

## **ADMINISTRATIVE PANEL DECISION**

Valero Energy Corporation and Valero Marketing and Supply Company v.  
Eneh Sumadina  
Case No. D2024-2512

### **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 "Complainant").

The Respondent is Eneh Sumadina, Afghanistan.

### **2. The Domain Name and Registrar**

The disputed domain name <valero-energyies.energy> is registered with Hostinger Operations, UAB (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on June 19, 2024. On June 20, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 21, 2024, 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) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 21, 2024, 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 June 21, 2024.

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 July 3, 2024. In accordance with the Rules, paragraph 5, the due date for Response was July 23, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on July 24, 2024.

The Center appointed Peter Burgstaller as the sole panelist in this matter on August 2, 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 Complainant operates in the field of oil and gas exploration, production, processing, and distribution services. It owns and has rights in several United States trademark registrations containing the term VALERO, *inter alia*:

- United States Trademark Registration (word) No. 4,216,650, registered October 2, 2012;
- United States Trademark Registration (word) No. 1,314,004, registered January 8, 1985; and
- United States Trademark Registration (figurative) No. 3,688,322, registered September 29, 2009 (Annex 4 to the Complaint).

The Complainant further owns the domain name <valero.com> which addresses its official website and which contains information about VALERO products and services.

The disputed domain name was registered on April 16, 2024. At the time of filing the Complaint, the disputed domain name was used as email address and resolved to a website which provided information about the Complainant and displayed the VALERO trademark (Annexes 5 and 6 to the Complaint).

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that the VALERO trademark is distinctive and well-known and notes that the disputed domain name contains the VALERO trademark in its entirety, simply adding the descriptive term "energyies" which appears to be a misspelling of the generic word "energies", along with the generic Top-Level Domain ("gTLD") ".energy".

The Complainant submits that it is inconceivable that the Respondent would not have been aware of the Complainant's trademark when registering the disputed domain name, since the disputed domain name resolved to a website containing the VALERO logo and information about the Complainant's products and services; furthermore, the Respondent used the disputed domain name as email address to mislead others.

Therefore, the Complainant notes that the disputed domain name is not used for a bona fide offering of goods or services - it is to the contrary: the Respondent's website is a scam, posing to be affiliated with the Complainant and aiming to mislead Internet users.

Regardless of the true identity of the Respondent, the Complainant has at no time authorized the registration of the disputed domain name containing its trademark and / or the use of its trademarks on the corresponding website.

Hence, the Respondent may have registered or acquired the disputed domain name primarily for scamming purposes to illegally impersonate the Complainant for commercial gain by deceiving unwitting third parties into believing that the Respondent is in some way connected with the Complainant or is the Complainant, which is not the case.

## **B. Respondent**

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

## **6. Discussion and Findings**

According to paragraph 4(a) of the Policy, the Complainant must prove that:

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

### **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 the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of the mark VALERO for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

In the present case, the disputed domain name is confusingly similar to the VALERO mark in which the Complainant has rights since it incorporates the entirety of the mark VALERO and only adds the word "energyies" which appears to be a misspelling of the generic word "energies".

It has long been established under UDRP decisions that where the relevant trademark is recognizable within the disputed domain name, the mere addition of other terms does not prevent a finding of confusing similarity under the first element of the Policy ([WIPO Overview 3.0](#), section 1.8). This is the case at present.

Finally, it has also long been held that gTLDs (in this case ".energy") are generally disregarded when evaluating the confusing similarity of a disputed domain name. [WIPO Overview 3.0](#), section 1.11.1.

Based on the available record, 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 the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

While 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 often impossible 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. 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.

Having reviewed the record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name.

The Complainant focuses on the fact that its trademark is distinctive and well known and provides suitable evidence of its reputation, adding that it is inconceivable that the Respondent would not have been aware of this when registering the disputed domain name.

The Complainant also notes that the disputed domain name is not being used to provide good faith goods or services via a website, but the Respondent has instead registered and used it for scamming purposes to illegally impersonate the Complainant to gain commercial gain by deceiving unwitting third parties into believing that the Respondent is the Complainant or is connected to the Complainant. Such conduct amounts to fraud. [WIPO Overview 3.0](#), section 2.5.

The Respondent did not reply to the Complainant's contentions and hence has not rebutted the Complainant's *prima facie* showing.

The Panel further notes that the composition of the disputed domain name carries a risk of implied affiliation with the Complainant. [WIPO Overview 3.0](#), section 2.5.1.

Based on the available record, the Panel finds the second element of the Policy has been established.

### **C. Registered and Used in Bad Faith**

As stated in paragraph 4(a)(iii) of the Policy, the Complainant must show registration and use of the disputed domain name in bad faith. These are concurrent requirements.

The Panel notes that paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In regard to the registration of the disputed domain name, the Panel notes that the Complainant has rights and is the owner of the registered trademark VALERO, which is registered and used in business long before the disputed domain name was registered. Moreover, the Complainant's domain name <valero.com> is used to address the official VALERO-website, for many years and long before the registration of the disputed domain name.

It is inconceivable for this Panel that the Respondent registered the disputed domain name without knowledge of the Complainant's rights, which leads to the necessary inference of bad faith. [WIPO Overview 3.0](#), section 3.2.2.

This finding is supported by the fact that the disputed domain name incorporates the Complainant's distinctive trademark VALERO entirely together with the term "energyies" under the gTLD ".energy", which indicates that the Respondent was aware of the Complainant, its business, and its VALERO mark at the time of registration of the disputed domain name.

Therefore, the Panel is convinced that the disputed domain name was registered in bad faith by the Respondent.

The disputed domain name is also being used in bad faith, putting emphasis on the following:

- the disputed domain name resolved to a website containing the Complainant's VALERO mark and information about the Complainant; and
- the disputed domain name was used as email address with the intention of deceiving others.

Hence, the disputed domain name was used for scamming purposes to illegally impersonate the Complainant likely for a commercial gain by deceiving unwitting third parties into believing that the Respondent is in some way connected with the Complainant or is the Complainant, which is not the case.

This clearly constitutes bad faith by willfully misleading and intentionally deceiving Internet users by pretending a false identity in order to likely gain financial advantage and thus an intentional attempt to commit fraud. This fraudulent and deceptive scheme undoubtedly represents bad faith use of the disputed domain name.

Based on the available record, the Panel finds the third element of the Policy has been established.

## **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 <valero-energyies.energy> be transferred to the Complainant.

*/Peter Burgstaller/*

**Peter Burgstaller**

Sole Panelist

Date: August 13, 2024