

ADMINISTRATIVE PANEL DECISION

Equinor ASA v. Marcos Cohen
Case No. D2022-3956

1. The Parties

The Complainant is Equinor ASA, Norway, represented by Valea AB, Sweden.

The Respondent is Marcos Cohen, Italy.

2. The Domain Name and Registrar

The disputed domain name <equinor-office.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 21, 2022. On the same day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. Also on October 21, 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 (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint.

The Center sent an email communication to the Complainant on October 25, 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 amendment to the Complaint on October 27, 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 October 27, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 16, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 17, 2022.

The Center appointed Fabrice Bircker as the sole panelist in this matter on November 24, 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, Equinor ASA, is a Norwegian energy company operating since the 1960s, and currently active in more than 30 countries.

The Complainant was formerly known as Statoil ASA and has adopted its current name on March 15, 2018.

Its activities are protected through many trademarks, such as:

- EQUINOR, European Union Trademark No. 17900772, filed on May 15, 2018, registered on January 18, 2019, and designating products and services of classes 1, 2, 4, 6, 7, 9, 16, 17, 19, 25, 28, 35, 36, 37, 39, 40, 41 and 42:
- EQUINOR, International trademark registration No. 1444675 in classes 1, 2, 4, 6, 7, 9, 16, 17, 19, 25, 28, 35, 36, 37, 39, 40, 41 and 42, registered on July 4, 2018, and notably protected in Australia, Colombia, India, Singapore, and Japan.

The Complainant has also an online presence, in particular through a large domain names portfolio constituted with domain names reflecting its trademark, such as <equinor.com>, registered on June 15, 2011 and which redirects to its official website.

The disputed domain name, <equinor-office.com>, was registered on May 23, 2022. It resolves to a website displaying sponsored links, and 10 mail exchange (MX) records are configured with it.

5. Parties' Contentions

A. Complainant

The Complainant requests the transfer in its benefit of the disputed domain name. Its main arguments can be summarized as follows:

Identical or Confusingly Similar:

The Complainant contends that the disputed domain name is confusingly similar to its EQUINOR trademark because it incorporates said trademark in its entirety and the latter remains recognizable within it.

Rights or Legitimate Interests:

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

It adds that the Respondent is not affiliated or related to it in any way, or licensed or otherwise authorized to use the EQUINOR trademark in connection with a website, a domain name or for any other purpose.

The Complainant also puts forward that the Respondent i) is not using the disputed domain name in connection with any legitimate non-commercial or fair use without intent for commercial gain, ii) is not generally known under the disputed domain name and iii) has not acquired any relevant trademark rights.

The Complainant further submits that the Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods or services.

Registered and Used in Bad Faith:

The Complainant considers that it is apparent from the composition of the disputed domain name, in as far as it contains the EQUINOR trademark, that the Respondent is fully aware that the disputed domain name incorporates a well-recognized and distinctive trademark in which it has absolutely no prior rights.

The Complainant adds that as the registration of the disputed domain name took place more than four years after it announced its name change to EQUINOR, the Respondent could not have chosen or subsequently used the word "Equinor" for any reasons other than to take unfair advantage of the reputation of the Complainant's famous trademark.

Then the Complainant contends that as the disputed domain name redirects to a website displaying Pay-Per-Click ("PPC") links, this must be understood as an attempt to profit of the registered trademark EQUINOR by attracting Internet users to the disputed domain name, what establishes bad faith use.

The Complainant also considers that the use of a privacy or proxy service which is known to block or intentionally delay disclosure of the identity of the actual registrant is often considered as an indication of bad faith.

The Complainant also submits that MX records are activated for the disputed domain name. Although the Complainant is not aware of any phishing email being sent from the disputed domain name, it considers that it cannot be ruled out that the Respondent has had the intention to send out emails when registering the disputed domain name, as the reason for setting up MX records is, precisely, to receive and send emails. The Complainant is of the opinion that this does create a likelihood of confusion with its trademark and the people who are managing the company and their reputation, which further supports a finding of bad faith.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that for obtaining the transfer or the cancellation of the disputed domain name, the Complainant must establish each of the following three elements:

- (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 in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

Besides, paragraph 15(a) of the Rules provides that "[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

Paragraphs 10(b) and 10(d) of the Rules also provide that "[i]n all cases, the Panel shall ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case" and that "[t]he Panel shall determine the admissibility, relevance, materiality and weight of the evidence".

Besides, the Respondent's failure to reply to the Complainant's contentions does not automatically result in a decision in favor of the Complainant, although the Panel is entitled to draw appropriate inferences therefrom, in accordance with paragraph 14(b) of the Rules (see section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Taking the foregoing provisions into consideration the Panel finds as follows.

A. Identical or Confusingly Similar

Pursuant to paragraph 4(a)(i) of the Policy, the Complainant must first establish rights in a trademark or service mark and secondly establish that the disputed domain name is identical or confusingly similar to its trademark.

It results from the documents supporting the Complaint, and in particular from Annex F, that the Complainant is the owner of trademark registrations for EQUINOR, such as those detailed in section 4 above.

Turning to whether the disputed domain name is identical or confusingly similar to the Complainant's trademark, as indicated in [WIPO Overview 3.0](#), section 1.7, "[w]hile each case is judged on its own merits, in cases where a domain name incorporates the entirety of a trade mark (...), the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing".

