

ADMINISTRATIVE PANEL DECISION

Valeo v. kanshi dawar
Case No. D2023-5006

1. The Parties

Complainant is Valeo, France, represented by Tmark Conseils, France.

Respondent is kanshi dawar, India.

2. The Domain Name and Registrar

The disputed domain name <phcvaleoautoparts.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 December 1, 2023. On December 4, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same day, 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 (Domains by Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to Complainant on December 5, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on December 7, 2023.

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 Respondent of the Complaint, and the proceedings commenced on December 12, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 1, 2024. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on January 3, 2024.

The Center appointed Phillip V. Marano as the sole panelist in this matter on January 10, 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

Complainant is a global automotive supplier headquartered in Paris, France. Complainant offers its goods and aftermarket services through its official <valeo.com> and <valeoservice.com> domain names and websites. Complainant owns valid and subsisting registrations for the VALEO and PHC VALEO trademarks (collectively referred to herein as the “VALEO trademarks”) in numerous countries, including the trademark for VALEO (French Reg. No.1624041) registered on April 5, 1991. Complainant also provided evidence of trademark registrations for PHC VALEO in different jurisdictions dating back to 2005.

Respondent registered the disputed domain name on November 4, 2023. At the time this Complaint was filed, the disputed domain name resolved to a website purportedly offering VALEO branded products, using prominently the VALEO trademarks.

5. Parties’ Contentions

A. Complainant

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

Notably, Complainant asserts ownership of the VALEO trademark and has adduced evidence of trademark registrations in numerous regions and countries around the world including in China, the European Union, the United States, and parts of the Middle East, with earliest priority dating back to at least as early as April 14, 1966. The disputed domain name is confusingly similar to Complainant’s VALEO trademark, according to Complainant, because its VALEO trademarks are wholly incorporated into the disputed domain name, and the “auto parts” element of the disputed domain name is exclusively and necessarily a descriptor for products offered by Complainant.

Complainant further asserts that Respondent lacks any rights or legitimate interests in the disputed domain name based on: the existence of Complainant’s prior trademark rights; the lack of any genuine activity or legitimate reason for Respondent to use Complainant’s VALEO trademarks; the lack of any evidence that Respondent is known by the terms “phc” or “valeo”; the lack of any authorization, license or permission between Complainant and Respondent; and Respondent’s use of the disputed domain name in connection with misappropriation of Complainant’s VALEO trademarks and trade dress plus fraudulent website content with putative offers for products in competition with Complainant.

Complainant argues that Respondent has registered and used the disputed domain name in bad faith for numerous reasons, including: Complainant’s prior rights in, and the well-known nature of Complainant’s VALEO trademarks, in particular with respect to auto parts; and Respondent’s use of the disputed domain name in connection with fraudulent website content in relation to Complainant. Specifically, Complainant highlighted that Respondent’s website: misappropriates Complainant’s VALEO trademarks and Complainant’s official website trade dress; features content that targets the automotive part industry in competition with Complainant; appears to attempt to sell competing and unauthorized auto parts in competition with Complainant; advertises Complainant goods (such as “PHC VALEO metal wiper blades” that are not in fact available; and contains fraudulently backdated dates of sales and customer reviews that predate even registration of the disputed domain name.

B. Respondent

Respondent did not reply to Complainant’s contentions.

6. Discussion and Findings

To succeed in its Complaint, Complainant must establish in accordance with paragraph 4(a) of the Policy:

- i. The disputed domain name is identical or confusingly similar to a trademark 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 has been registered and is being used in bad faith.

Although Respondent did not reply to Complainant's contentions, the burden remains with Complainant to establish by a balance of probabilities, or a preponderance of the evidence, all three elements of paragraph 4(a) of the Policy. A respondent's default would not by itself mean that the complainant is deemed to have prevailed; a respondent's default is not necessarily an admission that the complainant's claims are true. UDRP panels have been prepared to draw certain inferences in light of the particular facts and circumstances of the case, e.g. where a particular conclusion is prima facie obvious, where an explanation by the respondent is called for but is not forthcoming, or where no other plausible conclusion is apparent. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), sections 4.2 and 4.3; see also *The Vanguard Group, Inc. v. Lorna Kang*, WIPO Case No. [D2002-1064](#) ("The Respondent's default does not automatically result in a decision in favor of the complainant. The Complainant must still prove each of the three elements required by Policy paragraph 4(a)").

A. Identical or Confusingly Similar

Ownership of a nationally or regionally registered trademark serves as prima facie evidence that Complainant has trademark rights for the purposes of standing to file this Complaint. [WIPO Overview 3.0](#), section 1.2.1. Complainant submitted evidence that the VALEO trademarks have been registered in numerous jurisdictions with priority dating back to at least as early as April 14, 1966. Thus, the Panel finds that Complainant's rights in the VALEO trademarks have been established pursuant to the first element of the Policy.

The only remaining question under the first element of the Policy is whether the disputed domain name is identical or confusingly similar to Complainant's VALEO trademarks. In this Complaint, the disputed domain name is confusingly similar to Complainant's VALEO trademarks because, disregarding the ".com" gTLD, the entirety of the trademarks is contained within 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 domain name ... [I]n cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar..."). In regards to gTLDs, such as ".com" in the disputed domain name, they are generally viewed as a standard registration requirement and are disregarded under the first element. [WIPO Overview 3.0](#), section 1.11.

