

ADMINISTRATIVE PANEL DECISION

TotalEnergies SE v. Bush Morgan, Bushmorgan Global Resources
Case No. DCC2022-0003

1. The Parties

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

The Respondent is Bush Morgan, Bushmorgan Global Resources, Nigeria.

2. The Domain Name and Registrar

The disputed domain name <totalenergies.cc> (the “Domain Name”) is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 3, 2022. On the same date, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. Also on March 3, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on March 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 March 9, 2022.

The Center verified that the Complaint together with the amended Complaint (together, the “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 March 11, 2022. In accordance with the Rules, paragraph 5, the due date for the Response was March 31, 2022. The Respondent did not submit any Response. Accordingly, the Center notified the Respondent’s default on April 1, 2022.

The Center appointed D. Brian King as the sole panelist in this matter on April 6, 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

A. The Parties

The Complainant is TotalEnergies SE (“TotalEnergies”), a French energy company that produces and sells energy products globally, including oil, natural gas, renewables, and electricity. The Complainant was originally founded under the name Compagnie Française des Pétroles in 1924. It has changed its legal name several times, including to TOTAL-Compagnie française des pétroles on June 21, 1985; to TOTAL on June 26, 1991; and most recently to TotalEnergies on May 28, 2021 (Annex 6 to the Complaint). According to the Complainant, it operates in more than 130 countries as part of a larger group.

The Respondent has not provided the Panel with any information on his history or activities.

B. The Mark

The Complainant owns numerous trademarks for TOTAL and TOTALENERGIES (with and without the separating space) including several filed and accepted for publication in Nigeria, where the Respondent is based (Annexes 10-1 and 10-2 to the Complaint). Representative examples follow:

Trademark	Jurisdiction	Registration Number	Registration Date
TOTAL	France	1540708	December 5, 1988
TOTAL	Australia	257695	December 19, 1957
TOTAL	International	813234	September 2, 2003
TOTALENERGIES	France	4727686	February 1, 2021
TOTAL ENERGIES	Nigeria	F/TM/O/2021/26759	May 20, 2021
TOTAL ENERGIES	European Union	018308753	May 28, 2021
TOTALENERGIES	International	1601110	September 2, 2021

The Complainant claims to own over 400 domain names incorporating the more recent TOTALENERGIES mark. These include <totalenergies.com>, registered on September 17, 2020 (Annex 7-1 to the Complaint); <totalenergies.com.au>, registered on February 1, 2021 (Annex 7-2 to the Complaint); and <totalenergies.ng>, registered using the Nigerian country code top-level domain (“ccTLD”) on February 11, 2021 (Annex 9-1 to the Complaint).

C. The Domain Name

The Domain Name was registered on January 9, 2022 (Annex 1 to the Complaint). The Complaint contains evidence that the Respondent has sent emails impersonating one of the Complainant’s employees using the Domain Name’s email server (Annex 11 to the Complaint).

5. Parties' Contentions

A. Complainant

The Complainant first argues that the Domain Name is confusingly similar to its TOTAL and TOTALENERGIES marks. The Complainant's primary contention is that the Domain Name entirely incorporates its TOTALENERGIES mark, which it registered as a trademark and used in commerce before the Respondent registered the Domain Name. The Complainant argues that the incorporation of its trademark is sufficient to establish confusing similarity. The addition of a top-level domain ("TLD") does not, the Complainant contends, distinguish the Domain Name from the Complainant's mark. Furthermore, the Complainant notes that in this case the ccTLD attached to the Domain Name (".cc") designates the Keeling Islands, an Australian territory, and the Complainant notes that it has maintained a presence in Australia for over 50 years (Annex 7 to the Complaint).

The Complainant next argues that the Respondent has no rights or legitimate interests in respect of the Domain Name. The Complainant first asserts that the Respondent has no rights to the TOTALENERGIES mark and is not known by a name corresponding to the Domain Name. Additionally, the Complainant submits that it has not authorized the Respondent to use the TOTAL or TOTALENERGIES marks in any way. The Complainant further contends that the Respondent has used the Domain Name to send communications fraudulently impersonating one of the Complainant's employees.

