

ADMINISTRATIVE PANEL DECISION

Valvoline Licensing and Intellectual Property LLC v. 石磊 (Lei Shi)
Case No. D2022-2084

1. The Parties

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

The Respondent is 石磊 (Lei Shi), China.

2. The Domain Names and Registrars

The disputed domain names <valvolinecasback.com> and <wwwvalvolinecashback.com> are registered with Cloud Yuqu LLC (the “Registrar”).

The disputed domain names <valvolinecashbac.com> and <valvolinecashbak.com> are registered with Chengdu West Dimension Digital Technology Co., Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on June 9, 2022. On June 9, 2022, the Center transmitted by email to the Registrars a request for registrar verification in connection with the disputed domain names. On June 10, 2022, the Registrars transmitted by email to the Center their verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on June 10, 2022, providing the registrant and contact information disclosed by the Registrars, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint in English on June 17, 2022.

On June 10, 2022, the Center transmitted an email communication to the Parties in English and Chinese regarding the language of the proceeding. On June 17, 2022, the Complainant submitted its request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

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 in English and Chinese of the Complaint, and the proceedings commenced on June 20, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 10, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 11, 2022.

The Center appointed Jonathan Agmon as the sole panelist in this matter on July 19, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant, Valvoline Licensing and Intellectual Property LLC, was formerly known as Valvoline Inc. which was founded in 1866 by Dr. John Ellis, the inventor of the first lubricating oil and the originator of the VALVOLINE trademark. For over 150 years, VALVOLINE has been one of the most recognized and respected premium consumer brands in the global automotive lubricant industry.

Today, the Complainant is known as a leading worldwide producer and distributor of premium branded automotive, commercial and industrial lubricants, and automotive chemicals. The Complainant states that it operates and franchises more than 1,500 Valvoline Instant Oil Change centers in the United States and has a growing international presence with its products being sold in over 140 countries. The Complainant also states that it has a strong Internet presence through its primary website “www.valvoline.com” and various social media platforms including Facebook, Twitter, and Instagram, all of which enjoy high volume visitor traffic and following. The Complainant further states that it has made significant investments over the years to advertise, promote, and protect its trademarks through various forms of media, including the Internet.

The Complainant is the owner of numerous trademark registrations for VALVOLINE worldwide, including but not limited to the following (collectively referred to as the “VALVOLINE Marks”):

- China Trademark Registration No. 162814 for VALVOLINE, registered on September 30, 1982;



- China Trademark Registration No. 1972160 for  , registered on August 7, 2003;

- China Trademark Registration No. G568949A for VALVOLINE, registered on March 19, 1991;

- China Trademark Registration No. 34029542 for VALVOLINE, registered on June 14, 2019;

- China Trademark Registration No. 7906409 for VALVOLINE, registered on January 21, 2011;



- China Trademark Registration No. 2020512 for  , registered on February 21, 2005;

- United States Trademark Registration No. 0053237 for VALVOLINE, registered on May 29, 1906;

- United States Trademark Registration No. 0670453 for VALVOLINE, registered on December 2, 1958; and

- International Trademark Registration No. 568949A for VALVOLINE, registered on March 19, 1991.

The Complainant also states that it owns the domain name <valvolinecashback.com> since July 31, 2020.

The disputed domain names were all registered on November 14, 2021 and resolve to active websites hosting Pay-Per-Click (“PPC”) links to third parties’ websites.

5. Parties' Contentions

A. Complainant

The Complainant argues that the disputed domain names are confusingly similar to the Complainant's registered VALVOLINE Marks as the disputed domain names comprise of the Complainant's VALVOLINE mark or the deliberate misspelling or typosquatted version thereof and/or the addition of the generic term "cashback" with typographical errors and generic Top-Level Domain ("gTLD") ".com".

The Complainant also argues that the Respondent has no rights or legitimate interests in respect of the disputed domain names as it has not licensed or permitted the Respondent to use any of its trademarks or register the disputed domain names. The Respondent is not using the disputed domain names in connection with a *bona fide* offering of goods or services and is not making a legitimate noncommercial or fair use of the disputed domain names.

The Complainant further argues that the disputed domain names were registered and are being used in bad faith as the Respondent was well aware of the Complainant and its VALVOLINE Marks at the time of registration of the disputed domain names and there is no plausible good faith use to which the disputed domain names can be put to.

