

ADMINISTRATIVE PANEL DECISION

VGP IPCo LLC and Valvoline Licensing and Intellectual Property LLC v.
Natalya V Tarasova
Case No. D2024-2410

1. The Parties

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

The Respondent is Natalya V Tarasova, the Russian Federation.

2. The Domain Name and Registrar

The disputed domain names <valvoline-russia.shop>, and <valvoline-ural.shop> (the “Disputed Domain Names”) are registered with RU-CENTER-MSK (Regional Network Information Center, JSC dba RU-CENTER) (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on June 12, 2024. On June 13, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Names. On June 14, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Disputed Domain Names which differed from the named Respondent (Personal data, cannot be publicly disclosed according to applicable laws) and contact information in the Complaint. The Center sent an email communication to the Complainants on June 21, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amended Complaint on June 24, 2024.

On June 21, 2024, the Center informed the parties in Russian and English, that the language of the Registration Agreement for the Disputed Domain Names is Russian. On June 24, 2024, the Complainants requested English to be the language of the proceeding as stated in Section IV of the amended Complaint. The Respondent did not submit any comment on the Complainants’ submission.

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 both English and Russian of the Complaint, and the proceedings commenced on July 1, 2024. In accordance with the Rules, paragraph 5, the due date for Response was July 21, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on July 23, 2024.

The Center appointed Pham Nghiem Xuan Bac as the sole panelist in this matter on August 20, 2024. 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 Complainants operate in the field of automotive lubricant industry and have been selling their products under the VALVOLINE trademarks for over 150 years. VALVOLINE motor oil products are sold in more than 140 countries and territories.

The Complainants own several VALVOLINE trademarks, including but not limited to International Registrations Nos. 679766A designating, inter alia, the Russian Federation, where the Respondent is located, and 568949, registered on August 1, 1997 and March 19, 1991, respectively. Furthermore, the Complainants own domain names <valvoline.com> and <vioc.com>, registered on March 4, 1995 and January 17, 1997 respectively.

The Disputed Domain Names were registered on February 29, 2024. As of the date of filing of the Complaint and this Decision, the Disputed Domain Names do not resolve to an active website, it states in Russian "the website is not published".

5. Parties' Contentions

A. Complainants

The Complainants contend that they have satisfied each of the elements required under the Policy for a transfer of the Disputed Domain Names, as follows:

(i) The Disputed Domain Names are identical or confusingly similar to a trademark or service mark, in which the Complainants have rights.

The Complainants argue that the generic Top-Level Domain ("gTLD") ".shop" is not taken into account when comparing Disputed Domain Names to the Complainants' trademarks.

The Complainants contend that the Disputed Domain Names are confusingly similar to their VALVOLINE trademark, because the Disputed Domain Names can be considered as capturing, in their entirety, the Complainants' VALVOLINE trademark. The mere addition of the hyphens and the terms "russia" and "ural", does not negate finding of confusing similarity between the Disputed Domain Names and the Complainants' trademark.

(ii) The Respondent has no rights or legitimate interests in respect of the Disputed Domain Names.

First, the Complainants contend that the Respondent is not affiliated with/related to them nor licensed/authorized by them in any way to use the VALVOLINE trademarks in connection with a website, a domain name or for any other purpose.

Second, the Complainants assert that the Respondent is not commonly known by the Disputed Domain Names.

Furthermore, the Complainants contend that the registration of the Disputed Domain Names by the Respondent under anonymity is commonly considered as a lack of rights or legitimate interests.

Finally, the Complainants submit that the Respondent is using the Disputed Domain Names to direct Internet users to websites that resolve to holding pages which lack content. The Respondent failed to make use of the Disputed Domain Names' websites and has not demonstrated any attempt to make legitimate use of the Disputed Domain Names and websites, which evinces a lack of rights or legitimate interests.

(iii) The Disputed Domain Names were registered and are being used in bad faith.

Firstly, given the incorporation of the Complainants' VALVOLINE trademark in the Disputed Domain Names and the long use of VALVOLINE trademarks across the world which predates the registration of the Disputed Domain Names, the Complainants find that the Respondent knew, or at least should have known of the existence of the Complainants' trademarks. Thus, the Complainants contend that registration of the Disputed Domain Names containing well-known trademarks constitutes bad faith per se.

Secondly, the Complainants find that the Disputed Domain Names currently resolve to inactive sites and are not being used, and past panels have noted that passively holding a domain name can constitute a factor in finding bad faith registration and use. In this case, the Disputed Domain Names are confusingly similar to the Complainants' trademarks, and the Respondent made no use of the Disputed Domain Names, which should be duly considered in assessing bad faith registration and use.

The Complainants further submit that at the time of initial filing of the Complaint, the Respondent had employed a privacy service to hide its identity, which serves as further evidence of bad faith registration and use.

With the said arguments, the Complainants request that the Disputed Domain Names be transferred to the Complainants.

B. Respondent

The Respondent did not reply to the Complainants' contentions.

6. Discussion and Findings

A. The Respondent's Identity

The Panel notes that at the time the Complaint was filed on June 12, 2024, the Respondent was identified as "Personal data, cannot be publicly disclosed according to applicable laws". On June 14, 2024, the Registrar revealed the underlying registrant of the Disputed Domain Names as "Natalya V Tarasova" with detailed contact information. The Center sent an email communication to the Complainants on June 21, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint.

On June 24, 2024, the Complainants submitted an amended Complaint amending the registrant and contact information as disclosed by the Registrar.

