

ADMINISTRATIVE PANEL DECISION

TotalEnergies SE v. Castanian Chamoun
Case No. D2022-4683

1. The Parties

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

The Respondent is Castanian Chamoun, Gabon.

2. The Domain Name and Registrar

The disputed domain name <group-totalenergies.com> is registered with Register SPA (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on December 7, 2022. On December 7, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 12, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on December 14, 2022, 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 December 16, 2022.

On December 14, 2022, the Center sent an email in English and French to the Parties regarding the language of the proceeding. The Complainant confirmed its request that English be the language of the proceeding on December 16, 2022. The Respondent did not comment on the language of the proceeding.

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 December 28, 2022. In accordance with the Rules, paragraph 5, the due date for Response was January 17, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on January 20, 2023.

The Center appointed Benoit Van Asbroeck as the sole panelist in this matter on January 30, 2023. 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 a multinational energy company headquartered in France. The Complainant is the owner of registered trademarks in the marks TOTAL, TOTAL ENERGIES, and TOTALENERGIES, among which the following:

- French Trademark No. 1540708 for TOTAL, registered on December 5, 1988, in International 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. 591228 for TOTAL (figurative), registered on August 3, 1992, in International Classes 1, 2, 3, 4, 5, 9, 11, 16, 17, 19, 37, 39, 41, and 42;
- International Trademark No. 813234 for TOTAL (figurative), registered on September 2, 2003, in International Classes 1, 3, 4, 5, 17, 19, 35, 36, 37, 39, 40, 42, and 43;
- International Trademark No. 1469417 for TOTAL (figurative), registered on November 14, 2018, in International 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;
- European Union Trademark No. 018308753 for TOTAL ENERGIES, registered on May 28, 2021, in International 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 for TOTAL ENERGIES (figurative), registered on June 25, 2021, in International 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 for TOTALENERGIES (figurative), registered on June 26, 2021, in International 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 for TOTALENERGIES (figurative), registered on June 25, 2021, in International 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 for TOTALENERGIES (figurative), registered on February 9, 2021, in International Classes 1, 4, 7, 9, 37, 39, and 40;
- International Trademark No. 1601092 for TOTALENERGIES (figurative), registered on May 18, 2021, in International 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.

The Complainant also owns the following domain names:

- <total.com>, registered on December 31, 1996;
- <totalenergies.com>, registered on September 17, 2020;
- <totalenergies.info>, registered on June 29, 2017;
- <totalenergies.net>, registered on June 29, 2017.

The disputed domain name was registered on November 24, 2022, well after the Complainant secured rights to the trademarks. According to evidence submitted by the Complainant, the disputed domain name used to redirect to the Complainant's domain name and connected website at "www.totalenergies.com". Currently, the disputed domain name appears to be inactive.

5. Parties' Contentions

A. Complainant

The Complainant asserts that each of the three elements specified in paragraph 4(a) of the Policy are met. The three elements being: (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and (iii) the disputed domain name has been registered and is being used in bad faith.

(i) The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant contends that the disputed domain name is identical or confusingly similar to its trademarks since it incorporates the Complainant's abovementioned trademarks in their entirety. Moreover, the Complainant claims that the addition of the generic term "group" will only be perceived as a reference to the structure of the Complainant's company.

(ii) The Respondent has no rights or legitimate interests in respect of the disputed domain name.

The Complainant claims that the Respondent has no rights or legitimate interests in respect of the disputed domain name. Even though the disputed domain name redirects to the Complainant's domain name and connected website at <totalenergies.com>, the Complainant points out that they did not authorize, license, or permit the Respondent to use any of its trademarks or to apply for or use any domain name incorporating Complainant's trademarks, and thus, redirect to its domain name and connected website at "www.totalenergies.com". Finally, the fact that the Respondent's disputed domain name redirects to the Complainant's website shows that the Respondent is not commonly known by the disputed domain name, according to the Complainant.

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

The Complainant contends that the disputed domain name has been registered and is being used in bad faith. According to the Complainant, the reservation of a domain name identical or confusingly similar to famous or well-known trademarks belonging to the Complainant without the Respondent having a right to do so, demonstrates in itself that the Respondent is acting in bad faith. According to the Complainant, it is very unlikely that the Respondent chose the disputed domain name without any knowledge of the company name, domain names or trademarks of the Complainant, even more while the disputed domain name is redirecting obviously fraudulently to the Complainant's domain name and connected website at "www.totalenergies.com", and the Complainant believes that this is clear evidence of bad faith. The Complainant points to the possibility of the Respondent passing itself off as the Complainant, for instance by using the disputed domain name to generate email addresses with that domain name. Moreover, the Complainant contends, the Respondent is using the disputed domain name to attract, for commercial gain, Internet users to its domain name by creating a likelihood of confusion with the Complainant's trademarks and redirecting to the Complainant's domain name and connected website at "www.totalenergies.com", which would increase traffic and could potentially allow monetizing this.

