

ADMINISTRATIVE PANEL DECISION

Valvoline Licensing and Intellectual Property LLC v. Privacy Service Provided by Withheld for Privacy ehf / Walt Legg
Case No. D2022-1567

1. The Parties

Complainant is Valvoline Licensing and Intellectual Property LLC, United States of America (“United States” or “USA”), represented by CSC Digital Brand Services Group AB , Sweden.

Respondent is Privacy Service Provided by Withheld for Privacy ehf, Iceland / Walt Legg, Singapore.

2. The Domain Name and Registrar

The disputed domain name <valvolinebattery.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 April 29, 2022. On April 29, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 29, 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 Complainant on May 4, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on May 9, 2022.

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 Respondent of the Complaint, and the proceedings commenced on May 10, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 30, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on June 1, 2022.

The Center appointed Gabriel F. Leonardos as the sole panelist in this matter on June 15, 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

Complainant, Valvoline Licensing and Intellectual Property LLC, is a global company in the automotive lubricant industry, and provides products and services mainly as a choice of drive-thru oil changes and automobile maintenance. Complainant was founded in 1866 by the inventor of the first lubricating oil and is today a worldwide producer and distributor of premium branded automotive, commercial and industrial lubricants, and automotive chemicals.

Complainant provides its products and services internationally in over 140 countries, operating over 1,500 instant oil change centers in the United States itself.

Complainant owns trademark registrations for the signs VALVOLINE and VALVOLINE BATTERIES, as can be found on the examples below:

Registration No.	Trademark	Jurisdictions	International Classes	Date of Registration
0053237	VALVOLINE	USA	04	May 29, 1906
0670453	VALVOLINE	USA	01	December 2, 1958
568949A	VALVOLINE	International Trademark	01, 03, 04	March 19, 1991
009847773	VALVOLINE	European Union	01, 04, 35	October 25, 2011
3623588	BA BATTERY SYSTEM VALVOLINE PROFESSIONAL SERIES	USA	09	May 19, 2009
TMA1075909	BA BATTERY SYSTEM VALVOLINE PROFESSIONAL SERIES & DESIGN	Canada	02	March 26, 2020

Further, Complainant owns the domain name <valvoline.com> since March 4, 1995.

The disputed domain name was registered on October 28, 2021, and resolves to a webpage which presents a variety of advertisement links.

5. Parties' Contentions

A. Complainant

Complainant pleads that the disputed domain name is confusingly similar to its registered trademark VALVOLINE, since it fully incorporates the referred trademark with the addition of the term "battery".

Complainant affirms that Respondent creates a confusion, considering specially that the disputed domain name uses the trademark VALVOLINE in its entirety with the addition of the generic term "battery", as consumers may believe that this domain name is linked to Complainant. Complainant also notes that the term "battery" is inherently associated with its activities, since Complainant provides products and services related to automotive maintenance, such as batteries.

Additionally, Complainant affirms that Respondent's prior use of the disputed domain name to redirect Internet users to Complainant's website at "www.vioc.com/battery-services/" contributed to the confusion, as it confirms that Respondent tries to create a similarity with Complainant's trademark.

Therefore, according to Complainant, the disputed domain name presents a high risk of confusion to consumers, who will likely believe it is linked with Complainant's trademark VALVOLINE, fulfilling paragraph 4(a)(i) of the Policy and paragraph 3(b)(viii) and 3(b)(ix)(1) of the Rules.

In addition, Complainant states that Respondent does not have any rights or legitimate interests in respect of the disputed domain name, nor is Respondent commonly known by the disputed domain name. Further, Respondent has not been authorized, or licensed to use Complainant's trademark VALVOLINE as a domain name nor is Respondent associated with Complainant.

Complainant observes that the disputed domain name is currently used to redirect internet users to a website with links to third-party websites, some of which are direct competitors to Complainant's business. Therefore, Complainant presumes that Respondent is receiving pay-per-click profit from the links to third-party websites, which would not constitute *bona fide* use of the disputed domain name that would represent legitimate use or interest.

