

ADMINISTRATIVE PANEL DECISION

Valero Energy Corporation, Valero Marketing and Supply Company v. RITA FELDER

Case No. D2022-0358

1. The Parties

The Complainants are Valero Energy Corporation and Valero Marketing and Supply Company (hereinafter referred collectively to as the “Complainant” or “Valero”), United States of America (the “United States” or “U.S.”), represented by Fasthoff Law Firm PLLC, United States.

The Respondent is RITA FELDER, Germany.

2. The Domain Name and Registrar

The disputed domain name <valeroz.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 February 1, 2022. On February 2, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 3, 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 February 4, 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 February 7, 2022.

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 February 10, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 2, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 3, 2022.

The Center appointed Daniel Peña as the sole panelist in this matter on March 8, 2022. 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 Complainants are Valero Energy Corporation, headquartered in San Antonio, Texas, United States, and Valero Marketing and Supply Company, a wholly owned subsidiary of Valero Energy Corporation. The Complainant's business activities focus primarily but not exclusively on oil and gas exploration, production, procession, and distribution. The Complainant is the owner of following trademark registrations for its VALERO mark issued by the United States Patent & Trademark Organization (USPTO):

- VALERO, U.S. Reg. No. 1314004, applied for August 1, 1983, and registered on January 8, 1985, for use in oil and gas exploration, production, processing, and distribution services in Class 42 (first use in commerce February 7, 1983) (Sec. 2(f));
- VALERO, U.S. Reg. No. 4216650, applied for October 5, 2011, and registered on October 2, 2012, for credit card services in Class 36 (first use in commerce December 6, 2002) (Sec. 2(f));
- VALERO, U.S. Reg. No. 2560091, applied for May 8, 2000, and registered on April 9, 2002, for retail store services in Class 35 (first use in commerce June 15, 2000) (Sec. 2(f));
- VALERO, U.S. Reg. No. 2656971, applied for June 2, 2000, and registered on December 3, 2002, for convenience store services in Class 35, automobile service station and car wash services in Class 37 (first use in commerce August 15, 2000);
- VALERO (and design), U.S. Reg. No. 2656973, applied for June 7, 2000, and registered on December 3, 2002, for convenience store services and Automobile service station and car wash services in Classes 35 and 37 (first use in commerce August 15, 2000);
- VALERO (and design), U.S. Reg. No. 3688322, applied for August 25, 2008, and registered on September 29, 2009, for chemical process services in Class 40 (first use in commerce September 1, 2005);
- VALERO (and design), U.S. Reg. No. 2938790, applied for October 31, 2002, and registered on April 5, 2005, for credit card services in Class 36 (first use in commerce December 6, 2002); and
- VALERO (and design), U.S. Reg. No. 2927757, applied for March 14, 2003, and registered on February 22, 2005, for gasoline, diesel fuel and lubricant oils in Class 4 (first use in commerce August 15, 2000).

The disputed domain name was registered on January 10, 2022. The disputed domain name has been used to send fraudulent emails.

5. Parties' Contentions

A. Complainant

The Complainant submits that the disputed domain name is confusingly similar to the Complainant's VALERO mark in its entirety, notwithstanding the inclusion of the letter "z" together with the generic Top-Level Domain ("gTLD") extension ".com". The Complainant explains that when analyzing identity or confusing similarity the ".com" extension is not considered because while a necessary component of the disputed domain name it does not communicate distinctiveness. The Complainant maintains that the

VALERO mark is clearly recognizable in the disputed domain name, thus concludes that the disputed domain name is confusingly similar to the Complainant's mark under the Policy.

The Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name. According to the Complainant, the Respondent has not been licensed, authorized or otherwise given permission to use or register the VALERO mark, has not been commonly known by the disputed domain name, and has neither used nor made demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services.

The Complainant considers that the Respondent has registered a domain name that prevents the Complainant from registering a domain name that embodies the VALERO mark owned by the Complainant.

According to the Complainant, the Respondent has used the disputed domain name in an unlawful attempt to impersonate one of the Complainant's employees, by way of an email scam. The Complainant argues that the disputed domain name was registered and is being used in bad faith since the same was used for the purpose of an unlawful and fraudulent email scam to elicit a third party into transferring funds.

