

ADMINISTRATIVE PANEL DECISION

Valvoline Licensing and Intellectual Property LLC v. Carolina Rodrigues,
Fundacion Comercio Electronico

Case No. D2023-0465

1. The Parties

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

The Respondent is Carolina Rodrigues, Fundacion Comercio Electronico, Panama.

2. The Domain Name and Registrar

The disputed domain name <valvolineorders.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 February 1, 2023. On February 1, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 2, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on February 8, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 28, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 1, 2023.

The Center appointed Leon Trakman as the sole panelist in this matter on March 16, 2023. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant's business, Valvoline Inc., was founded in 1866. It founded its Valvoline Instant Oil ChangeSM in 1986, to provide drivers with drive through oil changes and maintenance services. The Complainant is quoted on the New York Stock Exchange, as VVV.

The Complainant has registered trademark with the United Kingdom Intellectual Property Office (UKIPO), the United States Patent and Trademark Office (USPTO), and the World Intellectual Property Office (WIPO). These include:

| TRADEMARK | JURISDICTION/ TM OFFICE | REGISTRATION No. | REGISTRATION DATE | IC CLASS |
|-----------|-------------------------|------------------|-------------------|------------|
| VALVOLINE | US / USPTO | 0053237 | May 29, 1926 | 004 |
| VALVOLINE | UK / IPO | UK00000753182 | April 25, 1956 | 4 |
| VALVOLINE | UK / IPO | UK00000846891 | March 26, 1963 | 4 |
| VALVOLINE | UK / IPO | UK00000889516 | January 19, 1966- | 2 |
| VALVOLINE | WO / WIPO | 568949A | March 3, 1991 | 01, 03, 04 |

The Complainant has a primary website at "www.valvoline.com". It also hosts social media platforms including on Facebook, Twitter and Instagram. Both its website and media platforms are widely accessed.

The disputed domain name was registered on June 14, 2022, and resolves to a parking page with third party pay-per-click ("PPC") links that divert traffic to third party websites.

5. Parties' Contentions

A. Complainant

1. The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (Policy, paragraph 4(a)(i))
2. The Respondent has no rights or legitimate interests in respect of the disputed domain name (Policy, paragraph 4(a)(ii))
3. The disputed domain name was registered and is being used in bad faith (Policy, paragraphs 4(a)(iii), 4(b))

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The disputed domain name is identical to the Complainant's VALVOLINE trademark, other than by adding the term, "orders". The mere addition of this term to the Complainant's trademark does not negate the confusing similarity between the disputed domain name and the Complainant's trademark, under Policy, paragraph 4(a)(i). WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") at section 1.8 states "Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative,

meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element”.

Furthermore, the TLD in the disputed domain name is typically disregarded for the first element test of the Policy.. See [WIPO Overview 3.0](#) at section 1.11.1, stipulates that: “The applicable Top Level Domain (“TLD”) in a domain name (e.g., “.com”, “.club”, “.nyc”) is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.”

Accordingly, the Panel determines that the disputed domain name is confusingly similar to the Complainant’s trademark, as provided for by Policy, paragraph 4(a)(i).

B. Rights or Legitimate Interests

The Panel is required to determine whether the Respondent has acquired any rights to or legitimate interests in the disputed domain name within the meaning of the Policy, paragraph 4(c)(ii).

Firstly, there is no evidence that the Respondent is commonly known by the disputed domain name. See *Moncler S.p.A. v. Bestinfo*, WIPO No. [D2004-1049](#).

Secondly, the Respondent is not expressly, impliedly or authorized by the Complainant to use that name. Nor is the Respondent so authorized by an agent of the Complainant.

Thirdly, there is no evidence that the Respondent has any other right or legitimate interest in that name.

There is further evidence supporting the determination that the Respondent has no right to or legitimate interest in the disputed domain name.