B. Respondent

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

6. Discussion and Findings

6.1 Language of the Proceeding

Paragraph 11 of the Rules provides that: "(a) Unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding."

The language of the Registration Agreement for the disputed domain names is Chinese.

The Complainant requested that the language of the proceeding be English.

The Respondent did not comment on the language of the proceeding.

The Panel cites the following with approval:

"Thus, the general rule is that the parties may agree on the language of the administrative proceeding. In the absence of this agreement, the language of the Registration Agreement shall dictate the language of the proceeding. However, the Panel has the discretion to decide otherwise having regard to the circumstances of the case. The Panel's discretion must be exercised judicially in the spirit of fairness and justice to both parties taking into consideration matters such as command of the language, time, and costs. It is important that the language finally decided by the Panel for the proceeding is not prejudicial to either one of the parties in his or her abilities to articulate the arguments for the case." (See *Groupe Auchan v. xmxzl*, WIPO Case No. [DCC2006-0004](#)).

The Panel finds that in the present case, the following should be taken into consideration upon deciding on the language of the proceeding:

(i) the Complainant is unable to communicate in Chinese and may be unduly disadvantaged by having to

conduct the proceeding in the Chinese language;

(ii) the disputed domain names consist of Latin characters;

(iii) the disputed domain names' websites feature various third-party links in English; and

(iv) the term "valvoline cashback" which is the dominant portion of the disputed domain names do not carry any specific meaning in the Chinese language.

Upon considering the above, the Panel determines that English be the language of the proceeding.

6.2 Substantive Issues

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires the complainant to show that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights.

A registered trademark provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner. The Complainant has provided evidence that it owns the VALVOLINE Marks.

The disputed domain name <wwwvalvolinecashback.com> comprises the Complainant's VALVOLINE trademark in its entirety with adding the prefix "www" to the VALVOLINE mark and the addition of the term "cashback" which does not prevent the finding of confusing similarity. The disputed domain names <valvolinecasback.com>, <valvolinecashbac.com>, and <valvolinecashbak.com> incorporate the Complainant's VALVOLINE trademark in its entirety and the addition of typographical error variations of the term "cashback" and the gTLD ".com" which also do not prevent the finding of confusing similarity.

It is established that where a trademark is recognizable within the disputed domain name, the addition of other terms would not prevent a finding of confusing similarity under the first element. (See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8). It is further established that the applicable gTLD is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test ([WIPO Overview 3.0](#), section 1.11.1).

The disputed domain names consist of the Complainant's VALVOLINE mark in its entirety and the addition of the term "cashback" with typographical errors or the term "www" and gTLD ".com" which in the Panel's view does not prevent a finding of confusing similarity with the Complainant's trademark.

Therefore, the Panel finds that the disputed domain names are confusingly similar to a trademark in which the Complainant has rights and the element under paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

Paragraph 4(a)(ii) of the Policy requires the complainant to show that the respondent has no rights or interests in respect of the disputed domain name. Once the complainant establishes a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name, the burden of production shifts to the respondent to show that it has rights or legitimate interests in respect to the disputed domain name (see [WIPO Overview 3.0](#), section 2.1).

In the present case, the Complainant has demonstrated *prima facie* that the Respondent lacks rights or legitimate interests in respect of the disputed domain names and the Respondent has failed to assert any such rights or legitimate interests.

The Complainant provided evidence that it owns trademark registrations of the VALVOLINE Marks long before the date that the disputed domain names were registered, and that it is not affiliated with nor has it licensed or otherwise permitted the Respondent to use the Complainant's trademarks (see *LEGO Juris A/S v. DomainPark Ltd, David Smith, Above.com Domain Privacy, Transure Enterprise Ltd, Host master*, WIPO Case No. [D2010-0138](#)).

