

ADMINISTRATIVE PANEL DECISION

O'Reilly Automotive Stores, Inc, d/b/a O'Reilly Auto Parts v. Whois Privacy,
Private by Design, LLC / Rasel Ahmmed
Case No. D2022-0072

1. The Parties

Complainant is O'Reilly Automotive Stores, Inc, d/b/a O'Reilly Auto Parts, United States of America ("U.S." or "United States"), represented internally.

Respondent is Whois Privacy, Private by Design, LLC, U.S. / Rasel Ahmmed, U.S.

2. The Domain Names and Registrar

The disputed domain names <firstcallonline.net> and <firstcallonline.org> are registered with Porkbun LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on January 7, 2022. On January 11, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On January 27, 2021, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent and contact information in the Complaint.

The Center sent an email communication to Complainant on January 28, 2021 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on February 3, 2022.

The Center verified that the Complaint together with the amendment to the 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 Respondent of the Complaint, and the proceedings commenced on February 4, 2022. In accordance with the Rules, paragraph 5, the due date for Response was February 24, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on February 25, 2022.

The Center appointed Brian J. Winterfeldt as the sole panelist in this matter on March 7, 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

Complainant O'Reilly Automotive Stores, Inc., d/b/a O'Reilly Auto Parts, is a wholly owned subsidiary of O'Reilly Automotive, Inc. Founded in Springfield, Missouri, in December 1957, O'Reilly Automotive, Inc. is an American auto parts retailer that provides automotive aftermarket parts, tools, supplies, equipment, and accessories.

Complainant owns a trademark registration for the FIRST CALL mark in the United States, with registration details as follows:

- FIRST CALL, United States Trademark Reg. No. 2032675, registered on January 21, 1997 for services in class 42.

The disputed domain names were both registered on October 5, 2020. Currently, <firstcallonline.org> redirects to "www.firstcallonline.us", which claims to be a registration portal for O'Reilly FirstCall, and which prominently displays the O'Reilly brand name and trademarks throughout the website. The <firstcallonline.net> domain name currently resolves to a website claiming to be the login portal for "www.firstcallonline.com", similarly displaying the O'Reilly brand name and trademarks throughout the website.

5. Parties' Contentions

A. Complainant

According to Complainant, the disputed domain names are identical or confusingly similar to Complainant's FIRST CALL trademark in which Complainant has rights as demonstrated through its cited registration. The FIRST CALL mark was adopted and has been continuously used in the United States since at least as early as 1997 in connection with automotive products and services. Today, the FIRST CALL mark is largely recognizable due to the online component of Complainant's business. Complainant maintains its online presence for its FirstCall service through the website hosted at its domain name, "firstcallonline.com", which it registered on December 10, 2003.

Complainant argues that the disputed domain names both incorporate the FIRST CALL trademark and are virtually identical to Complainant's "firstcallonline.com" domain name. Complainant also argues that, within each of the webpages to which the disputed domain names resolve, Respondent makes unauthorized use of the FIRST CALL mark, Complainant's additional trademarks, and the trade dress of Complainant.

Complainant asserts that Respondent lacks any rights or legitimate interests in the disputed domain names. According to Complainant, Respondent does not have any trademark rights to the FIRST CALL mark or any of Complainant's trademarks used throughout the websites to which the disputed domain names resolve. Complainant also claims that it has not granted Respondent, by license or otherwise, permission to operate such a website, let alone make use of Complainant's trademarks and/or trade name. To the contrary, Complainant sent Respondent notices of Complainant's rights in FIRST CALL and in other trademarks, demanding Respondent cease and desist using the disputed domain names and any other use of Complainant's trademarks.

According to Complainant, Respondent does not engage in any retail of aftermarket automotive parts. Complainant argues that Respondent is not making a legitimate or fair use of the disputed domain names,

but rather is impersonating the “Official O’Reilly Auto Parts Login Portal”, although the disputed domain names are not affiliated at all with Complainant. Complainant argues that the use of the disputed domain names, as evidenced by websites to which they resolve, can only be for purposes of misleading consumers and diverting traffic where no real service is provided, tarnishing the FIRST CALL mark and harming Complainant’s business and reputation.

Complainant argues that Respondent both registered and is using the disputed domain names in bad faith. According to Complainant, Respondent registered the disputed domain names in bad faith to disrupt Complainant’s business and to phish for information from unsuspecting customers of Complainant’s FirstCall Online program. Complainant argues that the disputed domain names and their respective websites are designed to mimic Complainant’s legitimate website and include varying levels of detail that the average customer of Complainant would not realize was incorrect. The disputed domain names are likely to attract visitors to those sites who wish to engage in business with Complainant. Complainant states that it is a Fortune 500 company and that its trademarks are well-known. Complainant identified several trademark registrations that Respondent has been using without the permission of Complainant and, after having been informed in writing by Complainant that said use was without the permission of Complainant and that Respondent should cease and desist such use immediately, the infringing behavior of Respondent continued to this date. Complainant argues that such actions clearly show the disputed domain names are being used in bad faith.