Furthermore, the Respondent is using the disputed domain name to direct Internet users to a website featuring links to third-party websites, some of which directly compete with the Complainant’s business. It is reasonable to infer that the Respondent has received PPC fees from the linked websites listed at the disputed domain name’s website. Prior UDRP decisions have held that respondents that monetize domain names using PPC links have not made a *bona fide* offering of goods or services that would give rise to rights or legitimate interests in a disputed domain name. As such, the Respondent is not using the disputed domain name to provide a *bona fide* offering of goods or services as allowed under Policy, paragraph 4(c)(i). Nor is the Respondent making a legitimate noncommercial or fair use of that name as permitted under Policy, paragraph 4(c)(iii). See [WIPO Overview 3.0](#) at section 2.9.

Accordingly, the Panel determines that the Respondent does not have rights to or legitimate interests in the disputed domain name, as provided for by Policy, paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

The Panel is required to determine whether the Respondent registered and is using the disputed domain name in bad faith according to the Policy, paragraph 4(c)(iii).

There is significant evidence on record that the Respondent had knowledge of and familiarity with the Complainant’s brand and business at the time of registering the disputed domain name.

Firstly, the Complainant trademark is globally known; and its products are widely marketed and used in multiple countries. Secondly, the Respondent registered the disputed domain name, which is confusingly similar to the Complainant’s trademark. Thirdly, the Respondent registered that disputed domain name significantly after the Complainant’s registration the VALVOLINE trademark. Fourthly, the Respondent has failed to respond to a cease-and-desist letter, which prior UDRP panels had held could be considered as a consideration in finding bad faith registration and use of a disputed domain name. See *Encyclopedia Britannica v. Zuccarini*, WIPO No. [D2000-0330](#).

Given these facts it is implausible that the Respondent was unaware of the Complainant's trademark at the time of registered the disputed domain name. See *Telstra Corp. Ltd. v. Nuclear Marshmallows*, WIPO No. [D2000-0003](#). It is also implausible that the Respondent registered a domain name that is confusingly similar to the Complainant's trademark without any knowledge of it or its commercial significance. See *Asian World of Martial Arts Inc. v. Texas International Property Associates*, WIPO No. [D2007-1415](#). On the contrary, "the Complainant's worldwide reputation and presence on the Internet, indicates that the Respondent was or should have been aware of the marks prior to registering the disputed domain name". See *Caesar World, Inc. v. Forum LLC*, WIPO No. [D2005-0517](#).

The Respondent is using the disputed domain name in bad faith to confuse Internet users believing that they are accessing for the Complainant's services, and to mislead them as to the source of the domain name and website. By creating this likelihood of confusion between the Complainant's trademarks and the disputed domain name, the Respondent has misrepresented the source, sponsorship, affiliation, or endorsement of the disputed domain name. It has demonstrated the bad faith intention to capitalize on reputation of the Complainant in order to increase traffic to the disputed domain name's website. In resorting to such bad faith use, the Respondent has both sought and secured pecuniary gain by posting multiple PPC links on its website. See Policy, paragraph 4(b)(iv) and [WIPO Overview 3.0](#) at section 3.5.

Finally, the Respondent's pattern of cybersquatting is evident in a series of prior UDRP cases, including in 2022 and 2023 See e.g., *Milliman, Inc. v. Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO No. [D2022-3079](#); *American Airlines, Inc. v. Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2022-4950](#); *Carrefour SA v. Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2023-0004](#)

The Respondent's pattern of cybersquatting is also evidenced by the Complainant by demonstrating that the Respondent held registrations for multiple other domain names, several of which misappropriate the trademarks of well-known brands and businesses.

Prior UDRP panels, have held that a pattern of cybersquatting constitutes bad faith. See paragraph 4(b)(ii) of the Policy.

The Panel determines that the Responded has registered and is using the disputed domain name in bad faith, as provided for by Policy, paragraphs 4(a)(iii), 4(b).

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, <valvolineorders.com>, be transferred to the Complainant.

/Leon Trakman/

Leon Trakman

Sole Panelist

Date: March 30, 2023