The Complainant also provided evidence that the Respondent is not commonly known by the disputed domain names (see [WIPO Overview 3.0](#), section 2.3). The Complainant also submitted evidence that its registrations and use of the VALVOLINE Marks predate the registration of the disputed domain names by many years, and that the disputed domain names are typosquatted versions of the Complainant's own domain name which is further proof that the Respondent has no rights or legitimate interests under the Policy (see *JCDecaux SA v. Pascal Ijeoma, Billcoin Company*, WIPO Case No. [DCO2018-0040](#); *Redbox Automated Retail, LLC d/b/a Redbox v. Milen Radumilo*, WIPO Case No. [D2019-1600](#); *River Light V, L.P., Tory Burch LLC v. Kung Chen Chang, PRIVATE*, WIPO Case No. [D2018-0046](#)).

The Complainant further submitted evidence that the disputed domain names resolve to parking pages with PPC links which past UDRP panels have found is not a *bona fide* offering of goods or services or legitimate noncommercial or fair use of the disputed domain name (see *Mayflower Transit LLC v. Domains by Proxy Inc./Yariv Moshe*, WIPO Case No. [D2007-1695](#)).

The Respondent did not submit a Response in the present case and did not provide any explanation or evidence to show rights or legitimate interests in the disputed domain names sufficient to rebut the Complainant's *prima facie* case. In the particular circumstances of the present case, the Respondent's use of the disputed domain names to host parked pages comprising PPC links that appear to be which appear to generate click-through commissions does not represent a *bona fide* offering of goods or services.

The Panel is therefore of the view that the Respondent has no rights or legitimate interests in respect of the disputed domain names and accordingly, paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

The complainant must show that the respondent registered and is using the disputed domain name in bad faith (Policy, paragraph 4(a)(iii)). Paragraph 4(b) of the Policy provides circumstances that may evidence bad faith under paragraph 4(a)(iii) of the Policy.

The Complainant has submitted evidence that the disputed domain names resolve to parked pages comprising PPC links which appear to generate click-through commissions.

Further, the Complainant also owns the domain name <valvolinecashback.com> which provides its customers a cashback reward system for the purchase of the Complainant's products. Notably, the disputed domain names appear to be typosquatted versions of the Complainant's VALVOLINE mark and domain name.

In this case, the evidence shows that the Complainant's marks have attained significant goodwill and reputation. The significant goodwill and reputation of the Complainant's marks is evidence that the Respondent is unlikely to have registered the disputed domain names without sight and knowledge of the Complainant's marks and it is implausible that there is any good faith use to which the (typo) disputed domain names may be put to. It is also the Complainant's evidence that the Respondent could not have registered the disputed domain names without prior knowledge of the Complainant's marks as the Respondent's name has no connection with the Complainant's VALVOLINE Marks which were registered long ago. This is another indication of bad faith on the part of the Respondent (see *Boursorama SA v. Estrade Nicolas*, WIPO Case No. [D2017-1463](#)).

The Complainant also provided evidence of a press release dated October 26, 2021, relating to its collaboration with Tuhu in China for the launch of a new product. Given the particular circumstances in the

present case, the Panel is of the position that it is not a coincidence that the disputed domain names were registered on November 14, 2021, shortly after the press release, which further demonstrates bad faith on the part of the Respondent.

The Respondent did not submit a Response in this proceeding which is a further indication of the Respondent's bad faith, which was considered by the Panel.

In the particular circumstances of the present case and based on the fact that the disputed domain names' websites displayed the Complainant and/or its VALVOLUME mark, including in relation to "lube oil", "Valvoline oil coupons", "credit card apply", "auto body shop software", and "instant cash loan", it is clear to the Panel that the Respondent specifically targeted the Complainant and its marks and registered the disputed domain names to divert Internet traffic and benefit commercially from unsuspecting Internet users seeking out the Complainant.

Based on the evidence presented to the Panel, including the confusing similarities between the disputed domain names and the Complainant's marks, the fact that the disputed domain names were used to host parked pages comprising PPC links to generate click-through commissions, the fact that no Response was submitted by the Respondent in response to the Complaint, the fact that the Respondent did not respond to the Complainant's cease and desist letter sent prior to the proceedings, and the fact that the Respondent has a long history of abusive domain name disputes against third-party trademark owners, the Panel draws the inference that the disputed domain names were registered and are 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 disputed domain names, <valvolinecasback.com>, <valvolinecashbac.com>, <valvolinecashbak.com>, and <wwwvalvolinecashback.com>, be transferred to the Complainant.

/Jonathan Agmon/

Jonathan Agmon

Sole Panelist

Date: August 2, 2022