B. Language of the Proceeding

The language of the Registration Agreement for the Disputed Domain Names is Russian. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English. The Complainants requested that the language of the proceeding be English for several reasons, including the fact that:

- i. The Complainants are unable to communicate in Russian and translation of the Complaint would delay the proceedings and adjudication of this matter. Such additional delay poses continuing risks to the Complainants and unsuspecting consumers seeking the Complainants or their products.
- ii. The Disputed Domain Names consist of Latin characters and the dominant feature of these Disputed Domain Names does not carry any specific meaning in the Russian language.
- iii. The use of Russian in this case would entail significant additional costs for the Complainants who already suffer from the Respondent's abuse of the famous VALVOLINE trademarks and brand.

The Respondent did not make any specific submissions with respect to the language of the proceeding.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.1).

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

C. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

The Complainants have shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds that the Complainants have evidenced that they have rights in and to the VALVOLINE trademarks, which were registered in a number of countries before the registration of the Disputed Domain Names.

The entirety of the mark is reproduced within the Disputed Domain Names. Accordingly, the Disputed Domain Names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of the terms "russia", "ural" and the hyphens may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the Disputed Domain Names and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

In addition, the Panel finds, similarly to the other UDRP panels, that the addition of the gTLD ".shop" to the Disputed Domain Names can be disregarded under the first element confusing similarity test because it is viewed as a standard registration requirement. See the section 1.11 of the [WIPO Overview 3.0](#).

The Panel finds the first element of the Policy has been established.

D. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although 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 difficult 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 (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainants have established a prima facie case that the Respondent lacks rights or legitimate interests in the Disputed Domain Names. The Respondent has not rebutted the Complainants’ prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the Disputed Domain Names such as those enumerated in the Policy or otherwise.

Paragraph 4(c) of the Policy lists circumstances, in particular but without limitation, which, if found by the Panel to be proved, demonstrate the Respondent’s rights or legitimate interests in the Disputed Domain Name for the purposes of paragraph 4(a)(ii) of the Policy, including:

- “(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

Regarding paragraph 4(c)(i) of the Policy, the Panel finds, in light of the Complainants’ asserted facts, that no license, permission or authorization in any kind to use the Complainants’ VALVOLINE trademarks have been granted to the Respondent. There is no evidence available that the Respondent holds any registered or unregistered trademark rights in any jurisdiction related to “VALVOLINE”. Thus, the Panel finds that the Respondent has no rights in the VALVOLINE trademarks.

The Disputed Domain Names are resolving to inactive websites as of the date of filing of the Complaint and this Decision. The Panel also notes that it has been more than 6 months from the registration of the Disputed Domain Names to the date of this Decision, so the Respondent has had sufficient time to build its websites under the Disputed Domain Names if it has such intention. However, no evidence is available on the Respondent’s preparation to use the Disputed Domain Names in connection with a bona fide offering of goods or services. Hence, in absence of this evidence, the Panel is of the view that paragraph 4(c)(i) is not met.

Regarding paragraphs 4(c)(ii) and 4(c)(iii) of the Policy, the Panel finds no evidence indicating that the Respondent, whether as an individual, business, or entity, is commonly known by the Disputed Domain Names, nor is the Respondent making a legitimate noncommercial or fair use of them. In fact, by incorporating the Complainants’ distinctive trademark in its entirety within the Disputed Domain Names, the composition of the Disputed Domain Names affirms the Respondent’s intention of taking unfair advantage of the likelihood of confusion between the Disputed Domain Names and the Complainants as to the origin or affiliation of the websites at the Dispute Domain Names, contrary to the fact, which cannot constitute fair use.

In addition, when a domain name closely matches a complainant’s trademark, this is an indication of potential confusion or implied endorsement. In this present case, the Disputed Domain Names fully replicate the Complainants’ VALVOLINE trademarks. Furthermore, the inclusion of the “.shop” gTLD may increase confusion by suggesting a connection to the Complainants’ sale efforts. Considering the Complainants’

broad presence, it is likely that consumers might mistakenly link the Disputed Domain Names to the Complainants. Therefore, the Panel confirms the findings that the Respondent is not making a legitimate noncommercial or fair use of the Disputed Domain Names.

Based on the foregoing findings, the Panel finds the second element of the Policy has been established.

E. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith, including:

“(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location.”

In the present case, the Panel finds that the Complainants have put forth evidence that the Respondent has registered and used the Disputed Domain Names in bad faith. The Respondent did not reply to the Complainants’ contentions and therefore, did not refute the Complainants’ contentions.

The Panel further finds that the Complainants’ VALVOLINE trademarks have been registered in multiple countries, including in the Russian Federation, where the Respondent is located. These trademark registrations precede the registration date of the Disputed Domain Names significantly.

In this case, the Panel finds it highly unlikely that the Respondent was unaware of the Complainants and their trademark rights at the time of registering the Disputed Domain Names. In fact, the Disputed Domain Names in question incorporate the VALVOLINE trademarks in entirety with the hyphens and the terms “russia” or “ural” added and are paired with the “.shop” gTLD that relates to the Complainants’ business activities. The Complainants’ trademarks had been in use for several decades prior to the registration of the Disputed Domain Names. The extensive use and recognition of the VALVOLINE trademarks suggest that the Respondent was likely aware of the Complainants’ trademarks at the time of registration. The Panel considers such registration is an attempt by the Respondent to take advantage of the Complainants’ goodwill. See the section 3.2.1 of the [WIPO Overview 3.0](#).

It is further noted that as of the date of this Decision, the Disputed Domain Names have not been used. From the inception of the UDRP, panelists have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding (see section 3.3 of [WIPO Overview 3.0](#)).

Based on the foregoing findings, the Panel finds that the Complainants have established the third element of the Policy.

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 <valvoline-russia.shop>, <valvoline-ural.shop> be transferred to the Complainants.

/Pham Nghiem Xuan Bac/

Pham Nghiem Xuan Bac

Sole Panelist

Date: August 30, 2024