B. Respondent

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

6. Discussion and Findings

A. Language of the Proceedings and Jurisdiction

Paragraph 11(a) of the Rules provides that “unless 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 language of the Registration Agreement for the disputed domain name is French. However, the Complainant has requested to conduct the proceeding in English.

The Complainant contends that the Respondent is able to communicate in English. According to the Complainant, English is a very common language throughout the world and it is one of the official languages of WIPO. Furthermore, the Complainant points to the word “group” in the disputed domain, which is an English word. Finally, the Complainant shows that the disputed domain name redirects to the English version of the Complainant’s website “www.totalenergies.com” even though this website also exists in French.

In addition, the Complainant points out that a translation of the Complaint from English into French would involve additional costs and unfairly disadvantage and burden the Complainant and delay the proceedings. The Complainant only became aware of the language of the registration agreement after it had already drafted the Complaint.

As noted by previous UDRP panels, paragraph 11 of the Rules must be applied in accordance with the overriding requirements of paragraphs 10(b) and 10(c) of the Rules which provide that the parties are treated equally, that each party is given a fair opportunity to present its case and that the proceeding takes place with due expedition (see *Volkswagen AG v. Nowack Auto und Sport - Oliver Nowack*, WIPO Case No. [D2015-0070](#); *General Electric Company v. Edison Electric Corp. a/k/a Edison Electric Corp. General Energy, Edison GE, Edison-GE and EEEGE.COM*, WIPO Case No. [D2006-0334](#); *Beiersdorf AG v. Good Deal Communications*, WIPO Case No. [D2000-1759](#); and *Deutsche Messe AG v. Kim Hyunho*, WIPO Case No. [D2003-0679](#)).

Taking the abovementioned requirements and the circumstances of this case all into account, the Panel considers that conducting the proceeding in English would not be disadvantageous to the Respondent.

The Panel agrees with the Complainant that, based on the circumstances presented by the Complainant, the Respondent appears to understand English. In addition, the Panel believes that there does not appear to be a risk that the Respondent may not appreciate the true nature of the proceeding and that they therefore may be deprived of a fair opportunity to present their case. The Center duly notified the Respondent in both English and French of these proceedings and the Complainant’s request to conduct these proceedings in English instead of French. The Center’s notices were issued to the email and correspondence addresses stated in the Whois records. The Center’s notice regarding the language of the proceedings contained a deadline for a response and the Center communicated both in English and French that “if we do not hear from you by this date, we will proceed on the basis that you have no objection to the Complainant’s request that English be the language of proceedings”. However, the Respondent did not respond to any of the Center’s notices, including this one, and failed to submit a Response.

The Panel is therefore satisfied that the Respondent was given a fair opportunity to appreciate the true nature of the proceedings and what its consequences may be, as well as present its case, to raise objections as to the request for English to be the language of proceedings or to inform the Center on its language preference. The Respondent has however chosen not to comment on any of these issues (cf. *Volkswagen AG v. Song Hai Tao*, WIPO Case No. [D2015-0006](#)). The Panel concludes that the Respondent will not be prejudiced by the proceeding being conducted in English and it has the advantage of avoiding unnecessary delay of the proceeding and further expense on translations into French of the Complaint and the annexes. Accordingly, the Panel determines that the language of the Proceeding shall be English.

Furthermore, the Panel finds that it has jurisdiction to hear this dispute as the Policy has been incorporated by reference into the registration agreement between the Registrar and the Respondent.

The Panel notes that while the Respondent has been duly notified, it did not reply to the Complainant's contentions within the time period established by the Rules. Pursuant to paragraph 14 of the Rules the Panel shall nonetheless proceed to a decision on the Complainant's Complaint and it may draw such inferences from the Respondent's failure to respond as it considers appropriate.

Paragraph 4(a) of the Policy requires that in order for its Complaint to succeed, the Complainant must prove that the following three elements are present:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

The above three elements will each be discussed in further detail below.

B. Identical or Confusingly Similar

The Complainant is required to establish: (1) that it owns rights in a trademark or service mark, and, if so, (2) that the disputed domain name is identical or confusingly similar to its trademarks.

