

ADMINISTRATIVE PANEL DECISION

VGP IPCo LLC, Valvoline Licensing and Intellectual Property LLC v. 陈燕
(chen yan)

Case No. D2024-4425

1. The Parties

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

The Respondent is 陈燕 (chen yan), China.

2. The Domain Name and Registrar

The disputed domain name <valvoline-inc.com> is registered with Alibaba Cloud Computing Ltd. d/b/a HiChina (www.net.cn) (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on October 29, 2024. On October 29, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 30, 2024, 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 (N/A) and contact information in the Complaint. The Center sent an email communication to the Complainants on October 30, 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 in English on November 1, 2024.

On October 30, 2024, the Center informed the Parties in Chinese and English, that the language of the Registration Agreement for the disputed domain name is Chinese. On November 1, 2024, the Complainants requested English to be the language of the proceeding. 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 Chinese and English of the Complaint, and the proceedings commenced on November 5, 2024. In accordance with the Rules, paragraph 5, the due date for Response was November 25, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on November 29, 2024.

The Center appointed Rachel Tan as the sole panelist in this matter on December 3, 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 First Complainant is the IP holding company for Valvoline Inc. and the Second Complainant is the IP holding company for VGP Holdings LLC (collectively referred to as "Valvoline"). Established in 1866, Valvoline is known as a leading worldwide producer and distributor of automotive lubricants and chemicals in the automotive lubricant product and services industry. Valvoline has been selling its products under the VALVOLINE trade mark for over 150 years. As of today, Valvoline's products and services are available in more than 140 countries.

The First Complainant is the owner of the VALVOLINE mark in several jurisdictions. For example, U.S. Registration No. 53237 for VALVOLINE registered on May 29, 1906 in Class 4; International Registration No. 568949A for VALVOLINE registered on March 19, 1991 in Classes 1, 3 and 4.

The Second Complainant is the owner of the VALVOLINE mark in several jurisdictions. For example, Chinese Registration No. 162814 for VALVOLINE registered on September 30, 1982 in Class 4 and Chinese Registration No. 2020512 for  registered on February 21, 2005 in Class 4.

Valvoline operates mainly through two primary domain names, namely <valvoline.com> and <valvolineglobal.com>. The First Complainant is the registrant of the domain name <valvoline.com> (registered on March 4, 1995). The Second Complainant is the registrant of the domain name <valvolineglobal.com> (registered on August 23, 2022).

The disputed domain name was registered on May 29, 2024. As of the date of filing of the Complaint and this Decision, the disputed domain name does not resolve to an active website.

The Complainants sent a cease-and-desist letter to the Respondent on June 28, 2024. Despite several follow-up reminders, the Respondent did not respond to the Complainants.

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 name.

Notably, the Complainants contend that the disputed domain name is identical or confusingly similar to the Complainants' VALVOLINE mark as it incorporates the mark entirely along with a generic word and a hyphen, i.e., "-inc". The mere addition of the generic term and the hyphen does not negate the similarity between the disputed domain name and the VALVOLINE mark.

The Complainants further allege that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainants have not licensed, authorized, or permitted the Respondent to register a domain name incorporating the Complainants' VALVOLINE mark or to use the mark in any

manner. The Respondent is not sponsored by or affiliated with the Complainants in any way. There is no evidence to demonstrate that the Respondent is commonly known by the disputed domain name. In addition, the disputed domain name resolves to an empty page, which shows the Respondent has no intent to use it in connection with a bona fide offering of goods or services.

Finally, the Complainants assert that the Respondent registered the disputed domain name in bad faith. The Complainants claimed that they have used the VALVOLINE mark since 1866, and the mark is known internationally. At the time of registering the disputed domain name, the Respondent knew or should have known of the Complainants' mark. Separately, although no content is being displayed on the webpage, the passive holding of the disputed domain name that incorporates the Complainants' well-known VALVOLINE mark constitutes evidence of bad faith registration and use of the disputed domain name. Finally, the Respondent's failure to respond to the Complainants' cease and desist letter also supports a finding of bad faith.

