

ADMINISTRATIVE PANEL DECISION

ADDINOL Lube Oil GmbH v. mckiek, zahraa
Case No. DCO2024-0044

1. The Parties

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

The Respondent is mckiek, zahraa, Lebanon.

2. The Domain Name and Registrar

The disputed domain name <havinol.co> is registered with Network Solutions, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 21, 2024. On June 21, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 26, 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 (Unknown, Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 1, 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 the same day.

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 July 3, 2024. In accordance with the Rules, paragraph 5, the due date for Response was July 23, 2024. The Respondent sent two informal email communications to the Center on July 5, 2024.

The Respondent did not submit a formal response. Accordingly, the Center notified the Respondent's default on July 29, 2024.

The Center appointed Andrew D. S. Lothian as the sole panelist in this matter on July 31, 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 manufacturer and developer of high performance lubricants with a history of more than 80 years. Lubricants and oils have been manufactured at the Complainant's German headquarters since 1936. The Complainant's product portfolio also included fuels, which were sold at ADDINOL branded fuel stations in the former German Democratic Republic. The Complainant's principal product has been marketed under the ADDINOL brand since 1990.

The Complainant produces more than 650 different ADDINOL branded products that are also badged "Made in Germany" and are available worldwide via dealers in over 100 countries.

Among others, the Complainant is the owner of International Registered Trademark Number 695723 for the word mark ADDINOL, registered on June 4, 1998, in Class 4 (Oils and lubricants for industrial use; oils for engines and gears of motor vehicles). The mark is designated in respect of a variety of territories which do not include Lebanon, where the Respondent is based.

The disputed domain name was registered on May 3, 2024. Little is known about the Respondent other than that it has a partial address reportedly in Beirut, Lebanon. The website associated with the disputed domain name promotes the sale of "Havinol" branded oils and lubricants under a "Made in Germany" banner and includes an online shop. The products on said site are packaged in a manner that imitates the packaging of the Complainant's products, notably, the taupe coloring of the containers with a large sweep from the bottom to the side containing an indented version of the capitalized brand, an embossed "Made in Germany" strapline below the cap at 45 degrees, a capitalized brand on the label in large letters followed by the ® symbol with underscoring via red banners overtyped in white lettering, and the unauthorized reproduction of a copy of the Complainant's "German Quality" logo.

The Respondent's website claims that it is a Gesellschaft mit beschränkter Haftung ("GmbH"), i.e., a German company, based in Suhl, Germany. The Complainant points out that there are no results for this company on a search of the German Commercial Register.

The Complainant states that the Respondent is the same person who registered the domain name <havinol.com> which was the subject of a previous complaint under the Policy (see: *ADDINOL Lube Oil GmbH v. Digital Marketing, Strabonet*, WIPO Case No. [D2024-0257](#)) in respect of which the panel concerned ordered transfer of the domain name to the Complainant. Although the name of the respondent concerned is different from that of the Respondent, both are noted to be based in Lebanon. The Complainant's position is that following the decision in said previous case dated March 25, 2024, the Respondent registered the disputed domain name and pointed this to the website previously associated with the domain name <havinol.com> with marginal modifications.

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 elements “havinol” and ADDINOL are visually similar, with the same length and overall structure and the same ending. They are aurally highly similar, with both signs consisting of three syllables containing the same A-I-O vocal sequence, which is important for phonetic similarity and a first sequence dominated by the letter “A”. Where the elements differ in some of their letters, the differing characters are weak-sounding consonants that do not stand out phonetically and do not define the sound pattern. The similarity of the signs is intentionally increased by the fact that the Respondent uses its sign on products on the related website that imitate the Complainant’s packaging in design and color scheme.

The Complainant also contends that its ADDINOL mark has a worldwide reputation while the disputed domain name has only been registered recently, adding that the Respondent claims it is a German company but no official evidence can be found thereof. The Complainant concludes that the use of a highly confusing domain name for a website offering imitations of the ADDINOL branded products constitutes trademark infringement and could not be regarded as a legitimate interest.