According to evidence provided by the Complainant, the disputed domain name does not resolve to any active website, but it has been documented that it was used for a fraudulent email scam.

B. Respondent

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

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied:

- (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.

Considering these requirements, the Panel rules as follows:

A. Identical or Confusingly Similar

The Panel finds that the disputed domain name is confusingly similar to the Complainant's trademarks. The Respondent's incorporation of the Complainant's trademark VALERO in full in the disputed domain name is evidence that the disputed domain name is confusingly similar to the Complainant's marks. Mere addition of the letter "z" in the disputed domain name does not prevent a finding of confusing similarity with the Complainant's marks. Furthermore, the addition of the gTLD ".com" is disregarded under the first element confusing similarity test.

The Panel is satisfied that the disputed domain name is confusingly similar to the Complainant's mark and the Complainant has satisfied the requirement of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant must prove that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

The Complainant argues that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

The Complainant bears the burden of proof in establishing this requirement. In view of the difficulties inherent in proving a negative and because the relevant information is mainly in the possession of the Respondent, it is enough for the Complainant to establish a *prima facie* case which, if not rebutted by sufficient evidence from the Respondent will lead to this ground being set forth.

Refraining from submitting any Response, the Respondent has brought to the Panel's attention no circumstances from which the Panel could infer that the Respondent has rights or legitimate interests in the disputed domain name.

The Panel will now examine the Complainant's arguments regarding the absence of rights or legitimate interests of the Respondent in connection with the disputed domain name.

The Complainant claims that the Respondent has no connection or affiliation with the Complainant and has not received any license or consent, express or implied, to use the Complainant's trademarks in a domain name or in any other manner.

The Respondent did not submit a Response or attempt to demonstrate any rights or legitimate interests in the disputed domain name, and the Panel draws inferences from this failure, where appropriate, in accordance with the Rules, paragraph 14(b).

The Panel finds the Respondent has no rights or legitimate interests in respect of the disputed domain name and that paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy stipulates that any of the following circumstances, *inter alia*, shall be considered as evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that the respondent registered or 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 the respondent's documented out-of-pocket costs directly related to the domain name; or
- (ii) circumstances indicating that the respondent 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 the respondent has engaged in a pattern of such conduct; or
- (iii) circumstances indicating that the respondent registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) circumstances indicating that the respondent is using the domain name to intentionally attempt to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on its website or location.

With regard to the bad faith at the time of registration, the Panel notes that it is not likely that the Respondent was not aware of the Complainant and its VALERO trademark. On the contrary, the Panel finds that it is likely that the Respondent was aware of the Complainant and its rights and reputation in the VALERO mark at the time the disputed domain name was registered. Bad faith can be presumed based on the widely evidenced recognition of the Complainant's marks, such that the Respondent was aware or should have been aware of the Complainant's well-known marks and claims of rights thereto.

It should also be bear in mind that the fraudulent manner in which the disputed domain name was used indicates that the Respondent registered the disputed domain name with the intention to impersonate the Complainant, which makes it virtually impossible that it was not aware of the Complainant's rights at the time of registration.

The disputed domain name does not resolve to any active website. However, based on the evidence provided by the Complainant, the disputed domain name was still actively used for email services, *i.e.* for sending emails which impersonate the Complainant's officer. Moreover, the Respondent's fraudulent emails included the VALERO trademark, and some of the details on the Complainant's employee whose identity was used for this fraud. Such use of the disputed domain name can only be observed as clear evidence of the Respondent's bad faith (see, in particular, sections 3.1.4 and 3.4 of [WIPO Overview 3.0](#)).

Considering all of the above circumstances, the Panel concludes that the Respondent has used the disputed domain name in an unlawful attempt to impersonate the identity of a Complainant's employee, by way of an email scam. This clearly constitutes evidence of bad faith registration and use.

The Panel concludes that the disputed domain name was registered and is being used in bad faith and that consequently, the Complainant has satisfied the requirement 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 <valeroz.com> be transferred to the Complainant.

/Daniel Peña/

Daniel Peña

Sole Panelist

Date: March 22, 2022