

## **ADMINISTRATIVE PANEL DECISION**

Valvoline Licensing and Intellectual Property LLC v. Jim Lineberger

Case No. D2023-2589

### **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 Jim Lineberger, United States.

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

The disputed domain name <oilchangevalvoline.com> is registered with GoDaddy.com, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 15, 2023. On June 16, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 16, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and its contact details.

The Center verified that 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 the Respondent of the Complaint, and the proceedings commenced on July 3, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 23, 2023. Upon the Respondent’s request, the due date for Response was extended, further to paragraph 5(b) of the Rules, to July 27, 2023. On July 27, 2023, the Respondent sent an informal email communication to the Center requesting additional time to respond to the Complaint. The first Response was filed with the Center on July 28, 2023. In a cover email, the Respondent requested further extension to seek legal assistance and file a more comprehensive response. The response due date was further extended, pursuant to paragraph 5(e) of the Rules, to August 7, 2023. On August 7, 2023, the

second Response was filed with the Center. The Respondent also requested a further extension to file another response.

On August 22, 2023, the Complainant submitted a Supplemental Filing. On August 25, 2023, the Respondent also submitted a Supplemental Filing.

The Center appointed Ingrīda Kariņa-Bērziņa as the sole panelist in this matter on August 30, 2023. 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 wholly-owned subsidiary of Valvoline, Inc., which was established in 1866 and operates in the automotive lubricant industry. The Complainant established its Valvoline Instant Oil Change consumer business in 1986, and today operates or franchises 1,700 service centers under this brand in the United States. The Complainant is the proprietor of numerous trademark registrations, including the following (both claiming a date of first use of October 16, 1987):

- United States Trademark Registration No. 1531277 for VALVOLINE INSTANT OIL CHANGE (word mark), registered on March 21, 1989 for services in class 37;
- United States Trademark Registration No. 3512482 for VALVOLINE (word mark), registered on October 7, 2008 for services in class 37.

The Complainant operates its business websites at the domain names <valvoline.com> and <vioc.com>. The record contains copies of cease-and-desist letters addressed to the Respondent dated February 28, 2023 and March 14, 2023. In response to the latter, the Respondent sent an email on the same date stating: "At this point, the domain is not live for the public." In response to the Complainant's further email reiterating the substance of the cease-and-desist letters, the Respondent sent an email on March 16, 2023, stating: "Sorry, I have not done anything with the domain! If they wanted it, they should have bought it!!"

The disputed domain name was registered on December 9, 2022. At the time of filing of the Complaint and this Decision, it resolved to a website featuring pay-per-click ("PPC") links related to the Complainant's business.

The Respondent is a private individual who states that he operates an authorized Valvoline oil-change business and/or markets Valvoline products.

#### **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 wholly incorporates its VALVOLINE mark and is confusingly similar to its VALVOLINE and VALVOLINE INSTANT OIL CHANGE marks. The Respondent is not commonly known by the disputed domain name, which is used to direct Internet users to a website featuring PPC links to third-party websites, some of which compete directly with the Complainant's business. The registration post-dates the Complainant's trademark rights and registration of the Complainant's domain name at <valvoline.com>. The Respondent knew or should have known about the

Complainant's well-known trademarks. The disputed domain name is being used to create confusion among Internet users. The Complainant requests transfer of the disputed domain name.

## **B. Respondent**

The Respondent's responses may be summarized as follows:

The Respondent states that he legally acquired the disputed domain name from the Registrar, which could have made a mistake in registering it. The Respondent owns a business offering oil changes using Valvoline products and is duly authorized by Valvoline Global Operations to use the Valvoline name and trademark in marketing its use and sale of Valvoline products. The term "oil change" in the disputed domain name is a common and descriptive term for these services. The Complainant's own website for its Valvoline Instant Oil Change business is at the domain name <vioc.com>, which is not confusingly similar to the disputed domain name. The acquisition of the disputed domain name from the Registrar and subsequent non-use demonstrate the Respondent's genuine intentions and good faith. The Complainant's assertions are unfounded and overly broad, particularly in light of the recent acquisition of the Valvoline Global Operations business which supplies the Respondent with oil products by Aramco, which is thereby in competition with Valvoline, Inc. The two entities are in conflict as each grants permission to use the VALVOLINE brand for marketing purposes. The Respondent acquired the disputed domain name in good faith, in accordance with all applicable legal provisions.

