

ADMINISTRATIVE PANEL DECISION

Valero Energy Corporation, Valero Marketing and Supply Company v.
Name Redacted

Case No. D2023-4958

1. The Parties

Complainants are Valero Energy Corporation, Valero Marketing and Supply Company, United States of America (“United States”), represented by Fasthoff Law Firm PLLC, United States.

Respondent is Name Redacted.¹

2. The Domain Name and Registrar

The disputed domain name <membersvalero.com> is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 28, 2023. On November 29, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 30, 2023, 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 (Privacy Protect LLC, PrivacyProtect.org) and contact information in the Complaint. The Center sent an email communication to Complainant on November 30, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on November 30, 2023.

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

¹ Respondent appears to have used without permission the name of a third party, an employee of Complainant, when registering the disputed domain name. In light of the potential identity theft, the Panel has redacted Respondent’s name from this decision. However, the Panel has attached as Annex 1 to this decision an instruction to the Registrar regarding transfer of the disputed domain name, which includes the name of Respondent. The Panel has authorized the Center to transmit Annex 1 to the Registrar as part of the order in this proceeding, and has indicated Annex 1 to this decision shall not be published due to the exceptional circumstances of this case. See *Banco Bradesco S.A. v. FAST-12785241 Attn. Bradescourgente.net / Name Redacted*, WIPO Case No. [D2009-1788](#).

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 Respondent of the Complaint, and the proceedings commenced on December 4, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 24, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on January 3, 2024.

The Center appointed Scott R. Austin as the sole panelist in this matter on January 23, 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 following facts appear from the Complaint (as amended) and its annexes, which have not been contested by Respondent.

Complainant Valero Energy Corporation and its wholly-owned subsidiary, Valero Marketing and Supply Company, consolidated for purposes of this UDRP proceeding based on the parent - subsidiary ownership interest in and control over the trademarks at issue (collectively referred to for purposes of this proceeding as Complainant) is a leading oil and gas processing and distribution company, as well as a leading provider of automobile service station services operated throughout the United States under the trademark and service mark VALERO (the “VALERO Mark”). When the disputed domain name was registered on September 20, 2023, Fortune Magazine listed Complainant as the 30th largest company in the United States. Since at least as early as 1983, Complainant has spent tens of millions of dollars advertising, marketing, and promoting the VALERO Mark in the United States and throughout the world, which significant investment and continuous use for almost four decades has developed consumer goodwill and well-known recognition of the VALERO Mark.

Complainant owns numerous registrations for the VALERO Mark in the United States, where Respondent is ostensibly located, and around the world, including:

- United States Registration No. 1,314,004, VALERO, registered January 8, 1985, for oil and gas processing and distribution services in international class 42 and claiming a first use date of February 7, 1983; and
- United States Registration No. 2,656,971, VALERO, registered December 3, 2002, for convenience store services in international class 35 and automobile service station services and car wash services in international class 37, both claiming a first use date of August 15, 2000.

The Panel notes that Complainant has submitted among the registrations in its Annexes in support of its trademark rights United States Registration No. 2,560,091, VALERO, registered April 3, 2002, for retail store services covering a range of goods sold at its service stations in international class 35, including evidence of an accepted maintenance filing under Sections 8 and 15 in 2008, but fails to note that this registration was cancelled in 2012, and as such will not be relied upon by the Panel for purposes of this decision.

Complainant further has continuously owned and operated an Internet website accessed through the domain name incorporating the VALERO Mark <valero.com> at “www.valero.com” for many years (the “VALERO Mark Official Website”), and also utilizes that domain name for company email addresses through which it communicates internally, with customers, vendors, and the public in general.

The Philippines Securities and Exchange Commission (“SEC”) has also issued a warning that the website operating from the disputed domain name impersonates Complainant.

The disputed domain name <membersvalero.com> was created on September 20, 2023, and at the time of the filing of the Complaint, the disputed domain name resolved to a login page displaying Complainant's trademark. Complainant claims that this login page presumably can be accessed only by victims of Respondent's use of its website identified in a Philippines Securities Exchange Commission advisory as a "Ponzi scheme" where Respondent engages in an offering of unregistered securities to the public as VALERO ENERGY CORPORATION PHILIPPINES, using Complainant's trademarks in violation of numerous criminal and civil laws.

5. Parties' Contentions

A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name: that the disputed domain name is confusingly similar to Complainant's trademark because it incorporates complainant's VALERO Mark in its entirety with the addition of term which are irrelevant under the Policy; that Respondent has no rights or legitimate interests in respect of the disputed domain name used as Respondent's illegitimate platform through which Respondent apparently conducts a fraudulent and criminal Ponzi scheme. Indeed, Respondent's intention appears to be to collect sensitive login information by passing off Respondent's website landing page as an official login page from Complainant's VALERO Mark Official Website and thereby deceive unsuspecting Internet users into providing confidential information through imitation of Complainant's authentic login page; and that the disputed domain name was registered and is being used in bad faith.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

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

The onus is on Complainant to make out its case and it is apparent from the terms of the Policy that Complainant must show that all three elements set out in paragraph 4(a) of the Policy have been established before any order can be made to transfer the disputed domain name. As the proceedings are administrative, the standard of proof under the Policy is often expressed as the "balance of the probabilities" or "preponderance of the evidence" standard. Under this standard, an asserting party needs to establish that it is more likely than not that the claimed fact is true. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)), section 4.2.