The combination with the terms "auto parts" does not prevent a finding of confusing similarity between Complainant's VALEO trademarks and the disputed domain name. [WIPO Overview 3.0](#), section 1.8 (Additional terms "whether descriptive, geographical, pejorative, meaningless, or otherwise" do not prevent a finding of confusing similarity under the first element"); see also *AT&T Corp. v. WorldclassMedia.com*, WIPO Case No. [D2000-0553](#) ("Each of the domain names in dispute comprises a portion identical to [the ATT trademark] in which the Complainant has rights, together with a portion comprising a geographic qualifier, which is insufficient to prevent the composite domain name from being confusingly similar to Complainant's [ATT trademark]"). Indeed, the Panel concurs with Complainant that the additional term "auto parts" does not prevent a finding of confusing similarity between Complainant's VALEO trademark and the disputed domain name.

In view of the foregoing, the Panel concludes that Complainant has established the first element of the Policy.

B. Rights or Legitimate Interests

Complainant must make out a prima facie case that Respondent lacks rights or legitimate interests in the disputed domain name, shifting the burden of production on this element to Respondent to come forward with evidence demonstrating such rights or legitimate interests. Where, as in this Complaint, Respondent fails to come forward with any relevant evidence, Complainant is deemed to have satisfied the second element of the Policy. [WIPO Overview 3.0](#), section 2.1.

It is evident from the outset that Respondent, identified by Whois data for the disputed domain name as “kanshi dawar”, is not commonly known by the disputed domain name or Complainant’s VALEO trademark.

Resellers, distributors, and service providers using a domain name containing Complainant’s trademark (usually in conjunction with descriptive terms like “parts”, “repairs”, or a geographic location) to undertake sales or repairs related to Complainant’s products may be making a bona fide offering of goods and services and thus may have a legitimate interest in the disputed domain name. [WIPO Overview 3.0](#), section 2.8.1. Panels apply the fact specific “Oki Data Test” to determine whether rights or legitimate interests in the disputed domain name are present in cases where all of the following elements are met:

- i. Respondent must actually offer the goods or services at issue;
- ii. 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. Respondent must not try to “corner the market” in domain names that reflect the trademark.

See *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#). In the United States, the basis for the “Oki Data Test” is that the defense of nominative trademark use requires Respondent’s use of Complainant’s trademark “only so much as is necessary for ... identification” of Respondent’s goods or services. See *Project Management Institute v. CMN.com*, WIPO Case No. [D2013-2035](#), citing *New Kids on the Block v. News American Publishing, Inc.*, 971 F.2d 302 (9th Cir. 1992) and *Toyota Motor Sales, U.S.A., Inc. v. Tabari*, 610 F.3d 1171 (9th Cir. 2010).

In this Complaint, a cursory review of Respondent’s website confirms that it offers for sale putative third-party products, including “OGL Wiper Universal” and “XENON 4H Lamps”. Respondent’s website also does not appear to contain any disclosure or disclaimer regarding its lack of any relationship to Complainant. And most importantly, Complainant has submitted convincing evidence that Respondent is not an authorized distributor or reseller of Complainant’s products and that the goods offered on Respondent’s website are fraudulent because certain putative VALEO products advertised by Respondent have never been manufactured by Complainant. Thus, it is evident that Respondent is not making a bona fide offering of goods and services, does not have a legitimate interest in the disputed domain name, and clearly fails the Oki Data Test.

In view of the foregoing, the Panel concludes that Complainant has established the second element of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy proscribes the following non-exhaustive circumstances as evidence of bad faith registration and use of the disputed domain name:

- i. Circumstances indicating that Respondent has registered or Respondent has acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to Complainant who is the owner of the trademark to a competitor of that

Complainant, for valuable consideration in excess of Respondent's documented out of pocket costs directly related to the disputed domain name; or

- ii. Respondent has registered the disputed domain name in order to prevent the owner of the trademark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or
- iii. Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- iv. By using the disputed domain name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's website or other online location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website or location or of a product or service on Respondent's website or location.

Use of a domain name incorporating Complainant's trademark to redirect Internet users to Respondent's website, where goods or services are offered in competition with Complainant, is strong evidence of bad faith under paragraph 4(b)(iv) of the Policy. [WIPO Overview 3.0](#), section 3.1.4 (Panels have moreover found the following types of evidence to support a finding that a respondent has registered a domain name to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the complainant's mark: ... seeking to cause confusion for respondent's commercial benefit, even if unsuccessful ... the lack of a respondent's own rights to or legitimate interests in a domain name [or] redirecting the domain name to a different respondent-owned website. Here, the disputed domain name misappropriates Complainant's VALEO trademarks and resolves to Respondent's website which: (i) also misappropriates Complainant's trademarks and trade dress; (ii) advertises goods branded with Complainant's VALEO trademarks, like "PHC VALEO metal wiper blades", that do not actually exist; and (iii) contains fraudulently backdated dates of sales and customer reviews predating Respondent's registration of the disputed domain name. Accordingly, the Panel finds that use of the disputed domain name will divert potential customers from Complainant's business to the website under the disputed domain name by attracting Internet users who mistakenly believe that the disputed domain name is affiliated with Complainant, and which may further mistakenly believe that the products offered on this website are authentic products offered by Complainant, or by an entity affiliated to Complainant. Indeed, based on the totality of the evidence proffered by Complainant, in this Panel's view, test purchases from, or a deeper analysis into, Respondent's website would most likely have revealed an underlying counterfeiting or phishing scheme.

In view of the foregoing, the Panel concludes that 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, <phcvaleoautoparts.com>, be transferred to Complainant.

/Phillip V. Marano/

Phillip V. Marano

Sole Panelist

Date: January 31, 2024