

ADMINISTRATIVE PANEL DECISION

Valvoline Licensing and Intellectual Property LLC v. Lak Si Case No. D2022-3714

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 Lak Si, United States.

2. The Domain Name and Registrar

The disputed domain name <valvolinecouponcode.com> is registered with Amazon Registrar, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 5, 2022. On October 6, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 7, 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 (On behalf of valvolinecouponcode.com Owner, Identity Protection Service, United Kingdom) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 10, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on October 10, 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 the Respondent of the Complaint, and the proceedings commenced on October 11, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 31, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 4, 2022.

The Center appointed Dennis A. Foster as the sole panelist in this matter on November 14, 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 is a United States company that has been in operation for more than a century, during which time it has produced and sold automotive lubricant products throughout the world. Since its inception, the Complainant has conducted its business under the VALVOLINE mark, which is registered with several national and international trademark authorities, including the United States Patent and Trademark Office (“USPTO”).(e.g., Registration No. 0053237; registered May 29, 1906) and the United Kingdom Intellectual Property Office (“UKIPO”) (e.g., Registration No. UK00000753182; registered April, 25 1956).

The Respondent owns the disputed domain name, which was created on April 22, 2022. The disputed domain name resolves to a website that contains the Complainant’s VALVOLINE trademark and presents links to third-party websites, some of which offer products that compete directly with those of the Complainant.

5. Parties’ Contentions

A. Complainant

- The Complainant is a United States company that has produced and sold automotive lubricant products for more than 100 years, its parent company having been founded in 1866. Now, the Complainant has a presence in over 140 countries in the world, and operates or franchises more than 1,500 service centers in the United States. The Complainant conducts its business under its VALVOLINE trademark, which is registered with several authorities, including the USPTO and UKIPO. The Complainant also utilizes its website found at “www.valvoline.com” to further its operations.

- The disputed domain name is confusingly similar to the Complainant’s VALVOLINE trademark. The disputed domain name contains the mark in its entirety, merely adding only the terms, “coupon” and “code”, both of which apply directly and confusingly to the Complainant’s coupon offerings found at its “www.valvoline.com” website. The addition of the generic Top-Level Domain (“gTLD”), “.com”, is immaterial in the evaluation of confusing similarity.

- The Respondent has no rights or legitimate interests in the disputed domain name. The Complainant’s trademark registrations give it the exclusive right to use the VALVOLINE mark in commerce. As the Respondent’s name does not resemble the disputed domain name in any manner, there is no evidence that the Respondent is commonly known as the disputed domain name. Moreover, the disputed domain name is attached to a website that presents links to third-party websites, some of which compete directly with the Complainant’s business. That website also contains the Complainant’s trademark image. Such use of the disputed domain name comports with neither a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use of the disputed domain name.

- The disputed domain name was registered and is being used in bad faith. The Respondent’s use of the Complainant’s trademark on the website connected with the disputed domain name demonstrates that the Respondent was well aware of the mark. Furthermore, as the Complainant’s trademark is well known throughout the world, the Respondent’s bad faith in registration and use of the disputed domain name is clearly established. Also, the use of the disputed domain name for a website that includes links to third-party websites, presumably to allow the Respondent to collect pay-per-click (“PPC”) fees, again demonstrates bad faith registration and use of the disputed domain name. Lastly, the Respondent’s use of a privacy service to

hide his ownership identity is clear evidence of his bad faith registration and use of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

In accordance with Policy, paragraphs 4(a)(i) - (iii), the Panel may find for the Complainant and grant it a transfer of the disputed domain name, if the Complainant establishes that:

- The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- The Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- The disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

Given the proper evidence of its valid registrations with the USPTO and UKIPO for the VALVOLINE trademark, the Complainant has convinced the Panel that the Complainant has sufficient rights in that mark to satisfy Policy, paragraph 4(a)(i). See *LO 337 IP Holding, LLC v. John Williams, J Entertainment ATL / John Williams, J, Entertainment Productions*, WIPO Case No. [D2019-2339](#) ("The Panel concludes that Complainant has rights in the mark WORLD STAR HIP HOP through registration with the USPTO."); and *Daily Mail and General Trust Plc v. Sun Stefan*, WIPO Case No. [D2018-0818](#) ("The Panel accepts the uncontested evidence in the form of a copy of the UKIPO registration document that the Complainant has rights as required under the Policy in the trademark DMGT.").

Clearly, the disputed domain name is not identical to the VALVOLINE trademark. However, the disputed domain name does include that entire mark as the first and dominant element. Moreover, the Panel finds that the additional two terms, "coupon" and "code", do little to avoid confusing similarity between the disputed domain name and the trademark. Finally, the addition of the ".com" gTLD is not relevant in the Panel's evaluation of confusing similarity under the Policy. Consequently, the Panel determines that the disputed domain name is confusingly similar to the Complainant's trademark. See *Travelscape, LLC v. WhoisGuard, Inc. / Waseem Hassan*, WIPO Case No. [D2018-2088](#) (finding <travelcitycouponcodes.com> to be confusingly similar to the TRAVELOCITY mark); and *Hertz System Inc. v. Home, Khuong Mai Ngoc*, WIPO Case No. [D2012-1946](#) (finding <hertzcouponcode.net> to be confusingly similar to the HERTZ mark).

