

ADMINISTRATIVE PANEL DECISION

TotalEnergies Facilities Management Services v. Cheval Blanc Case No. D2023-0157

1. The Parties

The Complainant is TotalEnergies Facilities Management Services, France, represented by In Concreto, France.

The Respondent is Cheval Blanc, France.

2. The Domain Name and Registrar

The disputed domain name <tfms-sas.com> (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 January 12, 2023. On January 13, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On January 13, 2023, 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 (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 16, 2023 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 January 17, 2023.

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 January 19, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 8, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on February 9, 2023.

The Center appointed Vincent Denoyelle as the sole panelist in this matter on February 16, 2023. 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.

On March 14, 2023, the Panel issued Procedural Order No. 1, requiring the Complainant to provide evidence of its unregistered trade mark rights, within 5 days and granting the Respondent 5 days to provide comments, starting from the date the Complainant sent the evidence requested. On March 17, 2023, the Complainant answered Procedural Order No. 1, submitting documents to seek to demonstrate that TFMS has become a distinctive identifier which consumers associate with the Complainant's goods and/or services. The Respondent did not submit any comments.

4. Factual Background

The following facts are based on the submissions in the Complaint and the Annexes to the Complaint.

The Complainant is part of the TotalEnergies Group, a French headquartered international group of companies in the energy sector. The Complainant is specialized in facilities management services.

The Complainant has officially filed the commercial name TFMS (acronym of TotalEnergies Facilities Management Services) with the French companies register on August 4, 2016 and the Complainant is a registered company set up as a Société par Actions Simplifiée (abbreviated as "sas").

The Domain Name was registered on June 8, 2022 and does not point to any active website. The Complainant provided evidence that the Domain Name was used to send fraudulent emails impersonating the Complainant.

5. Parties' Contentions

A. Complainant

The Complainant contends that the Domain Name is confusingly similar to TFMS in which the Complainant has rights as it corresponds to the acronym of the Complainant's legal name (TotalEnergies Facilities Management Services) as well as the Complainant's exact business name which are protected under French law. The Domain Name incorporates TFMS entirely followed by an hyphen and the term "sas" which is an acronym for "Société par Actions Simplifiée", the type of corporate structure of the Complainant. The Complainant submits that such addition does not prevent the likelihood of confusion between the Domain Name and the Complainant's business name.

The Complainant asserts that the Respondent has no rights or legitimate interests in respect of the Domain Name pointing to the Complainant's use of the Domain Name to send fraudulent emails impersonating the Complainant and stating that the Complainant has not granted any authorization, license or permission to the Respondent.

The Complainant contends that the Respondent could not have been unaware of the existence of the Complainant's prior rights when registering the Domain Name given that the Domain Name reproduces the business name of the Complainant and the acronym corresponding to its type of corporate structure. The Complainant points to the use of the Domain Name to fraudulently impersonate the Complainant and one of its employees as evidence of the Respondent's bad faith in using the Domain Name. The Respondent also highlights the fact that the registrant and contact details disclosed by the Registrar for the Domain Name are incorrect.

B. Respondent

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

6. Discussion and Findings

In order to prevail the Complainant must substantiate that the three elements of paragraph 4(a) of the Policy have been met, namely:

- (i) the Domain Name is identical or confusingly similar to a trade mark or service mark 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.

In the case of default by a party, as is the case here, paragraph 14(b) of the Rules makes it clear that if a party, in the absence of exceptional circumstances, does not comply with any provision of, or requirement under, the Rules or any request from the Panel, the Panel shall draw such inferences therefrom as it considers appropriate.

In the absence of a Response from the Respondent whereby the Respondent did not object to any of the contentions from the Complainant, the Panel will have to base its decision on the basis of the Complaint and supporting Annexes.

A. Identical or Confusingly Similar

Under paragraph 4(a)(i) of the Policy, the Complainant needs to demonstrate that the Domain Name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights. It is established that under the Policy, the expression "trade mark or service mark" as used in paragraph 4(a)(i) of the Policy encompasses both registered and unregistered (sometimes referred to as common law) marks (see sections 1.1.1 and 1.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Panel thus needs to determine whether there is a sufficient case to find, on balance and for the purpose of the Policy, that the Complainant has unregistered trade or service mark rights in TFMS reproduced in the Domain Name.

The Complainant has produced evidence that TFMS is legally protected in France – where both the Complainant and the Respondent are based – since 2016, as a business name and the acronym of its legal name TotalEnergies Facilities Management Services. Nevertheless, to establish registered or unregistered trade mark or service mark rights – and thus standing – for the purpose of the Policy, the Complainant must provide evidence that TFMS has become a distinctive identifier which consumers associate with the Complainant's goods and/or services.

In this respect, since the Complainant failed to provide sufficient evidence in the Complaint, the Panel issued Procedural Order No. 1 on March 14, 2023, requiring the Complainant to provide evidence of its unregistered trade or service mark rights in TFMS.

On March 17, 2023, the Complainant provided a response and evidence to seek to demonstrate that TFMS has become a distinctive identifier which the relevant consumers associate with the Complainant's goods and/or services. The evidence provided by the Complainant included screen captures of dedicated TFMS webpages on the TotalEnergies Group website including a description of the services provided under TFMS, a detailed price list for services provided by TFMS, proof of the significant turnover of the entity trading under the TFMS and two publications referring to TFMS and the services provided under that name.