Thus, for Complainant to succeed it must prove within the meaning of paragraph 4(a) of the Policy and on the balance of probabilities that:

1. The disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
2. 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 finds that Complainant has met its burden in all three elements of the Policy and will deal with each of these elements in more detail below.

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 Complainant's trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

The Panel finds 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. Ownership of a nationally registered trademark constitutes prima facie evidence that the complainant has the requisite rights in a mark for purposes of paragraph 4(a)(i) of the Policy. Complainant claims trademark rights in the VALERO Mark for its automobile service station services in its registrations for the VALERO Mark dating back to 1985. Sufficient evidence has been submitted in the form of electronic copies of valid and subsisting trademark registration documents in the name of Complainant and therefore, Complainant has demonstrated it has rights in the VALERO Mark. See *Advance Magazine Publishers Inc., Les Publications Conde Nast S.A. v. Voguechen*, WIPO Case No. [D2014-0657](#).

With Complainant's rights in the VALERO Mark established, the remaining question under the first element of the Policy is whether the disputed domain name is identical or confusingly similar to Complainant's VALERO Mark. Prior UDRP panels have held "in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing". See, *L'Oréal, Lancôme Parfums et Beauté & Cie v. Jack Yang*, WIPO Case No. [D2011-1627](#); see also, *Wal-Mart Stores, Inc. v. MacLeod d/b/a/ For Sale*, WIPO Case No. [D2000-0662](#). The disputed domain name incorporates Complainant's VALERO Mark in its entirety. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy.

Although the addition of other terms may bear on assessment of the second and third elements, the Panel finds the addition of such terms here, "members", and the Top-Level Domain ("TLD") ".com", does not prevent a finding of confusing similarity between the disputed domain name and the VALERO Mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8; see also *Eurochannel Inc. v. Sarah Staar*, WIPO Case No. [D2007-0165](#); see also *Rakuten, Inc. v. Domain Admin, Privacy Protect, LLC (PrivacyProtect.org) / Matthew Connor, No Company*, WIPO Case No. [D2019-2983](#).

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 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. See also, *Malayan Banking Berhad v. Beauty, Success & Truth International*, WIPO Case No. [D2008-1393](#).

Having reviewed the available record, the Panel finds Complainant has established a prima facie case that Respondent lacks rights or legitimate interests in the disputed domain name. Respondent has not rebutted 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.

First, Complainant asserts that there was never any connection, affiliation or legitimate business relationship between Complainant and Respondent giving rise to any license, permission, or other right by which Respondent could own or use any domain name incorporating or imitating the VALERO Mark and it has never authorized, licensed, or otherwise permitted Respondent to use the VALERO Mark in any manner, for the disputed domain name or otherwise. Prior UDRP panels have found the fact that a respondent is not authorized to register or use a complainant's mark, "on its own, can be sufficient to prove the second criterion [of the Policy]". *Six Continents Hotels, Inc. v. IQ Management Corporation*, WIPO Case No. [D2004-0272](#); see also *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#) (finding no rights or legitimate interests where domain name incorporated complainant's registered mark and respondent was not a licensee of complainant).

Second, it is clear from the record submitted that Respondent is using the disputed domain name to impersonate Complainant and intentionally misdirect and divert, for commercial gain, Internet users to Respondent's unauthorized website, by creating a likelihood of confusion with Complainant and Complainant's well-known VALERO Mark. Prior UDRP panels have consistently held that use of a disputed domain name to misdirect Internet users seeking a complainant to a competitive or unrelated site is not a bona fide offering of goods or services or a legitimate noncommercial or fair use under the Policy. See *Kosmea Pty Ltd. v. Krpan*, WIPO Case No. [D2000-0948](#). Accordingly, Respondent is not making a bona fide offering of goods and services and, therefore, Respondent has no legitimate interest in the subject domain name under the circumstances described in paragraph (4)(c)(i) of the Policy.