This test is satisfied here, as the disputed domain name, <equinor-office.com>, identically reproduces the EQUINOR trademark, and because the added element, namely "office", consists of a mere dictionary term, which does not prevent the Complainant's trademark to remain recognizable, all the more that it is separated from the EQUINOR trademark by an hyphen. Indeed, there is a consensus view among UDRP panels that where the relevant trademark is recognizable within the disputed domain name, the addition of other terms would not prevent a finding of confusing similarity under the first element of the Policy (see [WIPO Overview 3.0](#), section 1.8; *Kabbage, Inc. v. Name Redacted*, WIPO Case No. [D2020-0140](#)). Besides, the generic Top-Level-Domain (gTLD) ".com" may be ignored for the purpose of assessing the confusing similarity, because it only plays a technical function.

Consequently, the first element under the Policy set for by paragraph 4(a)(i) is fulfilled.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets out the following circumstances which, without limitation, if found by the Panel, shall demonstrate that the Respondent has rights to, or legitimate interests in, a disputed domain name, for the purposes of paragraph 4(a)(ii) of the Policy:

- (i) before any notice to [the Respondent], [the Respondent's] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a *bona fide* offering of goods or services; or
- (ii) [the respondent] (as an individual, business, or other organization) [has] been commonly known by the [disputed] domain name, even if [the respondent has] acquired no trademark or service mark rights; or
- (iii) [the respondent is] making a legitimate noncommercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

While the overall burden of proof in UDRP proceedings is on the complainant, UDRP 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 (see [WIPO Overview 3.0](#), section 2.1).

In the present procedure, the Complainant asserts that it has not given its consent for the Respondent to use its EQUINOR trademark in domain name registration or in any other manner.

Besides, there is nothing in the record of the case likely to indicate that the Respondent may be commonly known by the disputed domain name.

Furthermore, the disputed domain name incorporates an intrinsically distinctive and well-known trademark (see Paragraph C. below) and resolves to a parking page displaying sponsored links. It is consistent case-law that such a commercial use that unduly capitalizes on the value of a third party's trademark, cannot create rights or legitimate interests in the disputed domain name for the purposes of the Policy (see [WIPO Overview 3.0](#), section 2.9, and *Payoneer, Inc. v. Jurgen Neeme*, WIPO Case No. [D2020-0137](#)).

In view of all the above, the Panel finds that the Complainant has discharged its burden of proof that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

The burden of production now shifts to the Respondent to show that it does have some rights or legitimate interests.

The Respondent, which has not replied to the Complainant's contentions, has not come forward with any explanation that demonstrates any rights or legitimate interests in the disputed domain name.

Accordingly, the Panel finds that the Complainant has established the second element under paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy provides that the Complainant must establish that the Respondent registered and is using the disputed domain name in bad faith.

Registration in Bad Faith:

In the present case, the Panel notes that:

- the EQUINOR trademark predates the registration of the disputed domain name by several years,
- the EQUINOR trademark is intrinsically distinctive,
- many UDRP panels have considered the EQUINOR trademark as being well-known (e.g. *Equinor ASA v. zenoforex macaulay*, *TECHNOCREATIVITY*, and *zenoforex17591 mark*, *TECHNOCREATIVITY*, WIPO Case No. [D2022-2088](#); *Equinor ASA v. Domain Administrator*, See *PrivacyGuardian.org / Eldon Adams, EldonLeaf Inc*, WIPO Case No. [D2022-0279](#); and *Equinor ASA v. WhoisGuard Protected, WhoisGuard, Inc. / Jenc Mazc*, WIPO Case No. [D2021-0084](#)).

In these circumstances, it is more than likely that the Respondent was aware of the Complainant's rights when it registered the disputed domain name.

Besides, the Panel considers that further evidence of the Respondent's bad faith registration can be inferred from the obvious inaccurate contact details provided for filling-in the *WhoIs* database (they mix a German street, a location in Italy, and an American phone number).

Use in Bad Faith:

The Panel finds that:

- the disputed domain name reproduces the Complainant's distinctive and well-recognized trademark, and is used for commercial gain, as it resolves to a website exclusively displaying PPC links,

- the Respondent has set up not only one, but 10 MX Records for the disputed domain name, which enables it to use said disputed domain name to receive and to send emails. Even if the case file does not contain any evidence of use of the disputed domain name for sending and receiving emails, it nevertheless remains that the mere fact to configure so many MX Records reveals at least a genuine intent to use the disputed domain name to exchange emails. Given i) the composition of the disputed domain name, in as far it can impersonate the Complainant, ii) the clear absence of rights of the Respondent, iii) the fact that the Respondent has concealed his identity through a privacy service and communicated obvious inaccurate contact details to the Registrar, and iv) the silence kept by the Respondent while invited to participate in the proceedings, such a situation makes extremely likely that the disputed domain name may be used for fraudulent activities, such as phishing schemes impersonating the Complainant. In any case, in the above-described context, the detention of the disputed domain name in the hands of the Respondent at least represents an unbearable threat hanging on the head of the Complainant.

In the absence of any explanation from the Respondent, the Panel concludes that the Respondent's primary motive in relation to the use of the disputed domain name is to unduly capitalize on, or otherwise take fraudulent advantage of, the Complainant's trademark rights, by creating a likelihood of confusion with the latter.

As a consequence of all the above, the third element under the Policy set for by paragraph 4(a)(iii) is fulfilled.

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, <equinor-office.com> be transferred to the Complainant.

/Fabrice Bircker/

Fabrice Bircker

Sole Panelist

Date: December 6, 2022