

ADMINISTRATIVE PANEL DECISION

Liqui-Moly GmbH, Meguin GmbH & Co. KG Mineraloelwerke v.
Registration Private, Domains By Proxy, LLC / Sayed Zainul Islam,
Sadia Zain Shah Meguin Auto Panels LLC, Naseem Shah
Case No. D2022-0011

1. The Parties

The Complainants are Liqui-Moly GmbH and Meguin GmbH & Co. KG Mineraloelwerke, Germany, both represented by BrandIT GmbH, Switzerland.

The Respondents are Registration Private, Domains By Proxy, LLC, United States of America (“United States”) / Sayed Zainul Islam, Sadia Zain Shah, Meguin Auto Panels LLC, Naseem Shah, United States.¹

2. The Domain Name and Registrar

The disputed domain name <mequin.com> 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 January 3, 2022. On January 4, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 5, 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 Complainants on January 11, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. On January 13, 2022, the Fourth Respondent sent an informal communication to the Center requesting further information about the Complaint. The Complainants filed an amended Complaint on January 14, 2022. The Fourth Respondent filed two informal communications on January 18, 2022 and January 25, 2022. The Complainants filed an updated amended Complaint on January 25, 2022.

¹ It is evident from the case file that Registration Private, Domains By Proxy, LLC is a privacy protection service and that is the underlying registrants of the disputed domain name are the Third and Fourth Respondents listed in Section 4 of this decision. Therefore, unless otherwise indicated, the term “Respondents” is used by the Panel to refer to the underlying registrants only.

The Center verified that the Complaint together with the amended Complaints 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 Respondents of the Complaint, and the proceedings commenced on January 28, 2022. On February 2, 2022, the Fourth Respondent requested an extension of 10 days to file the Response, and then on February 22, 2022, the Fourth Respondent requested a new extension. Both extensions were granted. In accordance with the Rules, paragraph 5, and considering the extensions requested, the due date for Response was February 28, 2022. The Response was filed with the Center on February 28, 2022.

The Complainant filed supplemental filings on March 29, 2022, and the Respondent filed supplemental filings on April 15, 2022.

The Center appointed John Swinson, Stephanie G. Hartung, and Diane Cabell as panelists in this matter on April 25, 2022. The Panel finds that it was properly constituted. Each member of 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 First Complainant, Liqui-Moly GmbH, is a manufacturer of premium quality lubricants, motor oils, additives, vehicle care products, chemical repair tools, service products, glues and sealants. The First Complainant was founded in 1957 and exports its products from Germany to more than 150 countries.

The Second Complainant, Meguin GmbH & Co. KG Mineraloelwerke, is a wholly owned subsidiary of the First Complainant. The Second Complainant was founded in 1847 by Gustav Meguin to manufacture hoof grease, linseed oil, and wagon lubricants. Today, the Second Complainant offers lubricants for passenger cars, commercial vehicles, and industry, including numerous special products such as synthetic industrial gear oils.

The Second Complainant owns several trademark registrations for MEGUIN including:

- Germany trademark MEGUIN No. 39607199, registered on September 19, 1996
- Indian trademark MEGUIN No. 818751, registered on August 21, 2002
- International trademark MEGUIN No. 708403, registered on August 27, 1998
- United States trademark MEGUIN No. 5253293, registered on August 1, 2017.

The disputed domain name was registered on January 11, 2001.

The Respondents listed in the Complaint are Sayed Zainul Islam (“First Respondent”), Sadia Zain Shah (“Second Respondent”), Meguin Auto Panels LLC (“Third Respondent”) and Naseem Shah (“Fourth Respondent”).

The First Respondent, the Second Respondent, and the Fourth Respondent are members of the same family.

The First Respondent is an international business executive who has held positions in well-known businesses in various countries. The First Respondent is President of the family business Alpina Holdings Inc. (“Alpina”). The First Respondent is also a director of a company called Uber Energy LLC, an Ohio company. This company filed a U.S. trademark application for UBER CLEAN ENERGY (Serial No. 87207594) in 2016. This application was the subject of Trademark Trial and Appeal Board Case No. 87207594-EXT, and the application was abandoned in March 2018.

The Second Respondent is the daughter of the First Respondent and the Fourth Respondent. She is an accomplished physician from Stanford University specializing in Lung and Heart transplants. She performed the first lung transplant and CABG on a Covid patient in 2020. She is the Medical Director of Lung Transplant and the Medical Director of Larynx and Trachea Transplant with Mayo Clinic, United States.

The Fourth Respondent invented and patented an invisible solar panel for all transport vehicles that also eliminates drag, thereby increasing fuel efficiency.

