

ADMINISTRATIVE PANEL DECISION

Genuine Parts Company, National Automotive Parts Association LLC v. Zhu Xi

Case No. D2024-4191

1. The Parties

The Complainants are Genuine Parts Company, and National Automotive Parts Association LLC, United States of America (hereinafter the “Complainant”), represented by Bryan Cave Leighton Paisner LLP, United States of America (“United States”).

The Respondent is Zhu Xi, China.

2. The Domain Name and Registrar

The disputed domain name <carlyle-tools.com> is registered with Name.com, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 11, 2024. On October 11, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 14, 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 October 17, 2024. In accordance with the Rules, paragraph 5, the due date for Response was November 6, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 13, 2024.

The Center appointed Angelica Lodigiani as the sole panelist in this matter on November 18, 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 is a retailer, distributor and supplier of automotive tools, parts and accessories, as well as a provider of automotive maintenance, repair and warranty services under the CARLYLE mark. CARLYLE tools is the brand name for a professional tool line offered in the United States via NAPA Auto Parts, and in the United Kingdom and Europe via Alliance Automotive Group. CARLYLE tools comprise more than 7,000 items, including automotive professional hand tools, service tools, air tools, etc. The Complainant sells its CARLYLE tools in more than 6,000 NAPA retail stores and more than 16,000 NAPA automotive service centers across the United States and almost 2,500 points of sale in the United Kingdom and the European Union.

The Complainant is the owner of a large portfolio of CARLYLE registered marks in various jurisdictions worldwide, including:

- CARLYLE TOOLS, Canadian registration No. TMA1172028, registered on March 22, 2023, for goods in classes 7, 8 and 11;
- CARLYLE, Chinese registration No. 32341763, registered on April 7, 2019 for goods in class 8;
- CARLYLE, United States registration No. 5,738,953, registered on April 30, 2019 for goods in classes 7, 8 and 11, claiming a first use in commerce since August 30, 2018;

Furthermore, since 2011 at least, the Complainant has maintained an active presence on the Internet through its websites at <carlyletools.com>, registered on October 7, 2011, and <napaonline.com>, where it promotes its tools in connection with the CARLYLE marks.

In addition, the Complainant owns various domain names comprising its CARLYLE mark, among which the following: <carlyle.tools>, <carlyletool.biz>, <carlyletool.com>, <carlyletool.info>, <carlyletool.net>, <carlyletool.org>, <carlyletools.biz>, <carlyletools.info>, <carlyletools.net> and <carlyletools.org>.

The disputed domain name was registered on June 4, 2024, allegedly by a Chinese individual and resolves to a website promoting purported CARLYLE branded tools through photographs and descriptions taken from the Complainant's official catalogue and displaying the CARLYLE and NAPA marks prominently.

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 its CARLYLE mark because it incorporates such mark in its entirety and the addition of the descriptive word "tools" cannot prevent a finding of confusing similarity. Moreover, the disputed domain name is identical to the Complainant's CARLYLE TOOLS mark with the sole addition of a hyphen.

The Complainant further maintains that the Respondent lacks rights or legitimate interests in the disputed domain name. In particular, the Respondent is not associated with the Complainant and has never sought nor received any authorization to use the Complainant's marks.

The Complainant's marks are famous and well known internationally and have been used since approximately 2011. The Respondent does not appear to be commonly known by the disputed domain name. To the best of the Complainant's knowledge, the Respondent has not sought or procured any registrations for tradenames, corporations or trademarks for the word "carlyle". The disputed domain name resolves to a website promoting the Complainant's CARLYLE tools for sale, and replicating the product

descriptions from the Complainant's official website, in an attempt to impersonate the Complainant and infringing the Complainant's copyright rights. The Respondent is therefore seeking to take advantage from the Complainant's notoriety by luring web browsers to the Respondent's website through a misleading domain name. Such use of the disputed domain name cannot amount to a legitimate noncommercial or fair use.

Lastly, the Complainant argues that the Respondent registered and is using the disputed domain name in bad faith. In the Complainant's view, the Complainant acted in opportunistic bad faith. The disputed domain name was registered with a deliberate intent to create an impression of association with the Complainant. The CARLYLE mark derives from the name of the Complainant's founder and is a trademark that has been used since as early as 2011 and is well known in its field. Hence, the Respondent was well aware of the Complainant's mark when it registered the disputed domain name.

