

## **ADMINISTRATIVE PANEL DECISION**

VGP IPCo LLC and Valvoline Licensing and Intellectual Property LLC v. Cen Paul, horizonfunding  
Case No. D2024-4032

### **1. The Parties**

The Complainants are VGP IPCo LLC and Valvoline Licensing and Intellectual Property LLC, United States of America, represented by CSC Digital Brand Services Group AB, Sweden.

The Respondent is Cen Paul, horizonfunding, United States of America.

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

The disputed domain name <valvolineglobals.com> (the “Disputed Domain Name”) is registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 1, 2024. On October 2, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On October 2, 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 (Redacted for Privacy / Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 3, 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 October 8, 2024.

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 the Respondent of the Complaint, and the proceedings commenced on October 9, 2024. In accordance with the Rules, paragraph 5, the due date for Response was October 29, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 30, 2024.

The Center appointed Douglas M. Isenberg as the sole panelist in this matter on November 4, 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 Complaint states that VGP IPCo LLC and Valvoline Licensing and Intellectual Property LLC, the Complainants in this proceeding, “are the owners of trademark registrations across various jurisdictions,” including the following registrations (the “VALVOLINE Trademark”):

- United States of America Reg. No. 53,237 for VALVOLINE (registered May 29, 1906), owned by Valvoline Licensing and Intellectual Property LLC, for use in connection with “lubricating-oils”
- United States of America Reg. No. 670,453 for VALVOLINE (registered (December 2, 1958), owned by Valvoline Licensing and Intellectual Property LLC, for use in connection with “automotive type chemical- namely, anti-freeze and rust inhibitor”
- United Kingdom Reg. No. UK00000846891 for VALVOLINE (registered March 26, 1963), owned by VGP IPCo LLC, for use in connection with “all goods included in Class 4”
- United Kingdom Reg. No. UK00001073144 for VALVOLINE (registered January 17, 1977), owned by VGP IPCo LLC, for use in connection with “oil, air and fuel filters, all for use on engines, motors or on machines”
- Canada Reg. No. TMA141455 for VALVOLINE (registered August 20, 1965), owned by VGP IPCo LLC, for use in connection with, inter alia, “petroleum products for use in connection with vehicles operated by motive power and in connection with engines and machinery generally”

Although the Complaint states that “Valvoline Licensing and Intellectual Property LLC remains the IP holding company for Valvoline Inc., and its affiliated entities” and that “VGP IPCo LLC is the IP holding company for VGP Holdings LLC and its affiliated entities,” the Complaint does not explain the relationship between VGP IPCo LLC and Valvoline Licensing and Intellectual Property LLC. Further, although the Complaint refers to a number of additional entities – including Valvoline Inc., VGP Holdings LLC, Aramco and Valvoline Global Operations – the Complaint does not explain the rights and roles of these entities.

Without making clear which entity is being referenced, the Complaint states that “Complainant is known as a leading worldwide producer and distributor of premium branded automotive, commercial and industrial lubricants, and automotive chemicals”; that “Valvoline” was “[e]stablished in 1866” and “introduced the world’s first branded motor oil”; that “Valvoline currently sells in more than 140 countries and territories and drives industry solutions for every engine and drivetrain, including high-mileage and heavy-duty vehicles, offered at more than 80,000 locations”; and that “[f]or over 150 years, VALVOLINE has been one of the most recognized and respected premium consumer brands in the global automotive lubrication [sic] product and service industry.”

The Disputed Domain Name was created on May 31, 2024, and, as described in the Complaint and as shown in an annex provided therewith, “currently resolves to an inactive site.” The Complaint states that “Respondent has ignored Complainant’s attempts to resolve this dispute outside of this administrative proceeding”; in support thereof, the Complaint includes copies of three letters (dated June 28, 2024; July 10, 2024 and July 22, 2024) sent on behalf of VGP IPCo LLC and Valvoline Licensing and Intellectual Property LLC to Respondent regarding the Disputed Domain Name, which presumably went unanswered.