On July 4, 2010, the First Complainant and Alpina, represented by its Chief Operation Officer (the First Respondent) signed a Distributorship Agreement. (No goods other than samples were supplied under this agreement, and the First Complainant terminated this agreement in February 2018.)

According to the Complainants, the disputed domain name was acquired by the First Respondent on July 12, 2010. According to the Respondents, the disputed domain name was acquired by the First Respondent on June 19, 2010. (The Respondents provided an email dated January 28, 2022 from BuyDomains that states that the disputed domain name was purchased for USD 3,233.95 on June 19, 2010.)

On April 1, 2011, March 2015, June 28, 2021, and August 11, 2021, the Complainants sent cease and desist letters to the First Respondent regarding the disputed domain name.

At times in the past, the First Respondent redirected the disputed domain name to the Complainants' website at <mequin.de>. This redirection ended in August 2021, and that appears to be the catalyst for the Complaint.

The Fourth Respondent incorporated a company in Florida on August 16, 2021 called Meguin LLC, but that company was dissolved on August 23, 2021.

The Third Respondent Meguin Auto Panels LLC was incorporated in Florida on August 25, 2021. The Fourth Respondent is the authorized person for the Third Respondent according to Florida incorporation records. The Second Respondent and the Fourth Respondent are directors of the Third Respondent.

The disputed domain name was transferred to the Fourth Respondent on August 28, 2021.

At the present time, the disputed domain name resolves to a website (which is only partially completed and is stated to be "under development") that is titled "Meguin Auto Parts" and advertises "INVISIBLE SOLAR PANELS THAT ALSO ELIMINATE DRAG FOR CARS, TRUCKS & TRAINS". This website states: "We hand picked our team of highly motivated scientists and researchers to deliver products that are at the cutting edge of the Green Revolution. We were able to secure Patents for our products in USA, Australia and India. Patents are pending for all of Europe and Canada." (The Panel was unable to find any patents owned by the Third Respondent Meguin Auto Panels LLC. The Respondents provided copies of patents that show ownership by the Fourth Respondent personally.)

5. Parties' Contentions

A. Complainants

In summary, the Complainants make the following submissions:

The Complainants have a corporate connection and a shared interest in the MEGUIN trademark. The Complainants have therefore a common grievance against the Respondents.

The disputed domain name is subject to the common control of several persons acting together. The acquisition of the disputed domain name and its subsequent transfer has been jointly organized by four persons, namely the Respondents.

The Second Complainant owns trademark registrations for MEGUIN including those set out in Section 4 above.

The Second Complainant attempted to assert its trademark rights in May 2010 and again in April 2011.

The disputed domain name, in its second-level portion, incorporates in its entirety the Complainants' registered and widely known trademark MEGUIN.

It is very likely that the First Respondent acquired the disputed domain name on July 12, 2010, only eight days after the signature of the Distributorship Agreement and many years after the first registrations of the Complainants' trademark MEGUIN.

The Complainants have not authorized any of the Respondents to register or use the disputed domain name.

In 2010, the First Respondent registered the disputed domain name without informing the Complainants or obtaining consent. The Distributorship Agreement between the First Complainant and Alpina, paragraph 4.4, clearly stipulated that "[t]he Distributor is not authorized to have registered himself trade marks, trade names and other signs of the Seller (or signs or names which are similar to those of the Seller) neither within nor without the contractual territory".

The First Respondent acquired the disputed domain name on July 12, 2010, with the intent to refer to the Complainants and the MEGUIN trademark. Indeed, such acquisition happened only a few days after the parties concluded the Distributorship Agreement.

In an email sent to the First Complainant in reply to the cease and desist letter, the First Respondent stated "[w]e are [...] the owners of a US based Company Meguin Inc". Despite the First Complainant's request, the First Respondent did not provide evidence of such company registration. No reference to the company "Meguin Inc." was found in the United States company registries, especially in states associated with the First Respondent.

The First Respondent has used the disputed domain name to capitalize on the fame of the Complainants and the MEGUIN trademark. By continuously using email addresses incorporating the MEGUIN trademark, the First Respondent has aimed at inferring a direct association with the Complainants whereas the parties' business relationship ended several years ago.

The registration of the Third Respondent Meguin Auto Panels LLC and the change of domain name ownership are a maneuver to give the false impression that the Third and Fourth Respondents have rights and legitimate interests in respect of the disputed domain name.

By reading the disputed domain name, Internet users may believe that it is directly connected or authorized by the Complainants and that the disputed domain name will resolve to the Complainants' official website.

The Respondents have aimed at making Internet users believe that the disputed domain name is directly linked to, or operated by, the Complainants.

The First Respondent has extensively used the disputed domain name – by making reference to it, using it in email addresses and associating it to the First Complainant's former website – to infer a connection with the Complainants and the MEGUIN trademark, whereas the former business relationship between the parties ended many years ago. The First Respondent has been using the disputed domain name to obtain a commercial gain, by capitalizing on the fame of the Complainants and the MEGUIN trademark.

