

## **ADMINISTRATIVE PANEL DECISION**

**Valvoline Licensing and Intellectual Property LLC v. Tassos Recachinas,  
SOPHIS INVESTMENTS LLC / Hostmaster ONEANDONE  
Case No. D2022-3426**

### **1. The Parties**

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

The Respondent is Tassos Recachinas, SOPHIS INVESTMENTS LLC, United States / Hostmaster ONEANDONE, United States.

### **2. The Domain Name and Registrar**

The disputed domain name <valvolinevalue.com> is registered with IONOS SE (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 15, 2022. 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 September 16, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on September 22, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. On the same day, the Respondent made an informal communication to the Center by email. The Complainant filed an amended Complaint on September 27, 2022.

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 September 29, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 19, 2022. The Respondent asked for extension on the Response due date on October 19, 2022, and the new due date for Response was set for October 23, 2022.

The Respondent made a request for extension on the Response due date on October 20, 2022, and the new due date for Response was set for October 29, 2022. The Respondent made a request for extension on the Response due date on October 28, 2022, and the new date for Response due date was set for November 5, 2022. The Respondent asked for more extension on the Response due date on November 3, 2022, and the Center sent an email on November 4, 2022 to the Parties, inviting the Complainant to comment on the Respondent's request for extension. The Center notified the Parties on November 7, 2022 that the final due date for Response was set for November 9, 2022. The Response was filed with the Center on November 10, 2022.

The Center appointed Evan D. Brown as the sole panelist in this matter on November 23, 2022. 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 is a worldwide producer and distributor of automotive, commercial and industrial lubricants, and automotive chemicals. It owns the trademark VALVOLINE which it has registered in several jurisdictions around the world, including the United States (*e.g.*, Reg. No. 0053237, registered on May 29, 1906).

According to the Whois records, the disputed domain name was registered on March 7, 2022. For a time, the Respondent used the disputed domain name to display pay-per-click advertisements, including ads for products competitive to those offered by the Complainant. As of the time of the filing of the Complaint, however, the Respondent was using the disputed domain name to redirect Internet users to a blank page displaying no content. The Respondent asserts that it intends to publish a website at the disputed domain name providing information about the Complainant.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant contends that the disputed domain name is identical or confusingly similar to the Complainant's trademark; that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and that the disputed domain name was registered and is being used in bad faith.

##### **B. Respondent**

The Respondent claims to be a registered investment advisor and a beneficial owner of shares of stock of Valvoline, Inc. (presumably an affiliate of the Complainant). It employed certain methods that it considers proprietary to conclude that Valvoline shares are an undervalued investment opportunity. The Respondent asserts that its investment in such shares is of significant importance to the Respondent, its business and clients. To this end, the Respondent asserts that it prepared (but apparently did not yet publish) a website "through which to communicate its research and findings with other Valvoline shareholders . . . with regard to a proxy contest, possible lawsuits, or other legitimate matters". Despite this desire to advocate concerning the value of Valvoline stock, the Respondent asserts that "[t]he domain name has been registered and is being used for legitimate purposes and not as a pretext for commercial gain or other such purposes inhering to Respondent's benefit."

The Respondent argues that the disputed domain name is not confusingly similar to the Complainant's mark because the word "value" is a common descriptor for investment and stock market matters, and therefore it is clear that the registration of the disputed domain name reveals no abusive intent to confuse Internet users. Further, the Respondent claims that the manner in which its forthcoming website is to be used negates the Complainant's assertions of confusion with the Complainant's brands or marks.

On the second Policy element, the Respondent asserts that it has rights or legitimate interests in the disputed domain name because it made “credible and demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services, in such case comprised of proprietary investment research product with regard to Valvoline’s publicly-traded marketable securities, along with related investment management services utilizing such research”. The Respondent claims the use for which these preparations were made was “without intent for commercial gain”. The Respondent provided a rough draft of a website it claims that it would publish at the disputed domain name, and additionally asserted that it had conducted “material business formation-related due diligence”, had corresponded with a number of prominent institutional investors and legal advisors, and developed a genuine business plan utilizing the disputed domain name, among other activities. The Respondent also claims fair use, emphasizing that it believes the intended website to be “truthful and well-founded”. The Respondent makes a number of other arguments, tangential at best, under this second policy element. It issues a “warning” to the Complainant that a proposed transaction “destroys nearly \$5 billion of shareholder value” and asserts a string of other purported grievances against the Complainant and its business decisions.