With respect to use in bad faith, the Panel notes that the disputed domain name resolves to a website that falsely suggests an affiliation with or endorsement by the Complainant to attempt to attract customers to purchase tools that the Complainant has not authorized, from the Respondent's website. The Respondent's website does not contain a disclaimer notifying the public that the website is not affiliated with the Complainant. Moreover, the Complainant asserts that the Respondent has presumably provided false contact details at the time of the registration of the disputed domain name. The provision of false contact details is a further indication of bad faith. Lastly, the Respondent's e-mail address "[...]@carlyle-tools.com" appearing on the Respondent's website indicates that the Respondent has set up mail exchanges ("MX records") for the disputed domain name. Accordingly, there is a serious risk that the Respondent may be engaged in a phishing scheme, aiming at deceiving Internet users, inducing them to believe that they are dealing with the Complainant while in fact they are not.

B. Respondent

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

6. Discussion and Findings

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 of WIPO Panel Views on Selected UDRP Questions, Third Edition, (["WIPO Overview 3.0"](#)), section 1.7.

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. In particular, the Complainant is the owner of the registered marks CARLYLE TOOLS and CARLYLE. The disputed domain name is almost identical to the Complainant's mark CARLYLE TOOLS as it includes it entirely with the sole addition of a hyphen separating the words "Carlyle" and "tools". Moreover, the disputed domain name incorporates the Complainant's mark CARLYLE, while the addition of the word "tools", which may bear on assessment of the second and third elements, 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.

Accordingly, 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.

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.

In particular, the Complainant notes that the Respondent has no relationship with the Complainant and that the Complainant never authorized the Respondent to use its CARLYLE and CARLYLE TOOLS marks in any manner, including as part of the disputed domain name. Furthermore, the Respondent does not appear to own trademarks or other exclusive rights encompassing the terms “carlyle” or carlyle tools” and nothing in the case file shows that the Respondent might have been known by the disputed domain name.

The disputed domain name is highly misleading for the Internet users looking for the Complainant as it reflects the Complainant’s mark CARLYLE TOOLS almost identically - the only difference being the addition of a hyphen between the words “carlyle” and “tools” - and is confusingly similar to the Complainant’s mark CARLYLE. The addition of the term “tools” to the CARLYLE mark enhances the strict association of the disputed domain name with the Complainant and its mark as it refers to the Complainant’s activity. Thus, the disputed domain name carries a risk of implied affiliation with the Complainant.

The disputed domain name resolves to a website displaying the Complainant’s CARLYLE and NAPA marks prominently and promoting alleged CARLYLE automotive tools. Upon comparing the Respondent’s website with the Complainant’s official CARLYLE tools catalogue, it appears that the photographs and descriptions of the CARLYLE tools on the Respondent’s website are those contained in the Complainant’s catalogue and have been copied without authorization. Moreover, the Respondent’s website contains several associations with the Complainant and its business. Among these, the fact that the CARLYLE tools are “*premium quality*, American-made tools” and “Made in USA”, when the Complainant is a United States company, while the Respondent allegedly originates from China. In the FAQ section the answer to the question “How can I tell if a tool is made by Carlyle?” is: “Authentic Carlyle Tools can be identified by the Carlyle name stamped directly into the tool. Also, look for the made in USA marking. Carlyle takes pride in American craftsmanship”. Among the multiple reference to the Complainant’s marks, the Respondent’s website also contains the following statement: “The Carlyle® Tools Box name, logo and all related names, logos, product and service names, designs and slogans are trademarks of Carlyle® Tools Box or its affiliates or licensors. You must not use such marks without the prior written permission of Carlyle® Tools Box. All other names, logos, product and service names, designs and slogans on this Website are the trademarks of their respective owners. All trademarks, service marks, trade names, trade dress, product names and logos appearing on the site are the property of their respective owners. Any rights not expressly granted herein are reserved.” In addition, the website contains reviews from alleged clients active in the automotive field. Finally, the Panel notes that the Respondent’s contact email address on the Respondent’s website are either “[...]@carlyle-tools.com”, or, in the Privacy Policy section, “[...]@carlyle.com”. With respect to the first email address, the Panel notes that most probably the Respondent set up MX records for the disputed domain name. As far as the second email address is concerned, the Panel notes that the domain name <carlyle.com> resolves to a website, which apparently belongs to an unrelated third party.