The First Respondent has aimed at selling the disputed domain name for an exorbitant amount without providing evidence of such price. Such behavior cannot be considered as a *bona fide* offering of goods and services.

The Respondents registered the disputed domain name many years after the first registrations of the Second Complainant's MEGUIN trademark.

The Respondents knew the Complainants and the MEGUIN trademark at the time they registered the disputed domain name.

On several occasions, the Respondents have been engaged in a pattern of registering domain names incorporating the Complainants' trademarks and provided contradictory statements in this matter.

For many years, the disputed domain name has resolved to the former version of the First Complainant's website without its consent. Moreover, the First Respondent has been using the disputed domain name in his email addresses.

The overall described circumstances are clear demonstration of the registration and use of the disputed domain name in bad faith.

B. Respondents

In summary, the Respondents make the following submissions:

The Complainants commit willful fraud by illegally using the disputed domain name owned by the First Respondent for the past 11 years on every page of the Complainants' corporate presentations, on the back page of its brochures, and on the centerfold of its catalogs.

The Respondents object to the consolidation of the Complainants. The First Complainant is not the registrant of the trademark MEGUIN in USA or Canada. These trademarks are owned by the Second Complainant.

The Complainants have falsified the facts. The true facts are: (1) the disputed domain name was acquired by the First Respondent on June 19, 2010; (2) the LiquiMoly domain names were acquired in 2009 by the Respondents with authorization from the First Complainant; (3) the First Complainant was aware of the First Respondent's use of the disputed domain name, due to an email sent by the First Complainant to zain@meguin.com on July 19, 2010.

The Respondents agree with the following facts which were set out in the Complaint:

- a. There was no relationship between the parties until July 4, 2010.
- b. The parties entered into a Distribution agreement on July 4, 2010.
- c. There was no supply/delivery of any products during the Distribution Agreement, except for free initial samples.
- d. The Distribution Agreement was terminated on February 12, 2018.

Over the past 11 years, the First Complainant's executives had dinner with the First and Fourth Respondents at their residence in Toronto multiple times, the Complainants invited and hosted the Respondents in Munich, Germany at AutoMechanica 2010, as well as at their facilities in Ulm and Saarlouis, Germany.

The Fourth Respondent had acquired the disputed domain name through the First Respondent on June 19, 2010 to fulfill her lifelong dream of hosting a website to market her invention globally.

The First, Second, and Fourth Respondents are a family of three highly accomplished individuals based in North America. The Complainants have known these three Respondents since July 4, 2010 when they signed an Exclusive Distributorship for North America with the family business (Alpina) of which all three were Directors.

None of the Respondents or any of the businesses that they owned have ever sold a domain name. The Respondents are not in the domain name buying/selling business.

The keyword contained in the disputed domain name is a geographical region in France. The Fourth Respondent was born in Metz, France in the mid-1950s. Her family moved to Méguin, Auvergne Rhône-Alpes Province, France in 1960. She studied at an elementary school within Auvergne and continues to stay in touch with her friends through various social media platforms. In early 2010, the Fourth Respondent came up with the idea of her disruptively innovative invention of "Invisible Solar panels that also eliminate drag for all transport vehicles". The invention is expected to spearhead the "Green Revolution". She planned to patent the idea globally and brand it as "meguin" by dedicating it to, and honoring Méguin, a place where she grew up in France.

On June 19, 2010, the First Respondent acquired the disputed domain name under his personal name at the request of his wife (the Fourth Respondent) through an open auction for USD 3,233.95 from "buydomains.com".

The Complainants did not have any registered trademarks in Canada as to "meguin" on June 19, 2010. This date is sufficient to defeat the Complaint.

None of the Respondents had ever heard of the Complainants' Meguin brand by June 19, 2010.

Within just a few days of the domain name acquisition by First Respondent through an open auction conducted, three of the key executives of the First Complainant, namely Manfred Fischer and Peter Baumann from Germany; and Tim Riordan from the United States landed in Toronto, Canada made a cold call on the corporate office of Alpina after coordinating an appointment with the First Respondent from Germany. After initial pleasantries, they offered the Exclusive Distributorship of the complete range of their products for all of North America (USA, Canada, Mexico) to the family business, Alpina, calling it the "find of the decade". Alpina and its human resources had zero experience in the Lubricants Industry. It was in the business of educating Project Managers and helping them in acquiring the coveted Project Management Professional (PMP) certification. Alpina had absolutely no clue of the Lubricants industry and being offered the Exclusive Distributorship for all of North America by a major German Lubricants manufacturer just after a cold call by three Senior Executives of a major European Oil and Lubricant company was pleasantly very shocking to Alpina. The First Complainant's representatives continued to badger Alpina on an almost daily basis to sign up for the Exclusive Distributorship Agreement for North America. The offer of the Exclusive Distributorship for North America was only a ruse to get the disputed domain name.

