

ADMINISTRATIVE PANEL DECISION

Valero Energy Corporation, Valero Marketing and Supply Company v. Na Lendorff

Case No. DME2022-0002

1. The Parties

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

The Respondent is Na Lendorff, United States.

2. The Domain Name and Registrar

The disputed domain name <valeroenergy.me> (“Disputed Domain Name”) is registered with Dynadot, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 21, 2022. On March 22, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On March 23, 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 March 25, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Center received two email communications from the Respondent on March 26 and March 29, 2022. The Complainant filed an amended Complaint on March 28, 2022.

The Center verified that the Complaint together with the amendment to 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 30, 2022. In accordance with the Rules, paragraph 5, the due date for Response was April 19, 2022. The Respondent did not submit any formal response. Accordingly, the Center notified the commencement of Panel appointment process on April 20, 2022.

The Center appointed Colin T. O'Brien as the sole panelist in this matter on May 13, 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 Complainant, international manufacturer and marketer of transportation fuels, other petrochemical products, and power, has continuously used the VALERO mark in commerce for at least 39 years and owns the following United States trademark registrations:

- VALERO for "oil and gas exploration production, processing, and distribution services" in Class 42, Reg. No. 1,314,004, Registered January, 1985;
- VALERO for "retail store services featuring convenience store items, food products, toiletries, fuels, and lubricants" in Class 35, Reg. No. 2,560,091, Registered April 2002;
- VALERO for "convenience store services; automobile service station services and car wash services" in Classes 35 and 37, Reg. No. 2,656,971, Registered December, 2002;
- VALERO V for "convenience store services; automobile service station services and;car wash services" in Classes 35 and 37, Reg. No. 2,656,973, Registered December 2002;
- V VALERO for "chemical processing services, namely, processing of petroleum feedstocks and chemicals, namely, mixed xylenes, benzene, toluene, propylene; petroleum refining; production of lubricant basestocks for others" in Class 40, Reg. No. 3,688,322, Registered September 2009;
- V VALERO for "credit card services" in Class 36, Reg. No. 2,938,790, Registered April 2005;
- VALERO for "credit card services" in Class 36, Reg. No. 4,216,650, Registered October 2012;
- V VALERO for "gasoline and diesel fuel; lubricant base oil" in Class 4, Reg. No. 2,927,757, Registered February, 2005; and
- VALERO for "retail store services featuring gasoline and diesel fuel and convenience store items" in Class 35, Reg. No. 3,108,715, Registered June 2006. ("VALERO Trademarks")

The Disputed Domain Name was registered on February 13, 2022. The Disputed Domain Name resolves to a website in Turkish language that features, among other things, photographs of the Complainant's signage at its headquarters in San Antonio, Texas along with a map to the location of the Complainant's headquarters. At the time of decision, the Disputed Domain Name is inactive.

5. Parties' Contentions

A. Complainant

The Complainant's significant monetary investment and continuous use of the VALERO Trademarks to advertise, market and promote the VALERO brand over more than three decades, the VALERO Trademarks have developed extensive goodwill and favorable consumer recognition.

The Complainant has continuously owned and operated an Internet website under the domain name <valero.com> for many years, and utilizes that domain name for company email addresses through which it communicates internally, with customers, vendors, and the public in general.

The Disputed Domain Name is confusingly similar to the VALERO Trademarks owned by the Complainant because it is comprised of the Complainant's VALERO mark in its entirety, plus the generic term "energy", along with the country code Top-Level Domain "ccTLD") ".me".

The Respondent has no rights or legitimate interests in or to the Disputed Domain Name. The Respondent has never been commonly known by the Disputed Domain Name; has not used or made demonstrable preparations to use the Disputed Domain Name; and is not making a legitimate noncommercial or fair use of the Disputed Domain Name without intent for commercial gain. The Complainant has not licensed to the Respondent the right to use the VALERO mark, and the Respondent is not otherwise authorized to act on the Complainant's behalf.

On March 18, 2022, the Complainant received an odd email that reads as follows:

"hello, Hope you're doing good. I'm here, to inform you, that we made a duplicate of your brand, we're using your name. actually we're investing platform.

now our client ratio is increased so I decided to update you that, please do not report my site.

either I'm gonna loss 50 Million lira, if you need share of it. let me know, but please don't block it"

The signature block contained a link to the Disputed Domain Name along with links to two different Telegram groups. One of the Telegram groups purports to have 7,700 members who are engaged in a variety of commercial and political activity with the Respondent using the Complainant's Trademarks without the Complainant's knowledge or consent.