The Complainant had also produced evidence in the Complaint of emails exchanged between the Respondent and a third party vendor in relation to a potential commercial transaction where the Respondent impersonated the Complainant using an email address under the Domain Name including its TFMS business name. The fact that the Respondent is shown to have passed itself off as the Complainant and to have been clearly targeting the Complainant's business name TFMS supports the Complainant's assertion that its business name TFMS has achieved some level of recognition as a source identifier for the purpose of the Policy (see *Gateway Fiber LLC v. Wix.com Ltd., Wix.com Ltd. / Ali Oudah, Ayadi Group*, WIPO Case No. [D2021-1736](#) and section 1.3 of [WIPO Overview 3.0](#)).

In light of the above, the additional evidence provided by the Complainant in response to Procedural Order No. 1 and the use by the Respondent of the Domain Name to pass itself off as the Complainant with reference to the Complainant's services and TFMS identifier, the Panel finds, on balance, that the Complainant has established unregistered trade or service mark rights in TFMS reproduced in the Domain Name for the purpose of the Policy.

The second point that has to be considered is whether the Domain Name is identical or confusingly similar to the unregistered trade mark or service mark TFMS.

At the second level, the Domain Name incorporates TFMS in its entirety with the addition of an hyphen and the term "sas" which is an acronym for "Société par Actions Simplifiée", the type of corporate structure of the Complainant. This addition does not prevent a finding of confusing similarity between the Complainant's TFMS unregistered mark and the Domain Name.

Then there is the addition of the generic Top-Level-Domain ("gTLD") ".com". As is generally accepted, the addition of a gTLD such as ".com" is merely a technical registration requirement and as such is typically disregarded under the first element of confusing similarity test.

Thus, the Panel finds that the Domain Name is confusingly similar to an unregistered trade mark or service mark in which the Complainant has rights.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets out relevant circumstances that could demonstrate that a respondent has rights or legitimate interests in a domain name, namely:

Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate [the respondent's] rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

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

Numerous previous panels have found under the UDRP that once the Complainant makes a *prima facie* showing that the Respondent does not have rights or legitimate interests in the domain name, the burden of production shifts to the Respondent to rebut the showing by providing evidence of its rights or interests in the domain name.

Having reviewed the Complainant's assertions and evidence, the Panel is satisfied that the Complainant has made a *prima facie* showing that the Respondent lacks rights or legitimate interests in the Domain Name.

The Complainant has stated that it has not licensed or otherwise authorized the Respondent to make any use of its TFMS unregistered mark.

The Panel finds that the use of the Domain Name to fraudulently impersonate the Complainant for financial gain is a clear indication of the Respondent's lack of rights or legitimate interest in the Domain Name. Indeed, as previous panels under the Policy have consistently found, such illegal use can never be considered *bona fide*, legitimate or fair under the Policy. See [WIPO Overview 3.0](#), section 2.13.1.

Furthermore, the nature of the Domain Name, comprising the Complainant's unregistered mark in its entirety in combination with an additional term corresponding to the Complainant's type of corporate structure, carries a risk of implied affiliation. See section 2.5.1 of the [WIPO Overview 3.0](#).

Thus, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy sets out a number of relevant non-exhaustive circumstances, which can be deemed to constitute evidence of registration and use of a domain name in bad faith, namely:

- (i) circumstances indicating that [the respondent has] registered or acquired [a disputed] 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 trade mark 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) [the respondent has] registered the domain name in order to prevent the owner of the trade mark 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) [the respondent has] registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, [the respondent has] intentionally attempted 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.

Given the circumstances described in the Complaint and the documentary evidence provided by the Complainant, the Panel finds that the Domain Name was registered in bad faith.

The Domain Name reproduces the exact TFMS unregistered mark of the Complainant and this cannot be a coincidence given the overall circumstances of the present case including: (i) the fact that TFMS has no generic meaning to the best of the Panel's knowledge and, (ii) the choice of term added to the TFMS unregistered mark in the Domain Name which corresponds to the acronym of the Complainant's type of corporate structure.

Thus, the Panel finds that the Domain Name was registered in bad faith.

As for use of the Domain Name in bad faith, given the circumstances described in the Complaint and the evidence provided by the Complainant, the Panel considers that the Domain Name is used in bad faith.

The use of the Domain Name to facilitate the sending of fraudulent emails impersonating the Complainant and one of its employees to deceive third party vendors for financial gain is very persuasive and clear evidence of the Respondent's bad faith use of the Domain Name.

The fact that the Respondent chose not to object to the Complainant's assertions can only reinforce the Panel's view that the Domain Name is used in bad faith.

Finally, the fact that the registrant contact details provided to the Registrar do not correspond to a genuine address, is an additional indication of the Respondent's bad faith and intent to use the Domain Name in a way which may be abusive or otherwise detrimental to the Complainant and its rights.

Thus, the Panel finds that the Domain Name has been registered and is also being used in bad faith.

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 <tfms-sas.com> be transferred to the Complainant.

/Vincent Denoyelle/

Vincent Denoyelle

Sole Panelist

Date: March 29, 2023