The Complainants falsely claim that the First Complainant came to know of the identity of the domain owner on April 1, 2011. The fact is that from July 2010 onwards, the Complainants continued to communicate with the First Respondent using both of his emails zain@meguin.com and zain@alpinaholdings.com.

The Complaint should be barred by the doctrine of laches because the Complainants waited almost 12 years to initiate this proceeding.

This is not a case of cybersquatting. The Respondents are highly reputed professionals with all the intent followed by action to use the domain for their legitimate business.

The Respondents' legitimate interest in the disputed domain name stems from the fact that the First Respondent registered the disputed domain name (on June 19, 2010) at a time when it was not subject to any trademark rights in Canada.

On March 16, 2016, the Respondents registered the company Meguin N.A. in Delaware, United States. The Respondents had the intention to use the disputed domain name for a *bona fide* business six years before notice of the dispute. It is irrefutable evidence of demonstrable preparations for use of the disputed domain name in connection with a legitimate offering of goods. The company was dissolved after a few

years as the expected financing did not come through to enable the global launch of the patented products.

The Third Respondent started using the disputed domain name while it had already incorporated the company by a similar name, Meguin Auto Panels LLC, in August 2021.

The Third Respondent has already spent considerable resources in marketing its international patents under the Meguin Auto Panels brand with the disputed domain name associated with it to leading automakers in the United States, Australia and India, and is at an advanced stage of licensing it to a few automakers.

The disputed domain name was acquired at a premium in an open auction, primarily for the purpose of selling patented “Invisible Solar Panels”.

The disputed domain name resolved to the Complainants’ <meguin.de> website since July 2010 at the specific request of the First Complainant’s executive and was very much in the knowledge of the First Complainant.

6. Discussion and Findings

To succeed, the Complainants must demonstrate that all of the elements enumerated in paragraph 4(a) of the Policy have been satisfied, namely:

(i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainants have rights; and

(ii) the Respondents have 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.

The *onus* of proving these elements is on the Complainants.

Paragraph 15(a) of the Rules directs the Panel to decide the 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.

A. Procedural Issues

Two Complainants

The Complaint is filed by two Complainants.

Previous panels have permitted a single complaint where the complainants have a “common grievance” against the respondent, as long as it is equitable and procedurally efficient to do so (*Bettina Liano and Bettina Liano Pty Limited v. Khanh Kim Huynh*, WIPO Case No. [D2000-0891](#); *NFL Properties, Inc. et al. v. Rusty Rahe*, WIPO Case No. [D2000-0128](#); and *Bennett, Coleman and Company Limited, Worldwide Media Private Limited v. Mr. Hubert Louis*, WIPO Case No. [D2019-0221](#))

The Panel finds that it is procedurally efficient to permit a single Complaint in this case as the Complainants are related entities. Both have been involved in dealings with the Respondents. The Respondents refer to both Complainants in their Response. As such, the Complainants share a common grievance against the Respondents.

Four Respondents

The Complaint has been filed against four Respondents. Three of the Respondents are members of the same family. One of the Respondents is a previous owner of the disputed domain name. Two of the Respondents are directors of the Third Respondent. The Panel finds that it is appropriate for the Complaint to be brought against the four Respondents. See *Mountain Top (Denmark) ApS v. Contact Privacy Inc. Customer 0133416460 / Name Redacted, Mountaintop Idea Studio*, WIPO Case No. [D2020-1577](#).

Supplementary Filings

Both parties have filed supplementary materials.

The Policy envisages prompt and efficient resolution of domain name disputes. Accordingly, the Rules and the Supplemental Rules only contemplate the filing of a complaint and a response, with strict time and word limits. There is no explicit provision for additional filings, except for further statements or documents provided in response to a request from a panel. Paragraph 10 of the Rules provides that the panel is to conduct proceedings “with due expedition” and gives the panel the power to “determine the admissibility, relevance, materiality and weight of the evidence”. Generally, panels will only accept supplementary filings in “exceptional” circumstances.

Here, the factual situation is complex. The Respondents raised issues in their Response that the Complainants were unlikely to have anticipated. The Complainants’ supplementary materials provide additional factual information and documents. The Respondent has had the opportunity to respond to the Complainants’ supplementary materials. The Panel has found the supplementary materials from both parties to be helpful, and accordingly accepts all the supplementary filings in this case.

