

ADMINISTRATIVE PANEL DECISION

VGP IPCo LLC, Valvoline Licensing and Intellectual Property LLC v. Rajpoot syani, Jhansi

Case No. D2024-4244

1. The Parties

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

The Respondent is Rajpoot syani, Jhansi, India.

2. The Domain Name and Registrar

The disputed domain name <valvolineglo.top> 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 October 15, 2024. On the same day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same day, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainants on October 16, 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 October 18, 2024.

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 22, 2024. In accordance with the Rules, paragraph 5, the due date for Response was November 11, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 12, 2024.

The Center appointed Federica Togo as the sole panelist in this matter on November 19, 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 Complaint was filed by VGP IPCo LLC and by Valvoline Licensing and Intellectual Property LLC. It results from the Complainants' undisputed allegations that it is a worldwide producer and distributor of premium branded automotive, commercial and industrial lubricants, and automotive chemical. It currently sells in more than 140 countries and territories and drives industry solutions for every engine and drivetrain, including high-mileage and heavy-duty vehicles, offered at more than 80,000 locations.

The Complainant VGP IPCo LLC is the registered owner of several trademarks worldwide for VALVOLINE, e.g., European Union trademark registration No. 009847773 VALVOLINE, registered on October 25, 2011 for goods and services in classes 1, 4 and 35.

The Complainant Valvoline Licensing and Intellectual Property LLC is the registered owner of many trademarks worldwide, e.g., United States trademark registration No. 1463629 VALVOLINE, registered on November 3, 1987 for goods in class 25.

They use the domain names <valvoline.com> and <valvolineglobal.com> as primary websites.

The disputed domain name was registered on June 1, 2024. Furthermore, the undisputed evidence provided by the Complainants proves that the disputed domain name resolved to a website, showing image in the field of activity of the Complainants. It currently resolves to an inactive webpage.

Finally, the Complainants sent a cease-and-desist letter to the Respondent on June 28, 2024. The Respondent did not reply to it, despite of many reminders.

5. Parties' Contentions

A. Complainant

The Complainants contend that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainants contend that the disputed domain name is confusingly similar to the Complainants' trademark, since it includes the entirety of the VALVOLINE trademark, simply adding the term "glo" to the end of the trademark.

The Complainants further contend the trademark VALVOLINE be distinctive and well-known.

The Complainants further contend that the Respondent has no rights or legitimate interests in the disputed domain name. According to the Complainants, Respondent is not sponsored by or affiliated with the Complainants in any way. The Complainants have not given Respondent permission to use Complainants' trademarks in any manner, including in domain names. Furthermore, the Complainants have not licensed, authorized, or permitted the Respondent to register domain name incorporating Complainants' trademark. The Respondent is not commonly known by the disputed domain name. The Respondent is using the disputed domain name to redirect Internet users to a website that resolves to a "server error page". Historically, the disputed domain name resolved to a registration page or log-in page for nonregistered users, where they are required to key in usernames, passwords and phone numbers.

Finally, the Complainants contend that the disputed domain name was registered and is being used in bad faith. According to the Complainants, the Complainants and VALVOLINE trademark are known internationally. At the time of registration of the disputed domain name, the Respondent knew, or at least should have known, of the existence of the Complainants' trademarks. Historically, the Respondent was using the disputed domain name's website to potentially launch a phishing attack, which is evidence of bad faith use. The Respondent has reproduced the Complainants' trademark in the disputed domain name that any Internet user with the misfortune of mistakenly landing at the disputed domain name could easily be deceived and misled into believing that the disputed domain name is officially associated with the Complainants. Respondent had employed a privacy service to hide its identity. Furthermore, the Respondent has ignored Complainants' attempts to resolve this dispute outside of this administrative proceeding. Past panels have held that failure to respond to a cease-and-desist letter may properly be considered a factor in finding bad faith registration and use of a domain name.

B. Respondent

The Respondent did not reply to the Complainants' contentions.

