

ADMINISTRATIVE PANEL DECISION

VGP IPCo LLC and Valvoline Licensing and Intellectual Property LLC v.
william monroe
Case No. D2024-5154

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 william monroe, United States.

2. The Domain Name and Registrar

The disputed domain name <valvolinesglobal.com> (the "Disputed Domain Name") is registered with Hostinger Operations, UAB (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on December 13, 2024. On December 16, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On December 17, 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 (Domain Admin, Privacy Protect, LLC (PrivacyProtect.org)) and contact information in the Complaint. The Center sent an email communication to the Complainants on December 17, 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 December 20, 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 December 23, 2024. In accordance with the Rules,

paragraph 5, the due date for Response was January 12, 2025. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on January 13, 2025. The Center appointed Colin T. O'Brien as the sole panelist in this matter on January 17, 2025. 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 provide automotive and industrial solutions. Established in 1866, the Complainant's group introduced world's first branded motor oil. The Complainants currently sell in more than 140 countries and territories and drive industry solutions for every engine and drivetrain, including high-mileage and heavy-duty vehicles, offered at more than 80,000 locations. The Complainants are known as a leading worldwide producer and distributor of premium branded automotive, commercial and industrial lubricants, and automotive chemicals.

The Complainants own numerous trademark registrations for its VALVOLINE mark globally including but not limited to the following:

TRADEMARK	JURISDICTION	REGISTRATION NUMBER	REGISTRATION DATE	INTERNATIONAL CLASS
VALVOLINE	UNITED STATES	53237	May 29, 1906	4
VALVOLINE	UNITED STATES	670453	December 2, 1958	1
VALVOLINE	UNITED KINGDOM	UK00000846891	March 26, 1963	4
VALVOLINE	UNITED KINGDOM	UK00001073144	January 17, 1977	7
VALVOLINE	CANADA	TMA141455	August 20, 1965	1, 2, 3, 4, 7, 11, 12, 17, 37, and 39

("Valvoline trademarks").

The Complainants have an Internet presence through their primary websites <valvolineglobal.com> and <valvoline.com> as well as their various social media platforms including Facebook, Instagram, and X. Their Facebook page has more than 3.8 million followers around the globe, the Instagram page has more than 88,000 followers, whilst the X page has more than 78,000 followers.

According to Similarweb.com, the Complainants' website located at their primary domain name <valvolineglobal.com> received more than 1.1 million total visits in the month of July 2024 and is ranked No. 35 in their industry category. Also, their domain name <valvoline.com> received more than 299,000 total visits during the month of July 2024 and is ranked No. 16 in their industry category.

The Disputed Domain Name was registered on July 2, 2024, and resolves to an error page.

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 they are the owner of VALVOLINE trademarks. In creating the Disputed Domain Name, the Respondent has added an "s" and the generic, descriptive term "global" to the end of the Complainants' VALVOLINE trademark, thereby making the Disputed Domain Name confusingly

similar to the Complainants' trademark and the primary domain name of the Complainants. The fact that such term is closely linked and associated with the Complainants' brand and trademark only serves to underscore and increase the confusing similarity between the Disputed Domain Name and the Complainants' trademark.

The first Complainant's company name is Valvoline Global Operations and the Complainants' primary domain name is <valvolineglobal.com>. The Disputed Domain Name differs from the Complainants' primary domain name by one added letter, "s", to the VALVOLINE trademark.

The Respondent is not sponsored by or affiliated with the Complainants in any way. The Complainants have not given the Respondent permission to use the Complainants' trademarks in any manner, including in domain names. Furthermore, the Complainants have not licensed, authorized, or permitted the Respondent to register domain names incorporating the Complainants' trademark. The Respondent is not commonly known by the Disputed Domain Name, which evinces a lack of rights or legitimate interests.

The Respondent is using the Disputed Domain Name to redirect Internet users to a website that resolves to a blank page and lacks content. The Respondent has failed to make use of this Disputed Domain Name's website and has not demonstrated any attempt to make legitimate use of the domain name and website, which evinces a lack of rights or legitimate interests in the Disputed Domain Name.

