

## **ADMINISTRATIVE PANEL DECISION**

Industrial Oils Unlimited, L.L.C. v. RONAQ SETHI, Kp Impex  
Case No. D2023-1437

### **1. The Parties**

Complainant is Industrial Oils Unlimited, L.L.C., United States of America ("U.S."), represented by Millikin Intellectual Property Law PLLC, U.S.

Respondent is RONAQ SETHI, Kp Impex, U.S.

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

The disputed domain name <dxlubes.com> (the "Domain Name") is registered with GoDaddy.com, LLC (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on April 3, 2023. On April 4, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On April 5, 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 (Domains By Proxy, LLC) and contact information in the Complaint.

The Center sent an email to Complainant on April 5, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on the same April 5, 2023.

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 Respondent of the Complaint, and the proceedings commenced on April 6, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 26, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on April 28, 2023.

The Center appointed Robert A. Badgley as the sole panelist in this matter on May 2, 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.

#### **4. Factual Background**

Based in Tulsa, Oklahoma, Complainant manufactures, among other things, various industrial oil and lubricant products.

Complainant owns a trademark registration for the stylized mark DX, registered on September 13, 2013 with the United States Patent and Trademark Office ("USPTO"), Reg. No. 4,397,032 in connection with "industrial lubricants used by manufacturing plants and oil and gas operations...". The registration notes a date of first use in commerce of June 12, 2013.

According to Complainant, its DX mark is "famous". The record contains no evidence of Complainant's advertising figures in aid of the mark's promotion, or of sales, number of customers, or unsolicited media coverage suggesting that the mark enjoys some measure of renown.

Complainant annexes to the Complaint a screenshot of a Pinterest page which shows the stylized DX mark and states that a company called Sunray DX Oil Company was using that stylized mark in the 1930s. A Wikipedia page for Sunoco annexed to the Complaint indicates that Sunray DX Oil Company was merged with Sun Oil Company (Sunoco's predecessor) in 1968.

The stylized DX mark appeared in the 1983 movie "The Outsiders", which was based in Oklahoma. Complainant also asserts, "The DX Mark is a subject of two museums". To support this claim, Complainant annexes a screenshot from a website at the domain name <theoutsidershouse.com>, which site has a page referring to "The DX Gas Station".

It is unclear from the record whether the stylized DX mark had been registered by Sunray DX Oil Company, Sunoco, or any other firm before Complainant apparently acquired rights to that mark.

According to information provided with the Complaint, Respondent KP Impex ("KP") is a California corporation which conducts business under the name Doxa Lubricants. The Registered Service Agent for KP Impex, according to California Secretary of State records, is Respondent Ronaq Sethi ("Sethi"). Based on the undisputed record and clear evidence presented, the Panel considers Sethi to be KP's principal for purposes of this proceeding, and the Panel will refer to KP and Sethi as "Respondent".

Respondent KP owns a registered trademark for DOXA, registered with the USPTO on August 13, 2019 under Reg. No. 5,832,725 in connection with "automobile lubricants" and related products in International Class 4, with a July 5, 2018 date of first use in commerce.

The Domain Name was registered on May 22, 2020. As of July 8, 2022, Respondent was using the website to sell DOXA automotive oil and lubricant products.

Complainant asserts that it sent cease-and-desist notices to Respondent on July 12, 2022 and September 29, 2022, but did not receive any response to these letters (which were not annexed to the Complaint). At some point after July 8, 2022, the commercial website to which the Domain Name resolved was deactivated.

On October 13, 2022, Complainant sent a third letter to Respondent, asserting Complainant's trademark rights to DX LUBES and alleging infringement by Respondent. On October 20, 2022, Respondent sent to Complainant's counsel an email stating that Respondent registered the Domain Name because it was a shorter version of its brand name Doxa Lubricants, and that Respondent had moved its commercial website to the domain name <doxalubricants.com>. (The domain name <doxalubes.com> was registered on

July 19, 2022, according to a Whois search conducted by the Panel.) Respondent also said in its October 20, 2022 email that it would be willing to discuss a sale of the Domain Name.

On October 21, 2022, Complainant's counsel responded that Complainant was under no obligation to purchase the Domain Name, given Complainant's trademark rights in DX LUBES, but asked Respondent to name a sale price for consideration.