Finally, the Complainant argues that the Domain Name was registered and is being used in bad faith. The Complainant first submits that the Respondent demonstrated bad faith by registering a domain name that was confusingly similar to trademarks in which it had no rights or legitimate interests. Further, the Complainant submits that it is highly unlikely that the Respondent would have registered the Domain Name without prior knowledge of the Complainant's rights in the TOTAL and TOTALENERGIES marks, because of the brand's fame. The Complainant also contends that by using the Domain Name to send emails impersonating an employee of the Complainant, the Respondent is engaging in a phishing scam that may damage the Complainant's reputation. This behavior, the Complainant submits, demonstrates that the Respondent hopes to use the confusing similarity of the Domain Name to the Complainant's marks for financial gain. Additionally, the Complainant notes that, as of March 4, 2022, the Respondent owned two Domain Names that corresponded to American companies in the agriculture sector (Annex 13 to the Complaint). The Complainant contends that it is highly unlikely that these companies have any link to the Complainant and thus argues that this behavior suggests a pattern of bad faith registration and use on the part of the Respondent.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy stipulates that the Complainant must prove the following three elements in order to be successful in its action:

- (i) the Domain Name is identical or confusingly similar to trademarks or service marks in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

Paragraph 4(c) of the Policy sets out illustrative circumstances that could demonstrate a respondent's rights or legitimate interests in a domain name for purposes of paragraph 4(a)(ii) above.

Paragraph 4(b) of the Policy sets out illustrative circumstances that may demonstrate registration and use of a domain name in bad faith for purposes of paragraph 4(a)(iii) above.

A. Identical or Confusingly Similar

The Domain Name entirely incorporates the Complainant's TOTALENERGIES mark, appending to it the ".cc" ccTLD. It likewise wholly incorporates the Complainant's earlier TOTAL mark. It is well established that the addition of a TLD is disregarded under the first element of the confusing similarity test, and that appending a term to a mark likewise does not eliminate confusing similarity. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), sections 1.8 and 1.11.

Applying these principles, the Panel has no difficulty in finding that the Domain Name is confusingly similar to the Complainant's TOTALENERGIES and TOTAL marks.

B. Rights or Legitimate Interests

Many prior UDRP panels have found that a complainant only needs to establish a *prima facie* case in relation to the second element of the test under paragraph 4(a)(ii) of the Policy (see, e.g., *Belupo d.d. v. WACHEM d.o.o.*, WIPO Case No. [D2004-0110](#); *MatchNet plc v. MAC Trading*, WIPO Case No. [D2000-0205](#)). Once a *prima facie* showing is made, the burden of production shifts to the respondent to demonstrate that it possesses rights or legitimate interests in respect of the domain name in dispute.

The Panel agrees that the Complainant only needs to make out a *prima facie* case and finds that it has met that standard here. In light of the evidence presented with the Complaint, the Panel finds credible and accepts the Complainant's representation that the Respondent has no connection to the Complainant and has not received permission to use the Complainant's widely recognized TOTALENERGIES or TOTAL marks. The Panel also finds no indication that the Respondent is commonly known by a name corresponding to the Domain Name.

In these circumstances, the Complainant has made out a *prima facie* case that the Respondent lacks any rights or legitimate interests in the Domain Name. The Respondent has failed to provide any contrary evidence despite having had the opportunity to do so. Furthermore, as found below, the Respondent has used the Domain Name in furtherance of a fraudulent email scheme, which can never confer rights or legitimate interests upon a respondent. See [WIPO Overview 3.0](#), section 2.13. The Panel accordingly finds that the Complaint succeeds as to the second element of the test under paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

The third element of the test under paragraph 4(a) of the Policy requires proof that the Domain Name has been registered and is being used in bad faith. The Panel finds that to be sufficiently established here.

The Panel has already found above that the Domain Name is confusingly similar to the Complainant's marks. Noting in particular the Respondent's attempt to impersonate one of the Complainant's employees, the Panel finds it likely that the Respondent had the Complainant and its marks in mind when registering the confusingly similar Domain Name. Furthermore, the Respondent's use of the Domain Name to transmit emails impersonating one of the Complainant's employees establishes, on a balance of the probabilities, an attempt to perpetrate a phishing scam. The use of a domain name for *per se* illegitimate activities such as this constitutes manifest evidence of bad faith registration and use. See [WIPO Overview 3.0](#), section 3.1.4.

On these grounds, the Panel finds that the Complaint succeeds as to the third element of paragraph 4(a) of the Policy. The registration and use of a domain name confusingly similar to a famous mark, as the Respondent has done here, can by itself create a presumption of bad faith. The evidence of fraudulent activity by the Respondent serves to confirm it.

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 Domain Name, <totalenergies.cc>, be transferred to the Complainant.

/D. Brian King/

D. Brian King

Sole Panelist

Date: April 20, 2022