## **C. The Complainant's Supplemental Filing**

The Complainant states that, contrary to the assertions made in the Responses, the Respondent is not a signatory to any agreement with the Complainant, which has not granted the Respondent permission to register domain names incorporating the Respondent's trademarks.

## **D. The Respondent's Response to the Complainant's Supplemental Filing**

The Respondent states that the Complainant has concealed the fact that it is not the only entity permitted to exploit the VALVOLINE trademark. The Respondent acknowledges that he is not a signatory to an agreement with the Complainant. The copy of the partnership agreement filed together with the Respondent's Responses serves as evidence of Valvoline's inclination to foster partnerships with diverse vendors. The PPCsite is controlled by the Registrar, not by the Respondent. The Respondent requests that the Complaint be dismissed and also requests additional time to respond to the Complainant's allegations.

## **6. Discussion and Findings**

### **6.1 Procedural Matters: Supplemental Filings**

Paragraph 10 of the UDRP Rules vests the panel with the authority to determine the admissibility, relevance, materiality and weight of the evidence, and also to conduct the proceedings with due expedition.

Paragraph 12 of the UDRP Rules expressly provides that it is for the panel to request, in its sole discretion, any further statements or documents from the parties it may deem necessary to decide the case.

Unsolicited supplemental filings are generally discouraged, unless specifically requested by the panel. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.6.

The Panel has reviewed the Parties' unsolicited Supplemental Filings of August 22 and 25, 2023 and finds that they contain information and evidence relevant for the disposition of this case. Under these circumstances, the admission of these Supplemental Filings would not unduly hamper procedural efficiency. Therefore, the Panel admits both Supplemental Filings. The Panel finds that the Parties have thereby

supplied abundant evidence for the disposition of these proceedings, and therefore declines to grant the Respondent's request to submit an additional filing.

## 6.2 Substantive Issues

Paragraph 4(a) of the UDRP requires the Complainant to make out all three of the following:

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

Under paragraph 15(a) of the Rules, “[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable”.

### 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 3.0](#), section 1.7.

Based on the available record, the Panel finds 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 entirety of the VALVOLINE mark is reproduced within the disputed domain name. The mark VALVOLINE INSTANT OIL CHANGE is also interspersed, omitting the term “instant”. Accordingly, the disputed domain name is identical or confusingly similar to the marks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

While the addition of other terms (here, “oilchange”) 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.

Based on the available record, 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.

While 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 often impossible 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. 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 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.

In particular, the Panel notes that the Respondent is not commonly known by the disputed domain name and the Respondent has provided no evidence of legitimate noncommercial fair use. Even assuming the Respondent provides (oil change) services using the Complainant's products, the record does not contain any evidence that the Respondent has permission to use the Complainant's marks in a domain name.

Pursuant to established UDRP practice, resellers, distributors, or service providers using a domain name containing the complainant's trademark to undertake sales or repairs related to the complainant's goods or services may be making a *bona fide* offering of goods and services and thus have a legitimate interest in such domain name. In such cases, under the "Oki Data test," the following four cumulative requirements must be reflected in the Respondent's use of the disputed domain name:

- (i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and
- (iv) the respondent must not try to "corner the market" in domain names that reflect the trademark

(see [WIPO Overview 3.0](#), section 2.8.1, and cases thereunder, including *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#).)

However, the Panel notes that the Respondent is using the disputed domain name in connection with a PPC website, which does not meet any of the above criteria; nor has the Respondent presented any arguments or evidence whatsoever concerning business plans or website content that would meet such criteria. The Panel also notes that in the Respondent's detailed Responses, nowhere does he mention his business name – presumably such name would not include the Complainant's registered (and famous) trademark. (It is also noted that for their length and detail, the Responses filed do not say much of substance, but merely make sweeping claims of innocence or introduce irrelevant news items.) Accordingly, reflecting established UDRP practice, the Panel finds that the Respondent's assertion of rights to use the Complainant's VALVOLINE trademark, for which the Respondent does not offer any evidence, does not establish his rights and legitimate interests in a domain name that does not resolve to a website reflecting a *bona fide* offering of goods or services. See [WIPO Overview 3.0](#), section 2.8.2.