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 and that registration of domain names containing well-known trademarks constitutes bad faith per se. The Disputed Domain Name is confusingly similar to the Complainants' primary domain name by the simple addition of the letter "s" to the VALVOLINE trademark. In addition to the numerous trademarks filed in connection with the Complainants' business prior to the Respondent's registration of the Disputed Domain Name on July 2, 2024, the Complainants rank as the No. 2 quick-lube chain by number of stores and No. 3 passenger car motor oil brand in the DIY market by volume in the United States.

The Respondent has ignored the Complainants' attempts to resolve this dispute outside of this administrative proceeding.

On balance of the facts set forth above, it is more likely than not that the Respondent knew of and targeted the Complainants' trademark, and the Respondent should be found to have registered and used the Disputed Domain Name in bad faith.

B. Respondent

The Respondent did not reply to the Complainants' contentions.

6. Discussion and Findings

The Complainants are related corporate entities thus it is appropriate to refer to the Complainant in the singular.

A. Identical or Confusingly Similar

The Complainant has demonstrated it owns registered trademark rights in the VALVOLINE mark and has shown that no other entity has rights in or uses the Complainant's mark. The addition of "s" and "global" does not prevent the Complainant's trademark from being recognizable in the Disputed Domain Name. The generic Top-Level Domain ".com" is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. Accordingly, the Disputed Domain Name is confusingly similar to a mark in which the Complainant has rights.

See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)), sections 1.8 and 1.11.1, and *F. Hoffmann-La Roche AG v. Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org / Conan Corrigan*, WIPO Case No. [D2015-2316](#).

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

B. Rights or Legitimate Interests

The Complainant has presented a prima facie case that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name and has not been commonly known by the Disputed Domain Name. The fact that the Respondent obtained the Disputed Domain Name nearly 159 years after the Complainant had begun using its globally famous VALVOLINE mark affirms that the Respondent sought to piggyback on the mark for illegitimate reasons.

After a complainant has made a prima facie case, the burden of production shifts to a respondent to present evidence demonstrating rights or legitimate interests in the domain name. See, e.g., *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#).

The Respondent has provided no evidence of any rights or legitimate interests in the Disputed Domain Name.

In the absence of any evidence rebutting the Complainant's prima facie case indicating the Respondent's lack of rights or legitimate interests in respect of the Disputed Domain Name, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Disputed Domain Name was registered years after the Complainant first registered and used its VALVOLINE mark and after the Complainant had started using <valvolineglobal.com>. Considering the evidence on the record provided by the Complainant with respect to the extent of use of its globally famous VALVOLINE mark, the nature of the Disputed Domain Name which is nearly identical to the Complainant's primary domain name <valvolineglobal.com> and differs from it by a single letter “s” added to the Complainant's mark, combined with the absence of any evidence provided by the Respondent to the contrary, it is sufficient to satisfy the Panel that, at the time the Disputed Domain Name was registered, the Respondent undoubtedly knew of the Complainant's globally famous VALVOLINE mark, and knew that it had no rights or legitimate interests in the Disputed Domain Name.

There is prima facie no reason for the Respondent to have registered the Disputed Domain Name adding a single letter “s” to the Complainant's VALVOLINE mark. UDRP panels have consistently found that the mere registration of a domain name that is 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. See section 3.1.4 of the [WIPO Overview 3.0](#).

The Panel finds that the only plausible basis for registering and passively holding the Disputed Domain Name is for illegitimate and bad faith purposes. The passive holding of the Disputed Domain Name does not prevent a finding of bad faith under the circumstances of this case. See section 3.3 of the [WIPO Overview 3.0](#).

Accordingly, the Panel finds that the Disputed Domain Name has been registered and is being used in bad faith.

The Panel finds the third element of the Policy has been established

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 <valvolinesglobal.com> be transferred to the Complainant.

/Colin T. O'Brien/

Colin T. O'Brien

Sole Panelist

Date: January 27, 2025