

ADMINISTRATIVE PANEL DECISION

ADDINOL Lube Oil GmbH v. Masoud shakeri
Case No. D2024-3330

1. The Parties

The Complainant is ADDINOL Lube Oil GmbH, Germany, represented by Taylor Wessing, Germany.

The Respondent is Masoud shakeri, United Arab Emirates.

2. The Domain Name and Registrar

The disputed domain name <adinehoil.com> is registered with 1API GmbH (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 14, 2024. On August 14, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 19, 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 (UNKNOWN) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 22, 2024 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on September 3, 2024.

The Center verified that the Complaint 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 6, 2024. In accordance with the Rules, paragraph 5, the due date for Response was September 26, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 27, 2024.

The Center appointed John Swinson as the sole panelist in this matter on October 2, 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 Complainant is a German-based manufacturer of lubricating greases and oils. The Complainant has manufactured high performing oils since 1936, particularly for machinery and motor vehicles.

Originally, Complainant's product portfolio also included fuels which were sold at the famous ADDINOL petrol stations in the former German Democratic Republic, commonly known as East Germany. Currently, the Complainant's most well-known product is branded ADDINOL. The Complainant's products are available worldwide. The Complainant's distribution network includes numerous dealers in more than 100 countries.

Among others, the Complainant is the owner of International Registered Trademark Number 695723 for the word mark ADDINOL, registered on June 4, 1998, in Class 4 (Oils and lubricants for industrial use; oils for engines and gears of motor vehicles).

The Complainant has a website located at <addinol.de>.

The Respondent did not file a Response, so little information is known about the Respondent. According to the Registrar's records, the Respondent has an address in the United Arab Emirates.

The disputed domain name was registered on October 23, 2022.

The Respondent is operating an online shop at the disputed domain name. The website is mostly in Arabic. This online shop offers a multi-purpose oil for sale, that appears to be directed at use in motor vehicles. The products displayed for sale at the Respondent's online shop are branded "ADINOIL" in large font and "ADINEHOIL" in smaller font. The Respondent's products include a logo that states "FORMULA BY GERMAN QUALITY". The back of the Respondent's packaging has wording in German, English and Arabic.

One of the photographs on the website at the disputed domain name has a person named as CEO (Massoud Shakri) standing in front of an automotive garage with a sign that has <gearboxone.com> on the sign. The <gearboxone.com> website has some similar design features to the website at the disputed domain name. According to the GearboxOne website, this business does automatic transmission repairs in Tehran.

5. Parties' Contentions

A. Complainant

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

Notably, the Complainant contends that the disputed domain name likely confuses users into falsely believing that the disputed domain name will lead to an online store selling products produced by the Complainant or at least products that are linked to the ones of the Complainant that is the global player producing industrial lubricants made in Germany.

The Complainant also contends that the Complainant's famous trademark and the disputed domain name are aurally highly similar, with both signs consisting of three syllables containing the same A-I-O vocal sequence, which is important for phonetic similarity and a first sequence dominated by the letter "A". Where the elements differ in some of their letters, the differing characters are weak-sounding consonants that do not stand out phonetically and do not define the sound pattern. The similarity of the signs is intentionally increased by the fact that the Respondent uses its sign on products on the related website that imitate the Complainant's packaging in design and colour scheme and that are branded "ADINOIL" in large font.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements enumerated in paragraph 4(a) of the Policy have been satisfied, namely:

- (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 onus of proving these elements is on the Complainant.

An asserting party needs to establish that it is more likely than not that the claimed fact is true. An asserting party cannot meet its burden by simply making conclusory statements unsupported by evidence. To allow a party to merely make factual claims without any supporting evidence would essentially eviscerate the requirements of the Policy as both complainants or respondents could simply claim anything without any proof. For this reason, UDRP panels have generally dismissed factual allegations that are not supported by any bona fide documentary or other credible evidence. *Snowflake, Inc. v. Ezra Silverman*, WIPO Case No. [DIO2020-0007](#); *Captain Fin Co. LLC v. Private Registration, NameBrightPrivacy.com / Adam Grunweg*, WIPO Case No. [D2021-3279](#).

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 of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[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 Panel finds the mark is recognizable 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.

The Complainant's trademark is ADDINOL. The disputed domain name is <adinehoil.com>. These terms are phonetically very similar. The Panel notes the consensus views of panels under the Policy that an assessment of phonetic similarity may be made in appropriate cases alongside the typical side-by-side comparison. [WIPO Overview 3.0](#), section 1.7.

Both the Complainant's trademark and the disputed domain name consist of three syllables. They further contain the same vocal sequence, namely "A – I – O", which is particularly important for phonetic similarity. The elements might differ in some of their letters. However, these differing characters are weak-sounding consonants that do not stand out phonetically. The letter "E" in the denomination "ADINEHOIL" is unvoiced in English and is not pronounced. In addition, the letter "H" in "ADINEHOIL" is an extremely weak sounding consonant and does not have any influence on the overall phonetic impression. This same analysis applies for the remaining differing letters. They do not in particular define the sound pattern.

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.

The Complainant has stated that the Respondent is not a customer of the Complainant but is selling “copycats” of the Complainant’s products. The Respondent’s products are branded “ADINOIL” in large font and are stated to be German quality. For the reasons set out below in respect of the third element of the Policy, the Respondent’s use of the disputed domain name is in bad faith. While the disputed domain name is being used in connection with an offering of goods and services, the Panel cannot find with reference to paragraph 4(c)(i) of the Policy that such offering is bona fide, given the findings set out below that the Respondent appears to be taking unfair advantage of the Complainant’s ADDINOL trademark.

For completeness, the Panel notes with reference to paragraph 4(c)(ii) of the Policy that there is no evidence that the Respondent has been commonly known by the disputed domain name. The Whois record does not mention the name “adinehoil”. With reference to paragraph 4(c)(iii) of the Policy, the use of the disputed domain name is clearly commercial in nature, as the presence of the Respondent’s online shop at the associated website signifies intent for commercial gain.

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.

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 Respondent is selling “copycat” oil products that have a similar look and feel to the Complainant’s oil products and that give the impression of having a German connection. The Complainant has conducted searches in German, and found no evidence that the Respondent or its products have a German connection.

The Complainant’s trademark is of a longstanding nature and the disputed domain name has only been recently registered. The Complainant’s trademark is used worldwide to identify the Complainant’s specialized lubricants. It is clear from a review of the website associated with the disputed domain name that the Respondent is engaged in a scheme to imitate the trade dress of the Complainant.

The Panel finds that the Respondent has adopted the disputed domain name due to its resemblance to the Complainant's distinctive (and non-descriptive) trademark, and has set out to mislead the consuming public into thinking that the Respondent and its products are the goods of, or authorized by, the Complainant, by copying its trade dress and using this in connection with the said sign. The Respondent did not claim that it had rights and legitimate interests in the disputed domain name. The Respondent has not put forward any possible good faith motivation regarding the registration and use of the disputed domain name, and the Panel cannot conceive of any such motivation based upon the present record. In the circumstances, the Panel is of the opinion that the Respondent registered and used the disputed domain name in bad faith.

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 <adinehoil.com> be transferred to the Complainant.

/John Swinson/

John Swinson

Sole Panelist

Date: October 16, 2024