Complainant has also shown based on persuasive evidence submitted that Respondent is not commonly known by the disputed domain name. The original Respondent listed in the Whois record submitted with the initial Complaint was "Privacy Protect LLC, PrivacyProtect.org" of the United States. Later, Complainant amended its complaint when the Registrar disclosed the underlying registrant as an individual whose name the Panel has redacted over concerns of potential identity theft because Respondent appears to have used without permission the name of a third party, specifically, an employee of Complainant as the registrant when registering the disputed domain name. Complainant submitted its amendment to the Complaint to include the Registrar disclosed individual registrant as Respondent. In this proceeding, neither the original nor the disclosed Respondent name bears any resemblance to the disputed domain name. Based on these facts, combined with the lack of evidence in the record to suggest otherwise, this Panel finds that Respondent is not commonly known by the disputed domain name or any variation thereof pursuant to Policy paragraph 4(c)(ii). See *Six Continents Hotels, Inc. v. Trasporto di Networ and Pro Intel*, WIPO Case No. [D2004-0246](#) ("given Complainant's established use of its... marks, it is unlikely that the Respondents are commonly known by any of these marks").

It is generally regarded as prima facie evidence of no rights or legitimate interests if a complainant shows that the disputed domain name is identical or confusingly similar to a complainant's trademark, that the respondent is not commonly known by the disputed domain name, and that a complainant has not authorized the respondent to use its mark (or an expression which is confusingly similar to its mark), whether in the disputed domain name or otherwise. See *Roust Trading Limited v. AMG LLC*, WIPO Case No. [D2007-1857](#).

Most importantly, Complainant contends Respondent is not using the disputed domain name in connection with a bona fide offering of goods or services because, as Complainant's Annex evidence of the web page connected to the disputed domain name shows, the disputed domain name resolved to a login page website where Respondent misused Complainant's VALERO Mark, attempting to create a false association with Complainant. The Panel notes that evidence submitted in the Annexes to the Complaint especially the Philippines SEC report persuasively supports Complainant's argument because it shows Respondent's website prominently features unauthorized use of Complainant's VALERO Mark for the illegitimate purpose of furthering an illegal Ponzi scheme offering unregistered securities to the public as VALERO ENERGY CORPORATION PHILIPPINES through related social media pages used by Respondent also featuring

unauthorized use of the Valero Mark.. Respondent, therefore, is using the disputed domain name to confuse Internet users and suggest an affiliation with or sponsorship by Complainant to resolve Internet users to its website for its commercial gain. Based on these facts the Panel finds Respondent's actions are clearly not legitimate and clearly are misleading. Respondent, therefore, cannot establish rights or legitimate interests pursuant to paragraph 4(c)(iii) of the Policy. See *Six Continents Hotels v. "m on"*, WIPO Case No. [D2012-2525](#).

In view of the above, the Panel finds that Complainant has made out a *prima facie* case that Respondent has no rights or legitimate interests in the disputed domain name. Respondent has not submitted any arguments or evidence to rebut Complainant's *prima facie* case. The Panel determines, therefore, that Respondent does not have rights or legitimate interests in the disputed domain name and Complainant has successfully met its burden under Policy paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

First given the Panel's findings in Section 6B above it should be noted that prior UDRP panels have held that "lack of respondent's rights or legitimate interests in the domain name is undoubtedly indicative of registration in bad faith." *Puerto 80 Projects SLU v. Domains By Proxy, LLC, DomainsByProxy.com and Jupiter Miguel Tarrero Gallo*, WIPO Case No. [D2012-1563](#).

The Panel finds based on the record submitted, that Respondent clearly registered the disputed domain name to impersonate Complainant through unauthorized use of Complainant's VALERO Mark to engage in a potential fraudulent Ponzi scheme involving the unlawful offering of unregistered securities to the public. It is implausible, therefore, to believe that Respondent was not aware of the VALERO Mark when it registered its confusingly similar disputed domain name to engage in its illegal Ponzi scheme. Complainant contends this shows Respondent's clear intention to target the VALERO Mark through the registration of the disputed domain name. In the circumstances of this case, where Respondent registered the disputed domain name to blatantly engage in *per se* illegitimate activity using the name of an employee of Complainant to register the disputed domain name, with actual knowledge demonstrated through configuration of a disputed domain name targeting Complainant's registered mark, such a showing is sufficient to establish bad faith registration. See, [WIPO Overview 3.0](#), section 3.1.4; see also *bioMérieux v. Registration Private*, WIPO Case No. [D2020-3499](#).

Based on these facts the Panel also finds that Respondent uses the disputed domain name in bad faith by: (1) passing itself off as an affiliate or a company associated with Complainant via what appears to be an official VALERO login page; and (2) as per the Philippines SEC report provided on record, perpetrating a fraudulent scheme to illegally sell unregistered securities as well as phish personal data from the targeted Internet users through the illegal securities offering requirements Respondent provides to them. Respondent has registered the disputed domain name, confusingly similar to Complainant's well-known VALERO Mark, in order to capitalize on Complainant's reputation in furtherance of Respondent's alleged fraudulent Ponzi scheme.

For these reasons, the Panel finds that Respondent has registered and is using the disputed domain name in bad faith and Complainant has met its burden under paragraph 4(a)(iii) 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 <membersvalero.com> be transferred to Complainant.

/Scott R. Austin/

Scott R. Austin

Sole Panelist

Date: February 15, 2024