

ADMINISTRATIVE PANEL DECISION

ADDINOL Lube Oil GmbH v. DIGITAL MARKETING, STRABONET
Case No. D2024-0257

1. The Parties

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

The Respondent is DIGITAL MARKETING, STRABONET, Lebanon.

2. The Domain Name and Registrar

The disputed domain name <havinol.com> is registered with FastDomain, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 22, 2024. On January 22, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 22, 2024, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the 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 January 31, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 20, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 28, 2024.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on March 8, 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 has been developing and manufacturing high performance lubricants and oils since 1936. For a long time, it also operated a chain of ADDINOL petrol stations in the then German Democratic Republic.

It appears that the Complainant operated for many years under the name Mineralölwerk Lützkendorf. Its main product, however, has been produced and marketed under the brand "Addinol" since 1990. The Complainant became registered on the commercial registry under its current name in December 1996. It currently offers more than 650 product lines in over 100 countries around the world. Its annual turnover in 2022 was EUR 100 million. In addition to its house mark, the Complainant emphasizes its products are "Made in Germany".

The Complainant promotes its business and products from a website at "www.addinol.de".

Amongst other things, the Complainant is the owner of International Registration No 695723, ADDINOL, which was registered on June 4, 1998, in respect of oils and lubricants in International Class 4. A number of national registrations have ensured including in the United States of America, China, and a number of European countries. However, the registration does not extend to Lebanon.

The disputed domain name was registered on September 24, 2022.

It resolves to a website which appears to offer for sale high quality lubricants. The website purports to be operated by a company under the name Havinol Lubricant GmbH and claims that the products are "Made in Germany". According to the website, the products are being offered for sale worldwide.

The website and the products being offered for sale are in a get-up closely corresponding to the get-up of the Complainant's website and products. For example:

Complainant's packaging



Respondent's packaging



The Complaint includes evidence of a search of the companies' register in Germany which indicates that no company is registered under the name "Havinol Lubricant GmbH".

5. Discussion and Findings

No response has been filed. The Complaint and Written Notice have been sent, however, to the Respondent at the electronic and physical coordinates confirmed by the Registrar in accordance with paragraph 2(a) of the Rules. As the physical co-ordinates recorded in the WhoIs record (and confirmed by the Registrar) were incomplete, it was not possible to complete delivery of the hardcopy materials. Bearing in mind the duty of the holder of a domain name to provide and keep up to date correct WhoIs details, therefore, the Panel finds that the Respondent has been given a fair opportunity to present its case.

When a respondent has defaulted, paragraph 14(a) of the Rules requires the Panel to proceed to a decision on the Complaint in the absence of exceptional circumstances. Accordingly, paragraph 15(a) of the Rules

requires the Panel to decide the dispute on the basis of the statements and documents that have been submitted and any rules and principles of law deemed applicable.

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of the disputed domain name, the Complainant must demonstrate each 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 disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The first element that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant's trademark rights.

The Complainant has proven ownership of the registered trademark ADDINOL.

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.

As this requirement under the Policy functions primarily as a standing requirement, the comparison between this trademark and the disputed domain name simply requires a visual and aural comparison of the disputed domain name to the proven trademarks. This test is narrower than and thus different to the question of "likelihood of confusion" under trademark law. Therefore, questions such as the scope of the trademark rights, the geographical location of the respective parties, the date they were acquired and other considerations that may be relevant to an assessment of infringement under trademark law are not relevant at this stage. Such matters, if relevant, may fall for consideration under the other elements of the Policy. See e.g. [WIPO Overview 3.0](#), section 1.7.

Disregarding the ".com" generic Top-Level Domain as a functional component of the domain name system ([WIPO Overview 3.0](#), section 1.11), the Complainant contends the disputed domain name is at least orally highly similar to the Complainant's trademark.

As the Complainant contends, ADDINOL and HAVINOL both consist of three syllables. They also contain the same vocal sequence "– A – I – NOL". The Complainant contends that the first letter "H" in "HAVINOL" is a very weak sounding consonant and has no influence on the overall phonetic impression of the word. The Complainant further contends that the two signs are similar visually, particularly allowing that consumers perceive signs as a whole rather than focusing on detail. Thus, the Complainant points out that both signs are the same length and structure, starting (in the Complainant's view) with the "A" sound and ending with "NOL".