B. Background Issues

This is a complex case, with relevant dealings stretching over 10 years, with many disputed factual issues. The Respondents submit that this case is not appropriate for a decision under the Policy. The Panel is aware of decisions such as *Aquarian Foundation, Inc. v. Domain Privacy / Richard Stewart / Sri Sunkara Sankacharya, aka Rev. Bruce Kimberley Lowndes, aka KIM*, WIPO Case No. [D2021-4176](#), where the Panelist denied the Complainant on the basis that it was unsuitable for determination under the Policy.

In this case, the Panel considers that, despite having many facts, it is suitable for determination under the Policy. The parties raising many difficult issues does not necessarily make the dispute unsuitable for resolution under the Policy.

The Panel now first will consider two preliminary factual issues raised by the parties.

The Liqui-Moly domain names

In October 2009, the Second Respondent on behalf of Alpina registered the domain names <liqui-moly.mobi>, <liqui-moly.ca>, and <liqui-moly.us> which incorporated the First Complainant’s trademark LIQUI MOLY. This was prior to the First Respondent acquiring the disputed domain name and entering a business relationship with the Complainants.

The evidence presents different reasons why the Second Respondent did this. Explanations include:

1. The Second Respondent was assisting a Mr Timothy Riordan, who worked for a Massachusetts company called Liquidation Molly, who was having trouble registering domain names with .ca and .us extensions because his company was not registered in Canada. (This does not explain why a .mobi was registered, or why Mr Riordan could not register the .us domain name.). In September 2009, the Second Respondent, who was a director of Alpina, emailed the webmaster at Alpina stating that Mr Riordan “will reach out to you to provide you with the required details. Have these domain names registered in my name and transfer to

them at his request”.

2. The Response further states that Mr Riordan was a sales manager for the First Complainant in the United States, and contacted the Second Respondent via mutual contacts (unnamed). The Second Respondent did this as a personal favour to an unnamed friend who was a doctor. The intent of doing this was to protect Mr. Riordan’s company’s interests. (As an aside, it is noted that Mr. Riordan emailed the First Respondent at an email address showing that the First Respondent was using the disputed domain name for emails on July 19, 2010. This email was about a potential sales opportunity for the First Complainant’s products.)

3. In February 2011, a marketing person working for the First Complainant in Germany asked for these domain names to be transferred to the First Complainant and referred to its trademark rights as the reason for doing so. It is unclear whether he knew of the arrangements made by Mr. Riordan. As a result, these three domain names were transferred to the First Complainant. In any email exchange at the time, the First Respondent stated that these three domain names were registered to prevent a competitor registering them. The First Complainant stated that <liqui-moly.us> was registered by the Respondents without permission.

4. Alpina asked the First Complainant for a payment of USD 7,038 for these three domain names, asserting this is what they paid for them. It is unclear why Alpina did not ask for this payment in July 2010 when these domain names were first registered, supposedly on behalf of the First Complainant. This payment was not made.

5. In 2015, the First Respondent responded to an email requesting transfer of the disputed domain name. In his response, the First Respondent referred to the liqui-moly domain names, and stated: “We had acquired all those domains after paying a lot of money for them and transferred them in good faith to your organisation for free. We never received so much as a thank you.” No mention has made of the arrangement with Mr. Riordan from 2009. The wording of this email is inconsistent with the 2009 arrangement.

6. In August 2021, the First Respondent responded to a demand letter from the Complainants regarding the disputed domain name. In this email respond, the First Respondent stated: “We also owned the domain Liqui-Moly.US that we gave to your client as a free gift back in 2011 in addition to three other domains that pertained to their line of business with not even so much as a Thank you. Please talk to your managers Tim Riordin, Manfred Fischer and Peter Baumann who were all privy to that FREE GIFT.” Again, this response is inconsistent with the 2009 arrangement – the domain names were not “owned” by Alpina but supposedly registered by Alpina as agent for the First Complainant, and were not given to the First Complainant as a free gift but pursuant to the 2009 agreement to transfer them to the First Complainant on request.

This situation is murky. What the Panel can conclude is that (a) the Respondents were aware of the Complainants prior to registering the disputed domain name; (b) the Respondents had a relationship with Mr. Riordan of the First Complainant prior to registering the disputed domain name; (c) this relationship involved domain names; (d) the Respondents have not been forthright to the Panel or to the Complainants regarding their registration of the liqui-moly domain names; (e) the Respondents have used the transfer of the liqui-moly domain names in 2011 as a reason to obtain a high price when negotiating in 2021 to sell the disputed domain name to the Complainants.