The Panel finds that, consistent with established UDRP practice, the use of a disputed domain name (which incorporates the Complainant's VALVOLINE mark in its entirety and is confusingly similar to its VALVOLINE and VALVOLINE INSTANT OIL CHANGE marks) to resolve to a PPC website such as the one used by the Respondent does not represent a *bona fide* offering noting also that the links compete with or capitalize on the reputation and goodwill of the Complainant's mark. See [WIPO Overview 3.0](#), section 2.9.

Based on the available record, 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.

The Panel has read and carefully considered the information and arguments submitted by the Respondent in his Responses and Supplemental Filings and is unable to find that the Respondent has successfully rebutted the arguments and evidence put forth by the Complainant.

First, the Respondent errs in stating that, by registering the disputed domain name, the Registrar has assumed responsibility to ensure that the Respondent was entitled to do so or that the fact of registration demonstrates the Respondent's rights to the disputed domain name.

The Panel notes that the role of the Registrar is clearly set forth within the normative framework of the UDRP. Pursuant to Section 4.19 of the [WIPO Overview 3.0](#), "When acting solely in its capacity as a registry or registrar, and not also as a registrant, a registry or registrar is not subject to jurisdiction under the UDRP as a respondent." Under the Rules, the Complaint is directed against the Respondent, the holder of the domain name, rather than the Registrar, which is the entity with which the Respondent has registered a domain name that is the subject of the Complaint. See Rules, paragraphs 1 and 3

The Panel notes that Paragraph 2 of the UDRP sets forth the affirmative duties of the registrant (the holder of the domain name) as follows:

"By applying to register a domain name, or by asking us to maintain or renew a domain name registration, you hereby represent and warrant to us that (a) the statements that you made in your Registration Agreement are complete and accurate; (b) to your knowledge, the registration of the domain name will not infringe upon or otherwise violate the rights of any third party; (c) you are not registering the domain name for an unlawful purpose; and (d) you will not knowingly use the domain name in violation of any applicable laws or regulations. It is your responsibility to determine whether your domain name registration infringes or violates someone else's rights."

Next, the Respondent has stated his belief that his alleged partnership relationship with an entity related to the Valvoline business would provide a proper basis for his registration of the disputed domain name. However, the Panel finds that the Respondent has not provided any evidence in support of these contentions and has indeed conceded that he is not a party to any partnership agreement with the Complainant.

The Complainant has brought forth evidence (unchallenged by the Respondent) that it is the owner of the registered trademarks VALVOLINE and VALVOLINE INSTANT OIL CHANGE. The Complainant has attested that it, as the trademark owner, has not granted the Respondent permission to use these marks in a domain name. The Panel notes that the Respondent is correct in stating that the Complainant uses the domain name <vioc.com> for the website associated with its Valvoline Instant Oil Change business. However, given that the Complainant is the uncontroverted owner of the relevant trademarks, the composition of the Complainant's own domain name is largely irrelevant and at minimum does not preclude a finding that the disputed domain name is confusingly similar to those trademarks.

Under these circumstances, the Panel finds that the Respondent has intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's mark. See [WIPO Overview 3.0](#), section 3.1.4, referencing paragraph 4(b)(iv) of the Policy.

Finally, the Panel finds that the Respondent errs in stating that non-use of the disputed domain name demonstrates the Respondent's genuine intentions and good faith. In fact, the Panel finds the evidence in the record establishes that Respondent used the disputed domain name to resolve to a website featuring PPC links, which is "use" of the disputed domain name. A respondent cannot disclaim responsibility for content appearing on the website associated with its domain name. Neither the fact that such links are generated by a third party such as a registrar or auction platform (or their affiliate), nor the fact that the respondent itself may not have directly profited, would by itself prevent a finding of bad faith. Absent any evidence of mitigating factors such as efforts by Respondent to avoid links that target the Complainant's mark, the Panel finds that such use is clearly evidence of bad-faith use of the disputed domain name. See [WIPO Overview 3.0](#), section, 3.5. See also *Shangri-La International Hotel Management Limited v. NetIncome Ventures Inc.*, WIPO Case No. [D2006-1315](#); *Villeroy & Boch AG v. Mario Pingerna*, WIPO Case No. [D2007-1912](#).

Based on the available record, 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, <oilchangevalvoline.com>, be transferred to the Complainant.

*/Ingrīda Kariņa-Bērziņa/*

**Ingrīda Kariņa-Bērziņa**

Sole Panelist

Date: September 13, 2023