To the extent that there may be doubt about this issue, the Panel considers this is an appropriate case also to take into account the content of the Respondent's website and get-up.

As noted in [WIPO Overview 3.0](#), section 1.15, the content of a website is usually disregarded when considering whether a domain name is confusingly similar to a complainant's trademark. However, panels have recognised that it is permissible to reference the content of a website in cases of doubt to confirm whether it appears prima facie that the respondent has been targeting the complainant's trademark. In the present case, there can be no doubt that is the case.

As noted above, the get-up of the Respondent's website and also its product is very close to the Complainant's get-up. This includes use of very similar colours, used in very similar arrangement. As the Complainant points out, the Respondent appears to be selling the same sort of high performance lubricants; they are also described as being "Made in Germany" and the Respondent's product even bears the same "German Quality" logo – a square device with a red background and a partial representation of the letter "Q" in white displayed on the bottom left hand of the products just above the volume measure. In addition, the Respondent's website presents itself as the website of a German company which, so far as company searches reveal, does not exist.

Accordingly, the Panel finds that the Complainant has established that the disputed domain name is confusingly similar with the Complainant's trademark and the requirement under the first limb of the Policy is satisfied.

B. Rights or Legitimate Interests

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in a disputed domain name:

- (i) before any notice to the Respondent of the dispute, the 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) the Respondent (as an individual, business, or other organization) has been commonly known by the disputed domain name, even if the Respondent has acquired no trademark or service mark rights; or
- (iii) the 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.

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a 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.

The Respondent registered the disputed domain name well after the Complainant began using its trademark and also well after the Complainant registered its trademark.

The Complainant states that it has not authorised the Respondent to use the disputed domain name. Nor is the Respondent affiliated with it.

The disputed domain name is not derived from the Respondent's name as verified by the Registrar. The Respondent's website does claim to be the website of a company called "Havinol" but, as already noted, no such company appears to exist. Nor is there any suggestion of some other name by which the Respondent is commonly known from which the disputed domain name could be derived. From the available record, the Respondent does not appear to hold any trademarks for the disputed domain name.

The Complainant's registered rights do not extend to Lebanon. However, it is well recognised now that trade on the Internet knows no national boundaries and the Respondent's website purports to be offering goods for sale worldwide (as well as being based in Germany).

In these circumstances, the use of the disputed domain name to misrepresent that the Respondent is the Complainant or that the Respondent's goods are the goods of or associated with the Complainant does not qualify as an offering of goods or services in good faith for the purposes of the Policy.

These matters, taken together, are sufficient to establish a prima facie case under the Policy that the Respondent has no rights or legitimate interests in the disputed domain name. The basis on which the Respondent has adopted the disputed domain name, therefore, calls for explanation or justification. The Respondent, however, has not sought to rebut that prima facie case or advance any claimed entitlement.

Accordingly, the Panel finds the Complainant has established the second requirement under the Policy also.

C. Registered and Used in Bad Faith

Under the third requirement of the Policy, the Complainant must establish that the disputed domain name has been both registered and used in bad faith by the Respondent. These are conjunctive requirements; both must be satisfied for a successful complaint: see e.g. *Burn World-Wide, Ltd. d/b/a BGT Partners v. Banta Global Turnkey Ltd*, WIPO Case No. [D2010-0470](#).

In the present case, the Panel is mindful that the trademark ADDINOL is a coined or invented word and not descriptive of the Complainant's goods. As discussed in sections 5A and 5B above, it appears that the Respondent has adopted the sign HAVINOL due to its resemblance to the Complainant's distinctive trademark and set out to mislead the consuming public into thinking the Respondent and its products are the goods of, or authorised by, the Complainant. In circumstances where the Respondent has not sought to claim, let alone establish, that it has rights or legitimate interests in the disputed domain name, therefore, the Panel finds the Respondent has registered and used it in bad faith.

Accordingly, the Complainant has established all three requirements under the Policy.

6. 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 <havinol.com> be transferred to the Complainant.

/Warwick A. Rothnie/
Warwick A. Rothnie
Sole Panelist
Date: March 25, 2024