Accordingly, the Panel finds that the Complainant has demonstrated that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

It is now axiomatic under the Policy that a complainant need sustain a mere *prima facie* case that a respondent has no rights or legitimate interests in a disputed domain name before that respondent must come forward with relevant evidence to the contrary. See *OSRAM GmbH v. Mohammed Rafi/Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org*, WIPO Case No. [D2015-1149](#) ("... once the complainant makes a *prima facie* showing under paragraph 4(a)(ii) of the Policy, paragraph 4(c) shifts the burden of production to the respondent to come forward with evidence of rights or legitimate interests in a disputed domain name."); and *Wal-Mart Stores, Inc. v. WalMart Careers, Inc.*, WIPO Case No. [D2012-0285](#).

In this case, the Panel has concluded that the disputed domain name is confusingly similar to the Complainant's VALVOLINE trademark. The Complainant asserts correctly that it possesses sole rights in that mark, implying that it has not granted any license or other authority for the Respondent to use the mark for any purpose, including for a domain name. Therefore, the Panel finds that the Complainant has sustained a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name.

Having filed no Response, the Respondent presents no rebuttal to the Complainant's *prima facie* case. However, per the requirements of the Policy, the Panel will examine the full record in this case to ascertain whether there is any reason to deny the validity of that *prima facie* case. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 2.1 ("The panel may draw inferences from the absence of a response as it considers appropriate, but will weigh all available evidence irrespective of whether a response is filed.").

The Complaint includes persuasive evidence that the Respondent has used the disputed domain name to resolve to a website that contains links to third-party websites, some of which have offerings that compete directly with those of the Complainant. In line with many prior UDRP cases, the Panel finds that the Respondent's usage of the disputed domain name in that manner is not "a *bona fide* offering of goods or services" pursuant to paragraph 4(c)(i) of the Policy. See *Merck Sharp & Dohme Corp. v. Domain Administrator, PrivacyGuardian.org / George Ring, DN Capital Inc.*, WIPO Case No. [D2017-0302](#) ("... using a domain name incorporating the Complainant's mark to host sponsored links associated with the Complainant's area of business cannot be a *bona fide* offering of goods or services."); and *Virgin Enterprises Limited v. LINYANXIAO aka lin yanxiao*, WIPO Case No. [D2016-2302](#).

Furthermore, the record shows no evidence whatsoever for the Panel to believe that the Respondent, Lak Si, has ever been commonly known as the disputed domain name, <valvolinecouponcode.com>. Thus, the Panel determines that Policy, paragraph 4(c)(ii) is also inapplicable to this case.

Finally, the Panel concludes that the third-party website linkages, found on the disputed domain name's resolving website as described above, mean that the disputed domain name is not being used for "legitimate noncommercial or fair use" purposes, as such linkages are most likely used by the Respondent to collect PPC revenue. Ergo, paragraph 4(c)(iii) of the Policy is inapplicable as well. See *Virgin Enterprises Limited v. LINYANXIAO aka lin yanxiao, supra*.

Moreover, the composition of the disputed domain name, which incorporates the Complainant's VALVOLINE trademark in its entirety together with the terms relating to the Complainant's business operations, cannot constitute fair use as it effectively suggests sponsorship or endorsement by the Complainant. See [WIPO Overview 3.0](#), section 2.5.1.

Therefore, as the record in this proceeding provides no effective rebuttal to the Complainant's *prima facie* case, the Panel determines that that case must prevail.

Accordingly, the Panel finds that the Complainant has demonstrated that the Respondent has no rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

As referred to above, the Panel has determined that the disputed domain name is attached to a website that presents links to third-party websites, some of which offer products competing with those sold by the Complainant. Moreover, the Panel is of the opinion that the Respondent undoubtedly uses those links to gain PPC fees. Therefore, as the disputed domain name has been found to be confusingly similar to the Complainant's trademark, the Panel determines that the Respondent is intentionally deriving commercial gain by attracting Internet users due to likely confusion between the disputed domain name and the Complainant's mark as to the source, sponsorship, affiliation or endorsement of the Respondent's attached website in bad faith under Policy, paragraph 4(b)(iv). See *Fontem Holdings 4, B.V. v. J- B-, Limestar Inc.*,

WIPO Case No. [D2016-0344](#) (“... the Respondent’s use of the Domain Name to resolve to a parking page containing sponsored links constitutes bad faith [...] in accordance with paragraph 4(b)(iv) of the Policy.”); and *Serta Inc. v. Charles Dawson*, WIPO Case No. [D2008-1474](#) (“Respondent’s bad faith is further illustrated by the domain name’s resolution to a PPC parking page with links to websites selling products competing with Complainant’s. It is now well-established that the use of a parking page in this manner is strong evidence of bad faith.”).

Also, in light of the Respondent’s undoubted PPC usage of the disputed domain name, the Panel finds that the Respondent’s use of a privacy service to prevent disclosure of his identity relative to the disputed domain name is a further indication that the disputed domain name was registered and is being used in bad faith. See *WhatsApp, Inc. v. Whois Agent, Whois Privacy Protection Service, Inc. / Mohammed Alkalbani, Ops Alkalbani, M. Rashid Alkalbani*, WIPO Case No. [D2016-2299](#) (“It is this Panel’s opinion that when it is combined with other elements such as the registration of a domain name corresponding to and/or containing a renowned third-party trademark, the use of a privacy shield is, on the balance of probability, to be considered an inference of bad faith registration and use of the disputed domain name.”).

Accordingly, the Panel finds that the Complainant has demonstrated that the disputed domain name was registered and is 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 name, <valvolinecouponcode.com>, be transferred to the Complainant.

/Dennis A. Foster/

Dennis A. Foster

Sole Panelist

Date: November 28, 2022