Thus, the website associated with the disputed domain name provides the strong impression that it belongs to the Complainant, or at least to someone affiliated or having a close relationship with the Complainant, while in fact this is not the case.

Panels have held that the use of a domain name for illegitimate activity such as impersonation/passing off, or other types of fraud, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

In light of the foregoing, 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.

In the present case, the Panel opines that the Respondent was aware of the Complainant and of its CARLYLE marks when it registered the disputed domain name. First, the Panel notes that CARLYLE is a distinctive term when used in connection with automotive tools and related services. The Complainant has explained that CARLYLE derives from the name of the Complainant's founder. Thus, there is a strict connection between the CARLYLE marks and the Complainant. Furthermore, the disputed domain name consists of the CARLYLE mark and the descriptive word "tools", which exactly refers to the Complainant's business and is identical to the Complainant's CARLYLE TOOLS Canadian mark referred to in the "Factual Background" section above. Lastly, the disputed domain name resolves to a website depicting the trademarks CARLYLE and NAPA prominently and reproducing photographs and texts taken from the Complainant's official catalogue. It is therefore clear that when the Respondent registered the disputed domain name it had well in mind the Complainant and its CARLYLE marks. By registering the disputed domain name, the Respondent targeted the Complainant's marks in order to lure Internet users into believing that the website associated with the disputed domain name belongs to, or is sponsored by, the Complainant. The registration of a domain name identical or confusingly similar to a complainant's earlier mark, being aware of such mark and without rights or legitimate interests amounts to registration in bad faith.

With respect to use in bad faith, the disputed domain name resolves to a website displaying the Complainant's copyrighted material without authorization and containing numerous references to the Complainant. Despite the Respondent's website apparently does not allow the online purchase of the alleged CARLYLE tools, the website contains a section titled "Carlyle Tools Sales Today". The photographs and explanations of the Complainant's tools appear in this section along with the sale price of these items in US dollars. The website also contains a section called "Why Choose Carlyle® Tools" illustrating all the advantages of buying the CARLYLE branded tools. Finally, the FAQ section explains why the CARLYLE tools "are priced higher than cheaper imported brands". Hence it is clear that the Respondent's intention is to either sell alleged CARLYLE branded tools, or at least provide the impression that its business is to sell these tools, thus inducing the Internet visitors to send enquiries through the contact e-mail address indicated on the Respondent's website. To this respect, the Panel notes that the Respondent has configured MX records in connection with the disputed domain name, and that the website terms and conditions of the Respondent's website indicate: "[t]o access some features of the Website, you may be required to register and create an account. When you create an account, you agree to provide accurate, current and complete information about yourself. You also agree not to impersonate or misrepresent any person or entity or falsely state or otherwise misrepresent your affiliation with anyone or anything". The same terms and condition also indicate that "(...) Carlyle® Tools Box's liability to you arising from or related to these terms is limited to the greater of (a) the amount of fees, if any, you paid to Carlyle® Tools Box through the website in the 12 months prior to the event giving rise to the liability, or (b) One Hundred U.S. Dollars (\$100)".

In light of the aforementioned circumstances, the Panel finds that the Respondent has been using the disputed domain name in bad faith, to intentionally attempt to attract Internet users by creating a likelihood of confusion with the Complainant's mark, for commercial gain, or for some other illegal purpose, such as impersonation/passing off, or other types of fraud. Panels have held that the use of a domain name for these illegitimate activities constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

Lastly, it appears that the Respondent used false contact details at the time of the registration of the disputed domain name (noted to be in breach of its registration agreement), probably in an attempt to conceal its identity, thus making more difficult to protect the rights of the Complainant and those of the consumers.

Accordingly, 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 <carlyle-tools.com> be transferred to the Complainant.

/Angelica Lodigiani/

Angelica Lodigiani

Sole Panelist

Date: December 2, 2024