B. Respondent

The Respondent did not reply to the Complainants' contentions.

6. Discussion and Findings

6.1 Preliminary Issue: Language of the Proceeding

The language of the Registration Agreement for the disputed domain name is Chinese. 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 based in the U.S. and conducting proceedings in Chinese would result in delay and add unnecessary cost to the Complainants; (ii) the disputed domain name is comprised of Latin characters; and (iii) the term VALVOLINE, which is the dominant portion of the disputed domain name, does not carry any specific meaning in the Chinese language.

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.

6.2 Substantive Issues

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 Complainants' 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 entirety of the 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, “-inc” 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.

Separately, it has been held that the use or absence of punctuation marks, such as hyphen here, does not alter the fact that a name is identical to a mark. See *Chernow Communications, Inc. v. Jonathan D. Kimball*, WIPO Case No. [D2000-0119](#).

Lastly, it is permissible for the Panel to disregard the applicable Top-Level Domain (“TLD”) in the disputed domain name, i.e., “.com”. It is accepted by UDRP panels that the practice of disregarding the TLD in determining identity or confusing similarity is applied irrespective of the particular TLD (including with regard to “new generic TLD”) and the ordinary meaning ascribed to a particular TLD would not necessarily impact assessment to the first element. [WIPO Overview 3.0](#), sections 1.11.1 and 1.11.2.

Based on the available records, 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 Complainants have established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. 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 name such as those enumerated in the Policy or otherwise.

The Respondent has not provided evidence of a legitimate or non-commercial use of the disputed domain name or reasons to justify the choice of the disputed domain name that is confusingly similar to the Complainants’ VALVOLINE mark. There is also no indication to show that the Respondent is commonly known by the disputed domain name or otherwise has rights or legitimate interests in it. Moreover, the Complainants have not granted the Respondent any license or authorization to use the VALVOLINE mark or register the disputed domain name.

Furthermore, the nature of the disputed domain name carries a risk of implied affiliation with the Complainants. [WIPO Overview 3.0](#), section 2.5.1.

None of the circumstances in paragraph 4(c) of the Policy are present in this case. For these reasons, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

Based on the available records, 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.

In the present case, the Panel notes that the Complainants' VALVOLINE mark has been widely registered around the world, including in China. The disputed domain name was registered long after the use and registration of the Complainants' VALVOLINE mark. Through use and advertising, the Complainants' VALVOLINE mark is known throughout the world. Search results using the term "valvoline" on the Internet search engines direct Internet users to the Complainants and their business, which indicates that an exclusive connection between the VALVOLINE mark and the Complainants has been established. As such, the Respondent either knew or should have known of the Complainants' VALVOLINE mark when registering the disputed domain name, and has exercised "the kind of willful blindness that numerous panels have held support a finding of bad faith". See *Barclays Bank PLC v. Andrew Barnes*, WIPO Case No. [D2011-0874](#).

Section 3.1.4 of the [WIPO Overview 3.0](#) states that the "mere registration of a domain name that is identical or confusingly similar (particularly domain names incorporating the mark plus a descriptive term) to a famous or widely known trademark by an unaffiliated entity can by itself create a presumption of bad faith". In this case, the disputed domain name fully incorporates the Complainants' well-known VALVOLINE mark in its entirety with a generic term "inc". Given that the Respondent has no relationship with the Complainants, a presumption of bad faith has been created.

Separately, panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness or reputation of the Complainants' VALVOLINE mark, and the composition of the disputed domain name, and finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

The Respondent has kept silent in the face of the Complainants' allegations of bad faith either in response to the cease-and-desist letter or in the response to the Complaint in this proceeding. Taking into account these circumstances, the Panel finds that the Respondent must have known of the Complainants before registering the disputed domain name and, considering the Respondent's lack of rights or legitimate interests, and by registering and using the disputed domain name as discussed above, the Panel is led to conclude that the disputed domain name was registered and is being used in bad faith

Based on the available records, 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 name <valvoline-inc.com> be transferred to the Complainants.

/Rachel Tan/

Rachel Tan

Sole Panelist

Date: December 17, 2024