The Complainant is a frequent target of fraudsters and criminals seeking to capitalize on its well-known brand by registering domain names that embody its trademarks, then using those domains to send phishing emails to unsuspecting third parties. In this instance, the landing page for the Disputed Domain Name is the same landing page used by the Respondent in another pending WIPO proceeding involving the domain name <valeroenergy.xyz>. As in the <valeroenergy.xyz> matter, the Respondent has published and is operating a website under the Disputed Domain Name in which it attempts to portray itself as part of the Valero organization. The textual content on the website is in the Turkish language, and features photographs of the Complainant's signage at its headquarters in San Antonio, Texas along with a map to the location of the Complainant's headquarters. It appears from the content on the site that the Respondent "offers" goods and services that purport to come from Valero and may do so in an attempt to deceive unsuspecting third parties into paying the Respondent money for goods and services that the Respondent does not, and cannot, offer for sale under the VALERO Trademarks.

The Complainant has owned and continually used the VALERO mark in commerce for more than 39 years. At the time the Disputed Domain Name was registered, the Complainant was listed as the 32nd largest company in the United States according to Fortune magazine, thus the Respondent was aware of the Complainant's prominence in the business world when it registered the Disputed Domain Name.

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.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant has demonstrated it owns registered trademark rights in the VALERO trademark in the United States. The addition of the term "energy" does not prevent a finding of confusing similarity. See section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions Third Edition

(“[WIPO Overview 3.0](#)”).

Accordingly, the Disputed Domain Name is confusingly similar to a mark in which the Complainant has rights.

B. Rights or Legitimate Interests

The Complainant has presented a *prima facie* case that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name and has not been commonly known by the Disputed Domain Name. The fact that the Respondent obtained the Disputed Domain Name over 39 years after the Complainant had begun using its famous VALERO mark indicates that the Respondent sought to piggy-back on the VALERO mark for nefarious purposes.

After a complainant has made a *prima facie* case, the burden of production shifts to the respondent to present evidence demonstrating rights or legitimate interests in the domain name. See, e.g., *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#).

Here, the Respondent has provided no evidence of any rights or legitimate interests in the Disputed Domain Name; rather, the evidence suggests that it was either registered to make an undue profit based on the Complainant’s rights (See, e.g., *Bottega Veneta SA v. ZhaoJiafei*, WIPO Case No. [D2013-1556](#)).

In the absence of any evidence rebutting the Complainant’s *prima facie* case indicating the Respondent’s lack of rights or legitimate interests in respect of the Disputed Domain Name, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Disputed Domain Name was registered many years after the Complainant first registered and used its famous VALERO mark. The evidence provided by the Complainant makes it clear the Respondent undoubtedly knew of the Complainant’s VALERO mark and knew that it had no rights or legitimate interests in the Disputed Domain Name. There is no benign reason for the Respondent to have registered a domain name that is confusingly similar to the Complainant’s famous mark.

Further, the use of the Disputed Domain Name by the Respondent is clearly in bad faith. Paragraph 4(b)(iv) states that evidence of bad faith may include a respondent’s use of a domain name to intentionally attempt to attract, for commercial gain, Internet users to the respondent’s 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 the respondent’s website or location. The Complainant has submitted evidence that the Respondent brazenly reached out to the Complainant and admitted “that we made a duplicate of your brand, we’re using your name. actually we’re investing platform” possibly in an effort to sell the Disputed Domain Name to the Complainant.

Further, the Complainant submitted evidence that the Respondent has used the Disputed Domain Name to host a website in Turkish which implies that it is a website operated by the Complainant. Given the fame of the Complainant’s VALERO mark, the obvious inference is that the Respondent hoped to mislead customers of the Complainant to visit the website at the Disputed Domain Name to cull email addresses from unsuspecting user for possible phishing attempts or some other illegitimate use.

The Panel finds that the only plausible basis for registering and using the Disputed Domain Name has been for illegitimate and bad faith purposes. It is moreover noted that the related website is now inactive; while this may be due to a request by the Complainant to the hosting provider, it may equally be an attempt by the Respondent to hide its tracks; in either event, especially noting the reputation of the Complainant and the lack of a contemplated good faith use, the present non-use of the Disputed Domain Name for an active website does not in any event prevent a finding of bad faith nor does it go against any of the Panel’s above findings.

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 <valeroenergy.me> be transferred to the Complainant.

/Colin T. O'Brien/

Colin T. O'Brien

Sole Panelist

Date: May 27, 2022