As for the third element under the Policy, the Respondent argues that it has not registered the disputed name to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant’s VALVOLINE mark, but rather for a number of conceivable good faith uses. The Respondent asserts that these good faith uses include “noncommercial fair use”, which should serve as a defense to bad faith allegations. It asserts in a number of ways that it did not register the disputed domain name to disrupt the Complainant’s business or to cause confusion among Internet users.

Finally, the Respondent asks the Panel to make a finding of reverse domain name hijacking on the basis that the Complaint was brought in bad faith and a number of other purported misdeeds of the Complainant.

## **6. Discussion and Findings**

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied: (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights, (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 finds that all three of these elements have been met in this case.

### **A. Identical or Confusingly Similar**

This first element under the Policy functions primarily as a standing requirement. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.7. This element requires the Panel to consider two issues: first, whether the Complainant has rights in a relevant mark; and second, whether the disputed domain name is identical or confusingly similar to that mark.

A registered trademark provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner. See *Advance Magazine Publishers Inc., Les Publications Conde Nast S.A. v. Voguechen*, WIPO Case No. [D2014-0657](#). The Complainant has demonstrated its rights in the VALVOLINE mark by providing evidence of its trademark registrations.

The disputed domain name incorporates the VALVOLINE mark in its entirety with the term “value”, which does not prevent a finding of confusing similarity between the disputed domain name and the Complainant’s VALVOLINE mark. See [WIPO Overview 3.0](#), section 1.8. The VALVOLINE mark remains sufficiently recognizable for a showing of confusing similarity under the Policy.

The Panel finds the Respondent’s arguments under this heading unpersuasive. The Complainant has established this first element under the policy.

## B. Rights or Legitimate Interests

The Panel evaluates this element of the Policy by first looking to see whether the Complainant has made a *prima facie* showing that the Respondent lacks rights or legitimate interests in respect of the disputed domain name. If the Complainant makes that showing, the burden of production of demonstrating rights or legitimate interests shifts to the Respondent (with the burden of proof always remaining with the Complainant). See [WIPO Overview 3.0](#), section 2.1; *AXA SA v. Huade Wang*, WIPO Case No. [D2022-1289](#).

On this point, the Complainant asserts, among other things, that: (1) the Respondent is not commonly known by the disputed domain name, (2) the Complainant has not licensed, authorized, or permitted the Respondent to register domain names incorporating the Complainant's trademark, (3) at the time of filing the Complaint, the Respondent was using a privacy service to obfuscate its contact information, (4) the Respondent has not demonstrated any attempt to make legitimate use of the disputed domain name, and (5) the Respondent has not used the disputed domain name to provide a *bona fide* offering of goods or services as allowed under the Policy nor a legitimate noncommercial or fair use as allowed under Policy.

The Panel finds that the Complainant has made the required *prima facie* showing. The Panel also finds that the Respondent's arguments do not overcome this *prima facie* showing.

The Respondent asserts that it had engaged in demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering. It submitted as evidence a mock-up document purporting to show a website under development. The mock-up document shows analysis and planning. Though the Respondent did not submit notable documentation supporting the alleged collaboration with prominent institutional investors and legal advisors, the Panel finds, looking at the circumstances as a whole, that the Respondent engaged in a degree of preparation to use the disputed domain name (albeit as a commercial site for the Respondent's benefit, see below) prior to having heard from the Complainant regarding the dispute.

The Panel is not persuaded by the Respondent's arguments that the planned use of the disputed domain name was noncommercial. For a period of time, the Respondent used the disputed domain name to serve up pay-per-click advertisements, some of which were competitive to the Complainant. The Respondent asserts that it never earned any revenue from such ads, and took proactive measures to eliminate the parked page when it received a demand letter from the Complainant. That may be the case, but does not carry the day, and is somewhat beside the point noting the Respondent's planned intentions for the disputed domain name. The Respondent's other assertions undermine its claim that it acquired the disputed domain name for noncommercial purposes. It asserts that it planned on using the disputed domain name in connection with a "proprietary investment research product with regard to Valvoline's publicly-traded marketable securities, along with related investment management services utilizing such research." The Respondent is an investment advisor, and it admits that its investment in shares of Valvoline, Inc. is of significant importance to the Respondent, its business and clients. The mock-up of the website prominently features the logo of the Respondent's investment firm at the top of the home page. The Panel views the presence of that logo as marketing and promotion of the Respondent's business and indicative of the overall purpose of the site. The more traffic the Respondent can draw to its (planned) website at the disputed domain name, the more exposure its business will get in the marketplace. The Panel finds it more likely than not that the primary purpose in registering the disputed domain name was to increase revenue for the Respondent. This is inconsistent with the Respondent's assertions that the intended use of the disputed domain name is noncommercial.