On November 1, 2022, Respondent replied by email, stating that it would accept USD 24,500 as consideration to transfer the Domain Name to Complainant. Respondent reiterated that it had chosen the Domain Name because it was a shorter version of its DOXA trademark, and denied having had any awareness of Complainant's DX mark at the time it registered the Domain Name. Respondent said the USD 24,500 asking price "would be adequate given the years of costs related to the website upkeep and search engine optimization".

There is no evidence in the record of further communications between the Parties.

The Domain Name currently resolves to a parking page.

At a separate Blogspot website, Respondent maintains a presence ("www. dxlubes.blogspot.com") where it sells its DOXA lubricant products, according to a February 28, 2023 screenshot annexed to the Complaint.

## **5. Parties' Contentions**

### **A. Complainant**

Complainant contends that it has established all three elements required under the Policy for a transfer of the Domain Name.

### **B. Respondent**

Respondent did not reply to Complainant's contentions.

## **6. Discussion and Findings**

### **A. Identical or Confusingly Similar**

The Panel concludes that Complainant has rights in the trademark DX through registration demonstrated in the record.

The Panel also concludes that the Domain Name is confusingly similar to that mark. The Domain Name incorporated the DX mark and adds the term "lubes" (shorthand for "lubricants"), which is what Complainant sells under the DX mark. The mark is recognizable within the Domain Name.

Complainant has established Policy paragraph 4(a)(i).

### **B. Rights or Legitimate Interests**

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [Respondent] of the dispute, your 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) you [Respondent] (as an individual, business, or other organization) have been commonly known by the Domain Name, even if you have acquired no trademark or service mark rights; or

(iii) you [Respondent] are making a legitimate noncommercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Panel concludes that Respondent lacks rights or legitimate interests in respect of the Domain Name.

On the record presented, and on a balance of probabilities, this case is somewhat of a close call. As noted above, Complainant did very little to support its claim that DX is a “famous” trademark. Even so, the Panel finds it as more likely than not that Respondent’s denial of knowledge of Complainant’s trademark at the time it registered the Domain Name cannot be credited.

First, both Parties make and sell lubricants.

Second, with respect to Respondent’s explanation that it chose the Domain Name because “DX” is shorter than “DOXA”, the trademark DOXA is already short, and it seems unlikely that shortening it (by saving two letters and no syllables) to “DX” is going to be of much help.

Third, the undisputed record shows that Respondent failed to reply to the first two cease-and-desist letters. This conduct does not depict a good faith actor.

Fourth, Respondent did not rebut any of Complainant’s allegations in this proceeding.

Fifth, and perhaps most importantly, Respondent’s page at the Blogspot website uses “DX LUBES” instead of “DOXA” or “DOXA LUBES.” Long after Respondent migrated its website from the Domain Name to <doxalubes.com>, it was still using Complainant’s DX mark to sell products via the Blogspot page. The Panel cannot understand why Respondent would have chosen the DX mark over its own DOXA mark on the Blogspot site. The “shorter version” argument makes little sense, and lacks credibility in this connection.

Finally, Respondent’s offer to sell the Domain Name for USD 24,500, which price seems greatly to exceed actual costs associated with the Domain Name (Respondent’s reference to costs on record, relate more to website operation, which would have been necessary regardless of which domain name it was using for the site), does not reflect well on Respondent in these circumstances.

As such, the Panel concludes that Respondent was aware of Complainant’s DX mark, and chose to sell its somewhat overlapping DOXA products by illegitimate use of the Domain Name.

Complainant has established Policy paragraph 4(a)(ii).

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

Paragraph 4(b) of the Policy provides that the following circumstances, “in particular but without limitation”, are evidence of the registration and use of the Domain Name in “bad faith”:

(i) circumstances indicating that Respondent has registered or has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out of pocket costs directly related to the Domain Name; or

(ii) that Respondent has registered the Domain Name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or

(iii) that Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or

(iv) that by using the Domain Name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's website or other online location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website or location or of a product or service on Respondent's website or location.

The Panel concludes, on this record, that Respondent has registered and used the Domain Name in bad faith under the Policy. The reasons set forth in the previous section apply with equal vigor here. Respondent's conduct constitutes bad faith registration and use within the meaning of the above-quoted Policy paragraph 4(b)(iv).

Complainant has established Policy paragraph 4(a)(iii).

## **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 <dxlubes.com> be transferred to Complainant.

*/Robert A. Badgley/*

**Robert A. Badgley**

Sole Panelist

Date: May 13, 2023