Firstly, the Panel finds that the Complainant has clearly evidenced that it owns registered trademark rights to TOTAL, TOTAL ENERGIES, and TOTALENERGIES. The Panel is satisfied with the evidence provided in support of the existence of trademarks for or containing the word "Total" or "Total Energies". Some of the registered trademarks that the Complainant relies on are figurative, however these can also be taken into account to show "rights in a mark" since the dominant portions of these trademarks are the words "Total", "Total Energies" or "TotalEnergies", respectively. It is a consensus view of UDRP panels, with which the Panel agrees, that trademark registrations with design elements can *prima facie* satisfy the requirement that a complainant shows "rights in a mark" (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.10) so long as the textual elements are not overtaken. Finally, it should be noted that paragraph 4(a)(i) of the Policy does not set minimum requirements as to the jurisdictions of the trademarks a complainant relies on, nor as to the number, nature or scope of protection of such trademarks.

Secondly, the Panel finds that the disputed domain name is confusingly similar to the Complainant's registered trademarks since it incorporates the TOTAL, TOTAL ENERGIES and TOTALENERGIES marks of the Complainant in their entirety (see [WIPO Overview 3.0](#), section 1.7, as well as *L'Oréal, Lancôme Parfums et Beauté & Cie v. Jack Yang*, WIPO Case No. [D2011-1627](#); *Rapidshare AG, Christian Schmid v. InvisibleRegistration.com, Domain Admin*, WIPO Case No. [D2010-1059](#); and *The Stanley Works and Stanley Logistics, Inc. v. Camp Creek Co., Inc.*, WIPO Case No. [D2000-0113](#)). As the abovementioned trademarks are recognizable within the disputed domain name, the addition of "group" does not prevent the Panel's finding of confusing similarity under the first element. It is a well-established view of UDRP panels, with which the Panel agrees, that the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element (see for instance: *Ansell Healthcare Products Inc. v. Australian Therapeutics Supplies Pty, Ltd.*, WIPO Case No. [D2001-0110](#); *Nintendo of America Inc. v. Fernando Sascha Gutierrez*, WIPO Case No. [D2009-0434](#); *M/s Daiwik Hotels Pvt. Ltd v. Senthil Kumaran S, Daiwik Resorts*, WIPO Case No. [D2015-1384](#); and *BHP Billiton Innovation Pty Ltd v. Oloyi*, WIPO Case No. [D2017-0284](#)).

Finally, as for the applicable Top-Level Domain ("TLD"), i.e., the suffix ".com", the Panel holds that this can be disregarded under the first element confusing similarity test (*CANAL + FRANCE v. Franck Letourneau*,

WIPO Case No. [DTV2010-0012](#); *Bentley Motors Limited v. Domain Admin / Kyle Rocheleau, Privacy Hero Inc.*, WIPO Case No. [D2014-1919](#); and SAP SE v. Mohammed Aziz Sheikh, Sapteq Global Consulting Services, WIPO Case No. [D2015-0565](#).

On the basis of the foregoing findings, and according to paragraph 4(a)(i) of the Policy, this Panel finds and concludes that the disputed domain name is confusingly similar to the Complainant's trademarks.

C. Rights or Legitimate Interests

Paragraph 4(c) of the Policy non-exhaustively lists three circumstances that shall demonstrate a right or legitimate interest:

"Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

- (i) before any notice to you of the dispute, your use of, or 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) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue."

It is a well-established view of UDRP panels, with which the Panel agrees, that a *prima facie* case advanced by a complainant is generally sufficient to satisfy the requirements under paragraph 4(a)(ii) of the Policy, and the burden of production shifts to the respondent to provide relevant evidence demonstrating rights or legitimate interests in the disputed domain name (*AGUAS DE CABREIROA, S.A.U. v. Hello Domain*, WIPO Case No. [D2014-2087](#); *Spigen Korea Co., Ltd., Spigen Inc. v. Domain Admin, Whols Privacy Corp.*, WIPO Case No. [D2016-0145](#); and *HubSpot, Inc. v. WholsGuard Protected, WholsGuard, Inc. / Steve Johnson*, WIPO Case No. [D2016-1338](#)).

The Panel notes that the Respondent has not responded to any of the Complainant's contentions, let alone submitted evidence to the contrary, and that, pursuant to paragraph 14 of the Rules, the Panel may draw such inferences from the Respondent's failure to respond as it considers appropriate. In the present case, taking into consideration the Respondent's default, this Panel finds that the Complainant has made out an unrefuted *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, in view of the circumstances of this case, including the following factors.