The question of fair use remains. The Policy provides, at Paragraph 4(c)(iii) that one may demonstrate rights or legitimate interests in a disputed domain name by "making a legitimate . . . 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."

The Panel views the Respondent's website as a criticism site of sorts. The Respondent variously asserts that it procured the disputed domain name so that it could communicate how the Complainant's stock is

“mispriced,” provide information about “a proxy contest” and “possible lawsuits,” and to otherwise “contribute valuable insight” into how the Complainant should operate its business. The Respondent discusses in the Response, at length, various “warnings” it is issuing to the Complainant, including how a proposed transaction of the Complainant “destroys nearly \$5 billion of shareholder value.” The Respondent accuses the Complainant of “maliciously seek[ing] to effectively effectuate a change of control without proper disclosure to shareholders or an opportunity for shareholders to vote on the transaction.” Simply stated, the Respondent is critical of the Complainant’s proposed business decisions insofar as they would be understood (by the Respondent) to impact the Respondent’s holdings in the Complainant’s company.

[WIPO Overview 3.0](#), section 2.6.1 provides that “[t]o support fair use under UDRP paragraph 4(c)(iii), the respondent’s criticism must be genuine and noncommercial.” As discussed above, the proposed site that contains criticism, such as it is, is plainly not noncommercial. The Panel believes, based on the record as a whole, that the Respondent has chosen to use the disputed domain name – which conspicuously contains the Complainant’s mark in a way to draw visitors – to further the Respondent’s commercial enterprise.

Accordingly, the Panel finds that the Respondent has not overcome the Complainant’s *prima facie* showing, and that Complainant has therefore established this second element under the Policy.

### **C. Registered and Used in Bad Faith**

There is no dispute that the Respondent was aware of the VALVOLINE mark when it registered the disputed domain name. In the circumstances of this case, where the Respondent has not demonstrated rights or legitimate interests, such a showing is sufficient to establish bad faith vis-à-vis the disputed domain name. See, e.g., *Veuve Cliquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co.*, WIPO Case No. [D2000-0163](#) (holding that the disputed domain name “is so obviously connected with such a well-known product that its very use by someone with no connection with the product suggests opportunistic bad faith”).

Bad faith use is shown from the Respondent’s activities. As noted above, the Panel believes that the Respondent registered and sought to use the disputed domain name – which incorporates the Complainant’s well-known mark – in order to generate revenue as an investment advisor; indeed, the Respondent effectively concedes this. See *International Business Machines Corporation v. Nick Paleveda, Moneymasterspbs Inc.*, WIPO Case No. [DTV2021-0001](#) (the respondent’s use of a disputed domain name that wholly appropriated the complainant’s well-known mark, to set up an online commercial enterprise, was a clear example of bad faith under the UDRP).

Furthermore, the disputed domain name is so “obviously indicative” of the Complainant’s VALVOLINE mark that the Respondent’s use of the disputed domain name would “inevitably lead to confusion of some sort”. *AT&T Corp. v. Fred Rice*, WIPO Case No. [D2000-1276](#); see also *Verizon Trademark Services LLC v. Mike Duffy, London Central Communications Ltd*, WIPO Case No. [D2014-1994](#) (finding that “given the very extensive reputation of the Complainant’s mark and that the mark is an invented one, it seems that any use that could be made of the disputed domain name would inevitably lead to confusion between the Respondent and the Complainant.”). In light of these considerations, the Panel finds it likely that the Respondent registered and seeks to use the disputed domain name in a way that trades off the goodwill of the Complainant’s VALVOLINE mark but for the Respondent’s financial gain. It is not necessary for the Respondent to use the disputed domain name for it to continue its investment advisory services. Accordingly, any argument sounding in nominative fair use (or protected criticism) to defend the selection and use of a domain name for the Respondent’s commercial purposes, and comprising the Complainant’s mark falls short.

For these reasons, the Panel finds that the Complainant has established this third element under the Policy.

### **D. Reverse Domain Name Hijacking**

Finding that the Complainant succeeded on all three elements under the Policy, the Panel will not find that the Complainant engaged in Reverse Domain Name Hijacking.

## 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 <valvolinevalue.com> be transferred to the Complainant.

*/Evan D. Brown/*

**Evan D. Brown**

Sole Panelist

Date: December 27, 2022