B. Respondent

Respondent did not reply to the Complainant’s contentions.

6. Discussion and Findings

Under paragraphs 5(f) and 14(a) of the Rules, the effect of a default by a respondent is that, in the absence of exceptional circumstances, the panel shall proceed to a decision on the basis of the complaint.

Under paragraph 4(a) of the Policy, to succeed Complainant must satisfy the Panel that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights;
- (ii) Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name was registered and is being used in bad faith.

A respondent’s default does not by itself satisfy a complainant’s burden of proof and is not necessarily an admission that the complainant’s allegations are true. See section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”). Thus, even though Respondent has failed to address Complainant’s contentions, the burden remains with Complainant to establish the three elements of paragraph 4(a) of the Policy by a preponderance of the evidence. See, e.g., *The Knot, Inc. v. In Knot We Trust LTD*, WIPO Case No. [D2006-0340](#).

A. Identical or Confusingly Similar

A national or international trademark registration is *prima facie* evidence that the holder has the requisite rights in the registered mark for purposes of paragraph 4(a)(i) of the Policy. [WIPO Overview 3.0](#), section 1.2.1. Complainant has provided evidence that it owns multiple trademark registrations for the FIRST CALL trademark and other O’Reilly trademarks as referenced above. Therefore, Complainant has established that it has rights in the FIRST CALL mark and other O’Reilly trademarks.

The remaining question under the first element of the Policy is whether the disputed domain name (typically disregarding the Top-Level Domain (“TLD”) in which the domain name is registered) is identical or confusingly similar to Complainant’s mark. It is well accepted that the first element functions primarily as a standing requirement and that the 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. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. *Id.*

Here, the disputed domain names incorporate the entirety of the FIRST CALL mark, adding only the term “online”, denoting an online presence or service, which does not prevent a finding of confusing similarity. The disputed domain names are also entirely identical to Complainant’s own domain name “firstcallonline.com”, by which it operates its online FirstCall services. The disputed domain names are indistinguishable from <firstcallonline.com> when disregarding the TLD.

Therefore, the Panel finds that Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy in establishing its trademark rights and showing that the disputed domain names are confusingly similar to its FIRST CALL mark.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, Complainant must make at least a *prima facie* showing that Respondent possesses no rights or legitimate interests in the disputed domain name. See [WIPO Overview 3.0](#), section 2.1. Once Complainant makes such a *prima facie* showing, the burden of production shifts to Respondent, though the burden of proof always remains on Complainant. If Respondent fails to come forward with evidence showing rights or legitimate interests, Complainant will have sustained its burden under the second element of the UDRP.

Paragraph 4(c) of the Policy lists the ways that Respondent may demonstrate rights or legitimate interests in the disputed domain name:

- (i) before any notice of the dispute, Respondent’s use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services; or
- (ii) Respondent (as an individual, business or other organization) has been commonly known by the disputed domain name, even if it has acquired no trademark or service mark rights; or
- (iii) Respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Here, Complainant has alleged that Respondent has no rights or legitimate interests in the disputed domain name. Respondent has failed to come forward with any evidence showing rights or legitimate interests. Respondent has not submitted any arguments or evidence to rebut Complainant’s contention that Respondent is not an assignee or licensee of Complainant and that Respondent has no other business relationship with Complainant. Complainant has contended that Respondent is not commonly known by the disputed domain name and that there is no evidence that Respondent has established trademark rights in the disputed domain name. Again, Respondent has not provided any evidence or arguments to demonstrate that it has such rights.

Accordingly, the Panel finds that Respondent does not have any rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

Bad faith is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark. Paragraph 4(b) of the Policy provides that any one of the following non-exclusive scenarios constitutes evidence of a respondent's bad faith:

(i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent 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 the respondent's website or location or of a product or service on the respondent's website or location.

Here, Respondent's actions align with 4(b)(iv) of the Policy. The disputed domain name contains the entirety of the FIRST CALL mark, with the addition of the term "online". Due to the well-known and online nature of Complainant's FIRST CALL brand, evidenced by its trademark registration for FIRST CALL as well as Fortune 500 recognition, along with the unauthorized use of the FIRST CALL mark and the O'Reilly design marks throughout the websites to which the disputed domain names resolve, Respondent was undoubtedly aware of Complainant and the FIRST CALL mark when it registered the disputed domain names. Respondent's impersonation of Complainant and false invitation to register and login to Complainant's FirstCall service via the disputed domain names further evidences bad faith on the part of Respondent in the registration and use of the disputed domain names.

This Panel therefore finds that Respondent acted in bad faith by its registration and use of the disputed domain names, intentionally creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of Respondent's website with the purpose of attracting Internet users for commercial gain as per paragraph 4(b)(iv) 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 names, <firstcallonline.net> and <firstcallonline.org> be transferred to Complainant.

/Brian J. Winterfeldt/

Brian J. Winterfeldt

Sole Panelist

Date: March 22, 2022.