The Panel finds that there is no evidence that the Respondent is using the disputed domain name in connection with a *bona fide* offering of goods or services. The fact that the disputed domain name is confusingly similar to the Complainant's trademarks carries a risk of implied affiliation. This risk appeared to have already materialised since the disputed domain name used to redirect to the Complainant's domain name and connected website at "www.totalenergies.com". The Panel agrees with the Complainant that this use falsely suggests affiliation with the Complainant and may indeed confuse consumers about the source of the domain name and whether or not it is sponsored or otherwise endorsed by the Complainant. As is clear from sections 2.2, 2.5, and 2.8 of the [WIPO Overview 3.0](#), UDRP Panels have consistently found that such use of a domain name can neither be considered legitimate noncommercial or fair use of the domain name nor a *bona fide* offering of goods or services.

In addition, the Complainant asserts that the Respondent is not affiliated with the Complainant in any way nor has the Complainant licensed, authorized, or permitted the Respondent to register domain names incorporating the Complainant's trademarks. The Panel has taken note of the Complainant's confirmation in

this regard and has not seen any evidence that would suggest the contrary. In the absence of any license or permission from the Complainant to use its trademarks, no actual or contemplated *bona fide* or legitimate use of the disputed domain name could reasonably be claimed (see, e.g., *Sportswear Company S.P.A. v. Tang Hong*, WIPO Case No. [D2014-1875](#); and *LEGO Juris A/S v. DomainPark Ltd, David Smith, Above.com Domain Privacy, Transure Enterprise Ltd, Host master*, WIPO Case No. [D2010-0138](#)).

Finally, the Panel agrees with the Complainant that there is no evidence that the Respondent has been commonly known by the disputed domain name. The fact that the Respondent disputed domain name redirects to the Complainant's website rather than its own indeed further supports this.

For all the foregoing reasons, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

D. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy non-exhaustively lists four circumstances that, if found by the Panel to be present, shall be evidence of the registration and use of the domain name in bad faith:

- “(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or
- (ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location.”

The Panel finds that the circumstances and evidence presented by the Complainant offer sufficient proof that both the Respondent's registration and current use of the disputed domain name are in bad faith.

The Panel will first discuss the Respondent's registration of the disputed domain name. The Panel believes that the Respondent knew or, at least, should have known at the time of registration that the disputed domain name included the Complainant's abovementioned trademarks. Knowledge of the TOTAL, TOTAL ENERGIES, and TOTALENERGIES trademarks may be inferred from the fact that these trademarks have been registered in different countries and existed for a long time prior to the Respondent's registration of the disputed domain name (see, e.g., *SembCorp Industries Limited v. Hu Huan Xin*, WIPO Case No. [D2001-1092](#); and *American Funds Distributors, Inc. v. Domain Administration Limited*, WIPO Case No. [D2007-0950](#)). The fact that the disputed domain name, without the Complainant's permission, redirected to the Complainant's domain name and connected website at “www.totalenergies.com” is a further indicator of this.

As for the use of the disputed domain name, the Complainant relies on the circumstances described under paragraph 4(b)(iv) of the Policy and points to the possibility of the Respondent passing itself off as the Complainant, for instance by using the disputed domain name to generate email addresses with that domain name. Moreover, the Complainant has submitted evidence which shows that the disputed domain name previously redirected to the Complainant's domain name and connected website at “www.totalenergies.com”. The Panel finds that these facts can indeed support the conclusion that the Respondent has used the

disputed domain name to attract, for commercial gain, Internet users to its domain name by creating a likelihood of confusion with the Complainant's trademarks and redirecting to the Complainant's domain name and connected website at "www.totalenergies.com". The fact that the disputed domain name no longer resolves to the Complainant's website and therefore the use of the disputed domain name in the abovementioned illegitimate activity may now have stopped, does not prevent a finding of bad faith use here. It is a well-established view of UDRP panels, including in *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#), and *Jupiters Limited v. Aaron Hall*, WIPO Case No. [D2000-0574](#), that the non-use of a domain name does not prevent a finding of bad faith under the doctrine of passive holding. The Panel agrees with this view and finds that the circumstance of past bad faith use by the Respondent makes it implausible that the disputed domain name will be put to any good faith use in the future. Moreover, given the previous redirection and change in use, the Respondent's retention of control of the disputed domain name represents an implied and ongoing threat to the Complainant, which further supports a finding of bad faith.

In light of the above, the Panel finds that the disputed domain name was registered and is being used by the Respondent in bad faith.

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, <group-totalenergies.com>, be transferred to the Complainant.

/Benoit Van Asbroeck/
Benoit Van Asbroeck
Sole Panelist
Date: February 13, 2023