Furthermore, Complainant notes that Respondent previously used the disputed domain name to redirect users to Complainant's own website "vioc.com/battery-services/", which led to the conclusion that Respondent's website was deliberately designed to attract Internet users to its website in the mistaken belief that it was linked to or authorized by Complainant.

Complainant also notes that Respondent registered the disputed domain name on October 28, 2021, which is significantly after Complainant registered VALVOLINE trademarks before the Intellectual Property Office of Singapore, United States Patent and Trademark Office, Canadian Intellectual Property Office, World Intellectual Property Organization, and European Union Intellectual Property Office, and significantly after Complainant's first use in commerce of its trademark in 1866.

This way, Complainant states that no legitimate use of the disputed domain name could be reasonably claimed by Respondent, thus paragraph 4(a)(ii) of the Policy and paragraph 3(b)(ix)(2) of the Rules has been fulfilled.

Moreover, Complainant argues that the trademark VALVOLINE is well-known internationally, and its products and services are provided with the referred trademark since 1866, and Respondent created the disputed domain name by connecting the trademark VALVOLINE with the term "battery" – thus, Respondent demonstrated knowledge and familiarity with Complainant's brand and business.

Complainant also affirms that, considering the numerous trademark registrations for the trademark VALVOLINE and its well-known international use and reputation, Respondent had knowledge or should have known of Complainant's rights to the trademark.

Further, Complainant alleges that the disputed domain name was registered by Respondent shortly after the announcement of a partnership between Complainant's business and "Battery Innovation Center", which would suggest that Respondent aimed to gain profit by using the publicity that this fact generated.

Complainant affirms that the use of the disputed domain name to increase traffic for the pay-per-click links posted to Respondent's website would indicate that Respondent is obtaining profit from the use of the disputed domain name, which, in the present circumstances, would also indicate bad faith.

Finally, Complainant indicates that Respondent has not responded to any of its attempts to resolve this dispute outside of the administrative proceeding.

Thus, the requirements for the identification of a bad faith use of the domain name would have been fulfilled, which constitutes registration and use in bad faith pursuant to paragraph 4(b)(iv) of the Policy.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

To succeed in a UDRP complaint, Complainant must demonstrate that all the elements listed in paragraph 4(a) of the Policy have been satisfied, as following:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) 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.

The burden of proving these elements is upon Complainant.

Respondent had 20 days to submit a response in accordance with paragraph 5(a) of the Rules and failed to do so. Paragraph 5(f) of the Rules establishes that if a respondent does not respond to the complaint, in the absence of exceptional circumstances, the panel's decision shall be based upon the complaint.

A. Identical or Confusingly Similar

Complainant has duly proven that it owns prior registered and unregistered rights for the trademark VALVOLINE, and that the disputed domain name is constituted by the trademark VALVOLINE in its entirety with the addition of the word "battery".

The addition of the word "battery" does not prevent a finding of confusing similarity with the trademark VALVOLINE, as the trademark VALVOLINE remains recognizable.

Thus, the Panel finds that the disputed domain name is confusingly similar to Complainant's trademarks, and so the requirement of the first element of paragraph 4(a) of the Policy is satisfied.

B. Rights or Legitimate Interests

The consensus view of UDRP panels on the burden of proof under paragraph 4(a)(ii) of the Policy is summarized in section 2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") as follows: "[w]hile the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a

domain name may result in the often impossible task of 'proving a negative', requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element."

In this case, noting the facts and contentions listed above, the Panel finds that Complainant has made out a *prima facie* case showing that Respondent lacks rights or legitimate interests in the disputed domain name, so the burden of production shifts to Respondent. As Respondent has not replied to Complainant's contentions, the Panel has considered Complainant's un rebutted *prima facie* case to be sufficient to demonstrate that Respondent has no rights or legitimate interests in the disputed domain name <valvolinebattery.com>.

Furthermore, Respondent has not used the disputed domain name in the context of a *bona fide* that could demonstrate legitimate interests, since the evidence shows that the disputed domain name (i) priorly redirected users to Complainant's own website "www.vioc.com/battery-services/", which indicates that the disputed domain name was designed to attract Internet users to its website in the mistaken belief that it is linked to or authorized by Complainant; (ii) is currently used to redirect Internet users to a website with links to third-party websites, which suggests that Respondent is obtaining profit from the disputed domain name website through pay-per-click links. Both uses of the disputed domain name were duly proven on Annex 3 to the Complaint.