The First Respondent’s Representations Regarding His Relationship with the Complainants

The Complainants assert that the First Respondent misrepresented his relationship with the Complainants. The Complainants provided evidence from online sources, such as Twitter, that show that the First Respondent was holding himself out as “President and CEO” of Meguin North America, and that his roles included setting up a country-wide distribution network for a major German oil company, and that he developed Meguin’s strategy, and he achieved a fivefold revenue growth for Meguin in four years (2007 to 2011). (After this, he became a project manager for Hewlett-Packard.) His Twitter account stated that the First Respondent is the Chairman and Chief Executive of Meguin North America, the largest after-market supplier of oils and additives in Europe.

These representations made online by the First Respondent are clearly untrue. The First Respondent has publicly misrepresented his relationship with the Complainants. The Respondents did not respond to this evidence.

The First Respondent also made clearly false and misleading statements to the Complainants in August 2021 when responding to correspondence from the Complainants' legal representative regarding the disputed domain name. This is discussed further below.

C. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy provides that the Complainant must establish that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Second Complainant owns trademark registrations for MEGUIN.

Where a domain name incorporates the entirety of a trade mark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark (see section 1.7 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

In this case, the disputed domain name incorporates the entirety of the MEGUIN trademark with no additional terms.

It is not relevant to the first element of the Policy that meguin may also be a place in France or a surname. The Second Complainant owns registered trademarks for MEGUIN.

The Respondents state that they conducted online searches before acquiring the disputed domain name and did not discover the Second Complainant's trademark registrations. Whether a respondent is aware of a complainant's rights is not relevant to the first element of the Policy. (The Panel notes as an aside that the Second Complainant owned registered trademarks for MEGUIN at the time the First Respondent registered the disputed domain name.)

The Complainants succeed on the first element of the Policy in relation to the disputed domain name.

D. Rights or Legitimate Interests

For the second requirement set forth by paragraph 4(a)(ii) of the Policy, the Complainants must prove that the Respondents have no rights or legitimate interests in respect of the disputed domain name.

Paragraph 4(c) of the Policy provides three circumstances in which the respondent has rights or legitimate interests in a disputed domain name. These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

The *onus* of proving this requirement, like each element, falls on the complainant.

Previous UDRP panels have recognized the difficulties inherent in proving a negative, however, especially in circumstances where much of the relevant information is in, or likely to be in, the possession of the respondent. Accordingly, it is sufficient for a complainant to raise a *prima facie* case against the respondent under this head and an evidential burden of production will shift to the respondent to rebut that *prima facie* case.

The Respondents present five possible reasons why the Respondents have rights or legitimate interests in the disputed domain name. These are: (A) The Respondents registered the disputed domain name because it is the name of a location in France near to where the Fourth Respondent went to school in the 1960s. (B) The First Respondent registered the disputed domain name (on June 19, 2010) at the request of

the Fourth Respondent for the Fourth Respondent's invisible solar panel business, and he would transfer the disputed domain name as soon as the patent was granted. (C) The disputed domain name corresponds with the name of the Third Respondent. (D) The First Respondent registered the disputed domain name (on June 19, 2010) at a time when it was not subject to any trademark rights in Canada. (E) The Respondents incorporated a Delaware company called MEGUIN N.A. LLC in 2016.

(A) The Respondents assert that the First Respondent registered the disputed domain name because it is the name of a location in France near to where the Fourth Respondent went to school in the 1960s. Assuming this is correct, which is disputed by the Complainants, this does not by itself give the Respondents' rights or legitimate interests in a disputed domain name. More to the point, this assertion is in clear contrast to the further assertions set out below.

(B) The Respondents assert that the First Respondent registered the disputed domain name (on June 19, 2010) at the request of the Fourth Respondent for the Fourth Respondent's invisible solar panel business, and that he would transfer the disputed domain name to the Fourth Respondent as soon as the patent was granted. There is no evidence to support this assertion. It is also not credible. The Fourth Respondent did not file a patent application until seven years after the disputed domain name was registered. There is no evidence of work on the patentable invention in 2010. Additionally, there is no association between the Fourth Respondent's invention and the disputed domain name. In sharp contrast, in 2015, the First Respondent emailed the Complainants in March 2015 stating: "We acquired [the disputed domain name] for \$7,200 about six years ago to protect your business interests. ... We have now decided to sell [the disputed domain name] at its current fair market price regardless of what we paid for it."

(C) The Respondents assert that they have rights or legitimate interests in respect of the disputed domain name because it corresponds with the name of the Third Respondent. However, the Third Respondent was only created in 2021, and just days after the Respondents received another demand letter from the Complainants. Further, there is no evidence showing that the Third Respondent has developed any reputation in its name MEGUIN AUTO PANELS. There is no evidence as to number of visitors to the website at the disputed domain name, and there is no other evidence of use of MEGUIN AUTO PANELS.

(D) The Respondents assert that the Respondents' legitimate interests in the disputed domain name stem from the fact that the First Respondent registered the disputed domain name (on June 19, 2010) at a time when it was not subject to any trademark rights in Canada. This, of itself, does not give the Respondents rights or legitimate interests in respect of the disputed domain name.

