant.

Also, the Complainant pointed out the absurdity of the postal address registered by the Respondent as Ile-de-France is not in Türkiye.

Finally, the Complainant highlighted that the Respondent is using a proxy/domain privacy service for the disputed domain name. It is claimed that, as repeatedly confirmed by WIPO Panels, use of a privacy or proxy registration service to shield a respondent's identity and elude or frustrate enforcement efforts by a legitimate complainant demonstrates bad faith use and registration of a disputed domain name.

In view of the explanations, the Complainant suggests that inference may be drawn therefore that in some way the Respondent hoped to capitalize on the reputation and rights of the Complainant. The registration and use of the disputed domain name was made for phishing and impersonation purposes.

As a conclusion, the Complainant alleges that the disputed domain name is registered and used 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).

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).

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).

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.

The Complaint was filed in English, but the language of the registration agreement is Turkish. Despite the language of the registration agreement being Turkish, the Complainant requested that the language of the proceeding to be English and explained its reasons.

Paragraph 11(a) of the Rules stipulates that: "[u]nless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding".

The Panel has duly considered the circumstances of this case. While there is a language requirement foreseen in paragraph 11(a) of the Rules, the Panel has to find the balance for ensuring that the proceeding takes place with due expedition and for the parties to be treated fairly and given a fair opportunity to present their case under Paragraph 10(b) and (c) of the Rules. The Panel is of the view that the language requirement should not cause any undue burden on the parties or undue delay (see Whirlpool Corporation, Whirlpool Properties, Inc. v. Hui'erpu (HK) electrical appliance co. ltd., WIPO Case No. D2008-0293; Solvay S.A. v. Hyun-Jun Shin, WIPO Case No. D2006-0593). It has been taken into account that no Response has been filed and there was no counter request from the Respondent, and in any case, English is an internationally common language. Consequently, the Panel believes that the Respondent would not be prejudiced if English is adopted as the language of the proceeding and the request of the Complainant is accepted.

PRINCIPAL REASONS FOR THE DECISION

Paragraph 15 of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

In this context, the Panel also notes that the burden of proof is on the Complainant to make out its case and past UDRP panels have consistently said that a Complainant must show that all three elements of the Policy have been made out before any order can be made to transfer a domain name.

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

1. the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
2. the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
3. the disputed domain name has been registered and is being used in bad faith.

The Panel will therefore deal with each of these requirements in turn.

1. IDENTICAL OR CONFUSINGLY SIMILAR

The Policy simply requires the Complainant to demonstrate that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights. The Panel is satisfied that the Complainant is the owner of registration of “TOTAL”, “TOTAL ENERGIES” and “TotalEnergies” trademarks.

The Panel finds that the disputed domain name is confusingly similar to the Complainant’s trademarks and trade name, and the addition of the two hyphens is not sufficient to vanish the similarity.

Moreover, the addition of the gTLD “.COM” is not enough to abolish the similarity.

The Panel is of the opinion that the Internet users will easily fall into false impression that the disputed domain name is an official domain name of the Complainant. The Panel recognizes the Complainant's rights and concludes that the disputed domain name is confusingly similar with the Complainant's trademark. Therefore, the Panel concludes that the requirements of paragraph 4(a)(i) of the Policy is provided.

2. NO RIGHTS OR LEGITIMATE INTERESTS

Under paragraph 4(a)(ii) of the Policy, the complainant has the burden of establishing that the respondent has no rights or legitimate interests in respect of the domain name.

It is open to a respondent to establish its rights or legitimate interests in a domain name, among other circumstances, by showing any of the following elements:

(i) before any notice to the respondent of the dispute, the use or making demonstrable preparations to use the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) the respondent of the dispute (as an individual, business, or other organization) has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or

(iii) the respondent of the dispute is making a legitimate non-commercial or fair use of the domain name, without an intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Thus, if the respondent proves any of these elements or indeed anything else that shows that it has a right or legitimate interest in the disputed domain name, the complainant will have failed to discharge its burden of proof and the complaint will fail. The burden is on the complainant to demonstrate a prima facie case that the respondent does not have rights or legitimate interests in the disputed domain name. Once the complainant has made out a prima facie case, then the respondent may, inter alia, by showing one of the above circumstances, demonstrate rights or legitimate interests in the disputed domain name.

The Complainant contends that the Respondent has nothing to do with the Complainant and any use of the trademarks “TotalEnergies” and “TOTAL ENERGIES” must be authorized by the Complainant and there is no such authorization. Moreover, the disputed domain name has no relation with the Respondent and the Respondent is not commonly known as the disputed domain name.

In the absence of a response, the Panel accepts the Complainant’s allegations as true that the Respondent has no authorization to use the Complainant’s trademark in the disputed domain name and that it is used for fraudulent purposes.

Hence, as the Complainant has made out its prima facie case, and as the Respondent has not demonstrated any rights or legitimate interests as illustrated under paragraph 4(c) of the Policy, nor has the Panel found any other basis for finding any rights or legitimate interests of the Respondent in the disputed domain dame, the Panel concludes that the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

3. BAD FAITH

The Panel concludes that the Complainant's “TOTAL ENERGIES” and “TotalEnergies” trademarks are of distinctive character and well-known. Therefore, the Panel is of the opinion that due to the earlier rights of the Complainant in the “TOTAL ENERGIES” and “TotalEnergies” trademarks, the Respondent was aware of the Complainant and its trademark at the time of registration of the disputed domain name (see e.g., Ebay Inc. v. Wangming, WIPO Case No. D2006-1107). Referring to Parfums Christian Dior v. Javier Garcia Quintas and Christiandior.net, WIPO Case No. D2000-0226, the Panel believes that the awareness of the Complainant’s trademarks at the time of the registration of the disputed domain name is to be considered an inference of bad faith registration.

Moreover, the disputed domain name <total-energies-se.com> is currently inactive. Regarding inactive domain names, section 3.3 of the WIPO Overview 3.0 provides the following: “From the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or ‘coming soon’ page) would not prevent a finding of bad faith under the doctrine of passive holding.” Besides, although there is no present use of the disputed domain name, the fact that there is MX record connected to the disputed domain name suggests that the Respondent will not be able to make any good faith use of the disputed domain name as part of an e-mail address and the fraudulent e-mail sent by using the e-mail extension/signature block of the disputed domain name shows the use in bad faith clearly.

In addition, it can be seen clearly from a previous WIPO UDRP Panel decision involving both the Complainant and the Respondent (WIPO Case no. D2024-4183, <totalenergies-fr.com>), in which the disputed domain name was also used for e-mails the same as the present case, the Panel found that there is fraud and impersonation, thus bad faith.

The Respondent did not provide any evidence of any possible good faith use of the disputed domain name.

Therefore, in light of the above-mentioned circumstances in the present case, the Panel finds that the disputed domain name has been registered and is being used in bad faith and that the Complainant has established the third element under paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **total-energies-se.com**: Transferred

PANELLISTS

Name	Mrs Selma Ünlü

DATE OF PANEL DECISION 2025-04-30

Publish the Decision