Therefore, the Panel finds that the requirement of the second element of paragraph 4(a) of the Policy is also satisfied.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists a number of circumstances that, without limitation, are deemed evidence of registration and use of a domain name in bad faith.

Respondent has registered the disputed domain name that fully incorporates Complainant's trademark VALVOLINE, plus the addition of the word "battery". The Panel finds that it is duly demonstrated that Respondent was aware of Complainant's rights to the trademark VALVOLINE at the time of the registration – as Complainant enjoys a worldwide reputation with the use of the referred trademarks.

With that in sight, Panel finds that Respondent registered the disputed domain name with the intention of attracting Internet users and consumers in search of authentic VALVOLINE services – especially when considering that the disputed domain name used to redirect to Complainant's website situated at "www.vioc.com/battery-services/", demonstrating that Respondent was aware of Complainant's activities and reputation.

Moreover, Panel finds that the word "battery" that accompanies the trademark VALVOLINE in the disputed domain name consists of a reference to the services provided by Complainant, which indicates that the unauthorized use of the trademark VALVOLINE in the disputed domain name will most likely be of bad faith.

This Panel concludes that the registration of the disputed domain name in the present circumstances allows a finding of bad faith registration and use, considering that it was duly proven that Respondent is using the disputed domain name to divert Internet users to third-party websites via pay-per-click links – which include links that refer to Complainant's business (see Annex 03).

As discussed in *International Business Machines Corporation v. Registration Private, Domains By Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico* (WIPO Case No. [D2021-0633](#)), the use of the disputed domain name to dispose pay-per-click links which include links related to Complainant should be seen as an indicative of bad faith:

“The Domain Name has been used for competing commercial pay-per-click links which is confusing and disruptive in that visitors to the site might reasonably believe services offered on that site are connected to or approved by the Complainant. Reference to the Complainant or its mark in pay-per-click links on the site attached to the Domain Name, and incorporation of the IBM Mark in the Domain Name, suggests actual knowledge of the Complainant and its rights, business, and services at the time of registration. Accordingly, the Panel holds that the Respondent has intentionally attempted to attract for commercial gain Internet users to its website by creating a likelihood of confusion with the Complainant’s trade mark as to the source, sponsorship, affiliation or endorsement of the website or services offered on it. This is also likely to disrupt the business of the Complainant. Further, using the Domain Name to disseminate malware indicates bad faith and constitutes a disruption of the Complainant’s business.”

Finally, it should be noted that the failure of Respondent to respond to Complainant’s contentions (via cease and desist letter or this administrative procedure) can be seen as a sign of bad faith, as concluded by the Panel in *Reed Smith LLP v. Reed Smith Capital* (WIPO Case No. [D2014-2123](#)):

“Complainant sent Respondent a series of letters, requesting that Respondent cease and desist the use of the disputed domain name, as the disputed domain name was confusingly similar to Complainant’s REED SMITH mark. Respondent failed to reply to any of these demand letters. Complainant filed a Complaint in this matter, alleging that the disputed domain name was confusingly similar to Complainant’s REED SMITH mark, that Respondent had no rights or legitimate interests in respect of the disputed domain name and that the disputed domain name was registered and is being used in bad faith. Respondent failed to reply to this Complaint. The Panel notes that paragraph 14(b) of the Rules gives the Panel discretion to draw such inferences from Respondent’s default as it considers appropriate. Accordingly, the Panel finds that Respondent has registered and is using the disputed domain name in bad faith.”

Panel finds that the fact that Respondent did not respond to any of Complainant’s contentions together with other circumstances of the case, such as the use of the disputed domain name to expose pay-per-click links to obtain profit, could be regarded as bad faith.

In light of the above, the Panel finds that the disputed domain name has been registered and is being used in bad faith. Therefore, the requirement of the third element of paragraph 4(a) of the Policy is satisfied.

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 <valvolinebattery.com> be transferred to Complainant.

/Gabriel F. Leonardos/

Gabriel F. Leonardos

Sole Panelist

Date: July 5, 2022