(E) The Respondents state they incorporated a Delaware company called MEGUIN N.A. LLC in 2016. This company was dissolved a few years later when finance was not obtained. This company, which was only in existence from 2016 to about 2018, does not give the Respondents rights or legitimate interests in 2010 when the Respondents acquired the disputed domain name, or arguably today as the company no longer exists. There is no evidence that this company traded or developed any reputation in MEGUIN. Further, there is no evidence that in 2010 (at the time of registration of the disputed domain name) that it was envisaged that the Respondents planned to establish and own a company named "MEGUIN" or similar.

The evidence shows that the First Respondent registered the disputed domain name in 2010 in the context of negotiating a distribution agreement with the Complainants. The First Respondent registered the disputed domain name to protect the Complainants' business interests, that is, for the benefit of the Complainants. The distribution arrangements have meanwhile come to an end. The distribution agreement states that the right to use the Second Complainant's trademarks ceases upon termination of the distribution agreement. The First Respondent had redirected the disputed domain name to the Complainants' website for many years. In August 2021, when the Complainants requested transfer of the disputed domain name, the First Respondent offered to sell the disputed domain name to the Complainants (as set out below), and when that offer was not accepted, the Third Respondent was established and the disputed domain name was transferred to the Fourth Respondent as director of the Third Respondent, presumably to try to improve the Respondents' legal position or leverage in negotiations. This does not demonstrate any rights or legitimate interests.

The Complainants provided a signed statement of Peter Baumann, Marketing Director at the First Complainant, that stated in part: “At the end of 2010 [the First Complainant] became aware that the First Respondent had registered the [disputed domain name] without [the First Complainant’s] consent. It is to be noted that the registration of this domain name had never been a part of any negotiations with [the First Respondent]. Then, based on fair business relationship, [the First Complainant] accepted that [the First Respondent] could redirect the [disputed domain name] to [the First Complainant’s] domain name <meguin.de> for the period the Agreement would be effective. [The First Complainant] also understood that if the Agreement would not become effective after three years, [the First Respondent] will transfer the [disputed domain name] to [the First Complainant]. Such offer originated from [the First Respondent] himself.”

The Respondents do not accept that Mr. Baumann’s statement is correct. There are emails that support the Respondents’ position. However, there are also emails from 2015, discussed above, that do not support the Respondents’ position and are consistent with Mr. Baumann’s statement.

In any event, even if there was not an agreement to transfer the disputed domain name at the end of the distribution arrangements, the Respondents’ position on the second element of the Policy has issues.

The present situation is similar to prior cases where it has been decided that a terminated distribution agreement does not give a respondent rights or legitimate interests after termination of the agreement. *ESET, spol. s.r.o. v. Antivirus Australia PTY Ltd., Rodney Fewster, ESET Pty Ltd.*, WIPO Case No. [DAU2015-0014](#), *Jerome Stevens Pharmaceuticals, Inc. v. Watson Pharmaceuticals*, WIPO Case No. [D2003-1029](#); *HDML Licensing Administrator, Inc. v. S Kumar, Knoxed Limited*, WIPO Case No. [D2018-2514](#). The appropriate time to assess whether the Respondents have rights or legitimate interests in the disputed domain name is the present time. Thus, at the present time, the Respondents cannot demonstrate rights or legitimate interests based on the past arrangements, regardless of whether the Complainants’ or Respondents’ characterization of the arrangements between the parties is correct.

For completeness, the Panel notes that redirection of a domain name to the trademark owner’s website does not establish rights or legitimate interests. *Skyscanner Limited v. Domain Administrator, Fundacion Privacy Services LTD*, WIPO Case No. [D2019-2974](#). To the extent that the Respondents were authorized to redirect the disputed domain name to the Complainants’ website, that authorization has ended – both legally and in fact.

Other factors indicate that the Respondents should not succeed on the second element. This includes that the Respondents also own the domain name <meguin.us> which is simply parked and offered for sale, the Respondents were trying to sell the disputed domain name in the second half of 2021 (“We have happy to transfer it if we are made a reasonable offer.”), and the Respondents’ have not developed a legitimate MEGUIN business despite owning the disputed domain name for over 11 years. Further, in August 2021, the First Respondent wrote to the Complainants stating: “I may also add the domain Meguin.us was acquired by us recently for \$7.99. We have no plans of retaining it in the future. Your client may acquire it when it expires.” The First Respondent then attempted to transfer the domain name <meguin.us> to the Complainants. Although none of these factors are conclusive, they do not assist the Respondents’ position that the Respondents intend or intended to use MEGUIN for a legitimate business or that the Respondents have rights or legitimate interests in the disputed domain name.