## **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 is confusingly similar to the VALVOLINE Trademark because, inter alia, “[i]n creating the Disputed Domain Name, Respondent has added the generic, descriptive term ‘GLOBALS’ to the end of Complainant’s VALVOLINE trademark, thereby making the Disputed Domain Name confusingly similar to Complainant’s trademark and the primary domain name of the Complainant”; and “[t]he fact that such term is closely linked and associated with Complainant’s brand and trademark only serves to underscore and increase the confusing similarity between the Disputed Domain Name and the Complainant’s trademark.”
- The Respondent has no rights or legitimate interests in the Disputed Domain Name because, inter alia, “Respondent is not sponsored by or affiliated with Complainant in any way”; “Complainant has not given Respondent permission to use Complainant’s trademarks in any manner, including in domain names”; “Complainant has not licensed, authorized, or permitted Respondent to register domain names incorporating Complainant’s trademark”; there is “no evidence, including [in] the Whois record for the Disputed Domain Name, [which] suggests that Respondent is commonly known by the Disputed Domain Name”; “Respondent is using the Disputed Domain Name to redirect internet users to a website that resolves to a blank page and lacks content”; and “Respondent has failed to make use of this Disputed Domain Name’s website and has not demonstrated any attempt to make legitimate use of the domain name and website, which evinces a lack of rights or legitimate interests in the Disputed Domain Name.”
- The Disputed Domain Name was registered and is being used in bad faith because, inter alia, “Complainant and its VALVOLINE trademark are known internationally, with trademark registrations across numerous countries” and goods and services sold under the VALVOLINE Trademark since 1866, which means that “Respondent knew, or at least should have known, of the existence of the Complainant's trademarks and that registration of domain names containing well-known trademarks constitutes bad faith per se”; although the Disputed Domain Name is not used in connection with an active website, the passive holding doctrine applies; Respondent used a privacy service to register the Disputed Domain Name; Respondent failed to respond to Complainant’s cease and desist letters; and “on balance of the facts set forth above, it is more likely than not that the Respondent knew of and targeted Complainant’s trademark, and Respondent should be found to have registered and used the Disputed Domain Name in bad faith.”

### **B. Respondent**

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

## **6. Discussion and Findings**

### **A. Preliminary Matter: Relevant Complainant**

The Complaint has been filed by two entities: VGP IPCo LLC and Valvoline Licensing and Intellectual Property LLC. Unfortunately, as stated above, the Complaint does not explain the relationship between these two entities, although some of the cited registrations for the VALVOLINE Trademark are owned by each of them. Nor does the Complaint explain either of these entity’s legal relationship to all of the additional entities haphazardly referred to in the Complaint, that is, Valvoline Inc., VGP Holdings LLC, Aramco and Valvoline Global Operations. Nor does the Complaint make clear which entity is being referenced when the

Complaint refers to “Complainant.” Such basic explanations, while perhaps not strictly necessary, are expected and would have served the process well.

Despite these shortcomings, the Panel is determined to exercise its role. As an initial matter, the Panel notes that section 1.4.2 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ([“WIPO Overview 3.0”](#)) states: “Where multiple related parties have rights in the relevant mark on which a UDRP complaint is based, a UDRP complaint may be brought by any one party, on behalf of the other interested parties.” Although how the two named complainants are related to each other is unclear, it is clear that each of them has rights in the VALVOLINE Trademark. Therefore, in this decision, references to “Complainant” shall be construed as referring interchangeably to VGP IPCo LLC and/or Valvoline Licensing or Intellectual Property LLC, as the context may allow or require.

Section 1.4.2 of [WIPO Overview 3.0](#) further states that where a complaint is filed by multiple entities, “the complainant(s) may wish to specify to which of such named interested parties any transfer decision should be directed.” Here, the Complaint fails to do so, instead ambiguously requesting transfer of the Disputed Domain Name “to the Complainant,” without specifying VGP IPCo LLC and Valvoline Licensing or Intellectual Property LLC. However, because each of these entities has rights in the VALVOLINE Trademark, it would be appropriate to order transfer of the Disputed Domain Name to either of them, as the Panel has done below.

## **B. 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.

The Complaint has shown that VGP IPCo LLC and Valvoline Licensing or Intellectual Property LLC each has rights in respect of a trademark or service mark for the purposes of the Policy, that is, the VALVOLINE Trademark. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the VALVOLINE Trademark is reproduced within the Disputed Domain Name. As set forth in [WIPO Overview 3.0](#), section 1.7, “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 to that mark for purposes of UDRP standing.” The Panel finds the VALVOLINE Trademark is recognizable within the Disputed Domain Name. Furthermore, although the Disputed Domain Name contains the additional, descriptive word “globals,” [WIPO Overview 3.0](#), section 1.8, states that “[w]here the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.”

Accordingly, the Disputed Domain Name is confusingly similar to the VALVOLINE Trademark for the purposes of the Policy, and the Panel finds the first element of the Policy has been established.

## **C. 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.

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.

#### **D. 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 not using the Disputed Domain Name in connection with an active website, and the record does not indicate any other usage of the Disputed Domain Name.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

As set forth in section 3.3 of [WIPO Overview 3.0](#):

From the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding.

While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put.

Citing *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#).

Here, the Panel finds that the VALVOLINE Trademark is highly distinctive and has a strong reputation, given that it has been registered for more than 118 years, is protected in multiple countries, and has been described by Complainant (without contradiction by Respondent) as "one of the most recognized and respected premium consumer brands in the global automotive [lubricant] product and service industry." Further, Respondent has not submitted a response or provided any evidence of actual or contemplated good faith use. Respondent concealed its identity by using a privacy service. And, there is no plausible good faith use to which the Disputed Domain Name may be put.

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 <valvolineglobals.com> be transferred to either VGP IPCo LLC or Valvoline Licensing and Intellectual Property LLC, as they shall instruct the Registrar.

*/Douglas M. Isenberg/*

**Douglas M. Isenberg**

Sole Panelist

Date: November 13, 2024