6. Discussion and Findings

6.1 Procedural issues – Consolidation of the Complainants

The Complaint was filed by both VGP IPCo LLC and by Valvoline Licensing and Intellectual Property LLC. In addition, each of the Complainants are individually the owner of registered trademarks for VALVOLINE in different jurisdictions.

As set forth in section 4.11.1 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"): "In assessing whether a complaint filed by multiple complainants may be brought against a single respondent, panels look at whether (i) the complainants have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants in a similar fashion, and (ii) it would be equitable and procedurally efficient to permit the consolidation".

In the light of the above, the Panel finds that the Complainants have a specific common grievance against the Respondent because they share a common legal interest in the trademark rights on which this Complaint is based since both the Complainants own registrations for the trademark VALVOLINE and allege a corporate connection. Against this background, the Panel does not see reasons why a consolidated Complaint brought by the Complainants against a single Respondent would not be fair and equitable. Moreover, the Respondent failed to come forward with any allegations or evidence to object the consolidation. For reasons of procedural efficiency, fairness and equity the Panel therefore accepts the joint Complaint. Therefore, throughout the remainder of the current Decision, the Panel will refer to both the Complainants as "the Complainant".

6.2 Substantive issues

Paragraph 15(a) of the Rules instructs this Panel to "decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable". Paragraph 4(a) of the Policy requires a complainant to prove each of the following three elements in order to obtain an order that each disputed domain name be transferred or cancelled:

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

(ii) the 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 Panel will therefore proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied.

A. 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 Complainant has 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 entirety of the VALVOLINE mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms here "glo" may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

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

B. 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 Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

According to the Complaint, which has remained unchallenged, the Complainant has no relationship in any way with the Respondent and did, in particular, not authorize the Respondent's use of the Complainant's trademark e.g., by registering the disputed domain name. Furthermore, the Panel notes that there is no evidence showing that the Respondent might be commonly known by the disputed domain name in the sense of paragraph 4(c)(ii) of the Policy.

Moreover, the Panel notes that the disputed domain name contains the Complainant's trademark VALVOLINE, and that more likely than not, this trademark is not a trademark that one would legitimately adopt as a domain name unless to suggest an affiliation with the Complainant. The Panel finds it most likely that the Respondent registered the disputed domain name with the intention to take advantage of the Complainant's reputation by registering a domain name containing the Complainant's trademark with the intent to mislead Internet users.

This is also confirmed by the content of the website to which the disputed domain name resolved. In fact, the undisputed evidence provided by the Complainant proves that the disputed domain name resolved to a website, showing image in the field of activity of the Complainant, tending to suggest sponsorship or endorsement by the Complainant.

The content of the website directly targeting the Complainant's field of activity enhances the false impression that the disputed domain name is somehow officially related to the Complainant and official websites promoting the Complainant's business.

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

C. 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.

One of these circumstances is that the respondent by using the disputed domain name, has intentionally attempted to attract, for commercial gain, Internet users to its 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 its website or location or of a product or service on its website or location (paragraph 4(b)(iv) of the Policy).

In the present case, the Panel notes that the Complainant's trademarks have existed for many years. Therefore, this Panel has no doubt that the Respondent positively knew the Complainant and its trademarks when it registered the disputed domain name. Registration of the disputed domain name by the Respondent in awareness of the VALVOLINE mark and in the absence of rights or legitimate interests in this case amounts to registration in bad faith.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

On this regard, the further circumstances surrounding the disputed domain name's registration and use confirm the findings that the Respondent has registered and is using the disputed domain name in bad faith:

- (i) the nature of the disputed domain name (i.e., a domain name incorporating the Complainant's mark);
- (ii) the content of the website to which the disputed domain name directs (i.e. showing image in the field of activity of the Complainant);
- (iii) a clear absence of rights or legitimate interests coupled with no credible explanation for the Respondent's choice of the disputed domain name;
- (iv) the respondent's concealing its identity;
- (v) the Respondent did not reply to cease-and-desist letter.

The Panel finds that the Complainant has 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 name <valvolineglo.top> be transferred to the Complainant.

/Federica Togo/

Federica Togo

Sole Panelist

Date: December 2, 2024