The Respondents have not rebutted the Complainants’ *prima facie* case and have not established rights or legitimate interests in the disputed domain name.

The Complainants, therefore, succeed on the second element of the Policy in relation to the disputed domain name.

E. Registered and Used in Bad Faith

Finally, paragraph 4(a)(iii) of the Policy provides that the Complainants must establish that the Respondents registered and subsequently used the disputed domain name in bad faith.

The Panel concludes that the First Respondent purchased the disputed domain name in bad faith in 2010. At this time, the First Respondent had just signed, or was about to soon sign, a distribution agreement with the First Complainant. This distribution agreement included references to products branded as MEGUIN. Additionally, the Respondents were likely aware of the Complainants, having recently registered three domain names allegedly on behalf of the First Complainant.

The evidence is unclear as to who approached whom, and when, to establish the distribution arrangements. The Respondents' position is that the Complainants approached the Respondents a few days after the disputed domain name was purchased by the First Respondent, with a business offer for distribution rights that was a pretext to obtain the disputed domain name.

However, the Panel does not believe that the reason that the First Respondent selected the disputed domain name was because Meguin is a location in France near to where the First Respondent's wife (the Fourth Respondent) went to school over 40 years ago, and was therefore purchased for USD 3,233.95 or USD 7,200 (depending on which part of the Respondents' evidence is to be believed) by the First Respondent to assist the Fourth Respondent's business that was not actually established for at least another 5 years.

The most likely explanation is that the Respondents purchased the disputed domain name because it was the corporate name and related valuable trademark rights of the Second Complainant.

When the distribution agreement came to an end, the Respondents did not transfer the disputed domain name to the Complainants as they were supposed to have done. For the previous 8 years, the Respondents had redirected the disputed domain name to the Complainants' website. The Respondents knew that the Complainants used the disputed domain name in advertising. The Respondents tried to take advantage of the situation, and offered to sell the disputed domain name to the Complainants. The Respondents wanted payment of USD 350,000 for the disputed domain name and the domain name <meguin.us> and informed the Complainants that this price was "not negotiable". (In the same email dated August 11, 2021, that offered the disputed domain name for USD 350,000, the First Respondent falsely stated: "We are also the owners of a US based Company Meguin Inc. registered in the US for the past 12 years." When the Complainants asked for evidence of this company, the First Respondent stated he would increase the price of the disputed domain name to USD 1.2 million. The Respondents never provided the evidence requested, because such evidence does not exist.) The Respondents told the Complainants that another person had made a competing offer (but did not provide any evidence of this in the Response). When the Respondents' offer was not accepted, the Respondents quickly established a company (the Third Respondent) and transferred the disputed domain name to the Third Respondent with the aim of trying to establish legitimacy to justify a high price.

These facts do not demonstrate good faith registration by the First Respondent (in 2010) or the Third and Fourth Respondents in 2021.

The use of the disputed domain name by the Third and Fourth Respondents after the 2021 transfer is also not in good faith. This use is a pretext, and not *bona fide*. It is also knowing infringing use, because the Respondents in 2021 were clearly aware of the Complainants' trademark rights in MEGUIN in the United States, and the Respondents' use of MEGUIN for an automobile accessory product would appear to be closely related to automobile products sold by the Complainants.

This is similar to the situation in the ESET case referred above, where a distributor of software products established a sham website at the end of the distribution arrangement to promote products under the trademark.

There was also a period in which the disputed domain name resolved to a registrar-generated pay-per-click parking page that had links to competitors of the Complainants. The Panel does not need to rely on this evidence to reach the conclusion as to bad faith.

The record indicates that the Respondents are not well-motivated toward the Complainants, for whatever reason, and so in 2022 used the disputed domain name in that context. For example, the First Respondent stated in writing that he would act with “vehemence” towards the Complainants unless his offer to sell the disputed domain name for USD 350,000 was accepted.

The Respondents raise laches. The redirection of the disputed domain name to the Complainants’ website was removed only recently, in August 2021. The disputed domain name was transferred to the Third and Fourth Respondents in late 2021. Laches, if such a defence does apply under the Policy, does not apply on the facts here.

The Panel finds that the Respondents have both registered and used the disputed domain name in bad faith.

The Complainants, therefore, also succeed on the third element of the Policy in relation to the disputed domain name.

F. Reverse Domain Name Hijacking (RDNH)

The Respondents ask for a finding of RDNH. In view of the outcome of the Complaint, such a finding is unwarranted.

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 <meguin.com> be transferred to the Second Complainant.

/John Swinson/
John Swinson
Presiding Panelist

/Stephanie G. Hartung/
Stephanie G. Hartung
Panelist

/Diane Cabell/
Diane Cabell
Panelist
Date: May 9, 2022