Finally, the Complainant contends that the Respondent’s registration and use of the disputed domain name that is highly similar to the ADDINOL mark in connection with the sale of products that imitate the ADDINOL branded products shows that the Respondent acted in bad faith, in the knowledge of the Complainant’s mark and with the clear intention of imitating the Complainant. The Complainant has engaged in this practice on a previous occasion, as demonstrated by *ADDINOL Lube Oil GmbH v. Digital Marketing, Strabonet*, supra. The Respondent has used a false company and contact details, together with a proxy service to hide its identity. The Respondent purposely misleads consumers by creating the impression that its shop is an original online shop of the Complainant or associated with it by way of the overall design and color scheme, matching the signature scheme of the Complainant.

B. Respondent

The Respondent did not reply to the Complainant’s contentions. Its informal emails to the Center did not disclose any substantive response to the Complaint.

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.

The Panel finds the mark is recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The Panel notes that the Complainant’s mark and the disputed domain name are not alphanumerically identical. However, they are phonetically very similar, and the Panel notes the consensus views of panels under the Policy that an assessment of phonetic similarity may be made in appropriate cases alongside the typical side-by-side comparison. [WIPO Overview 3.0](#), section 1.7.

Here, there are three syllables in both the Second-Level Domain of the disputed domain name and the Complainant's mark, and the second two syllables in each are identical. This fact alone means that a dominant feature of the relevant mark is recognizable in the disputed domain name. While the first syllable is different, the Panel accepts the Complainant's contention that the initial consonant "h" is relatively weak and that the focus of the first syllable is on the letter "a", which is present in both the disputed domain name and the Complainant's mark. In addition to phonetic similarity, the Panel considers that the mark and disputed domain name are aurally similar, in the sense that they will be heard in the same way when spoken. To a large extent, this follows from the phonetic similarity which leads to a similar rhythm in the spoken words, together with an identical word ending.

The applicable Top Level Domain ("TLD") in the disputed domain name is required for technical reasons only and is typically disregarded in the comparison process. [WIPO Overview 3.0](#), section 1.11.

The [WIPO Overview 3.0](#), section 1.7 goes on to note that in specific limited instances, where a panel would benefit from affirmation as to confusing similarity with the complainant's mark, the broader case context such as website content trading off the complainant's reputation, may support a finding of confusing similarity. As the panel noted in *ADDINOL Lube Oil GmbH v. Digital Marketing, Strabonet*, supra, where it was faced with a domain name that only differed by a single letter from the disputed domain name here (in the generic Top-Level Domain ("gTLD") rather than in the Second-Level Domain), "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."

The Panel notes that the website content associated with the disputed domain name features products which appear to have been intentionally designed to imitate the Complainant's products in multiple ways, as outlined in the factual background section above. It is clear to the Panel that the disputed domain name is part of the Respondent's overall imitative scheme and is intended by the Respondent to be mistaken for the Complainant's ADDINOL mark. In the Panel's view this affirms the confusing similarity already identified via the phonetic, aural and typical side-by-side comparisons outlined above.

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.

The Complainant's trademark is of a longstanding nature and the disputed domain name has only been recently registered. The Complainant's trademark is used worldwide to identify the Complainant's specialized lubricants. It is clear from a review of the website associated with the disputed domain name that the Respondent is engaged in a scheme to imitate the trade dress of the Complainant. The disputed domain name, being confusingly similar to the Complainant's mark as discussed in the preceding section, is part of that scheme. While the Respondent appears to be based in Lebanon, to which the Complainant's various trademarks do not appear to extend, it is nevertheless clear that the Respondent's intent is to target the Complainant in the various global markets in which the Complainant operates, and the products sold on its website are allegedly available worldwide. Notably, the Respondent claims to be a German company and that its product is of German origin, though there is no evidence available to vouch for this, and the official company register does not support the former claim. The Respondent has added a reproduction of the Complainant's "German Quality" logo to its product. In all of these circumstances, while the disputed domain name is being used in connection with an offering of goods and services, the Panel cannot find with reference to paragraph 4(c)(i) of the Policy that such offering is bona fide, given that the Respondent appears to be taking unfair advantage of the Complainant's goodwill in imitating the trade dress of its products and its ADDINOL mark.

For completeness, the Panel notes with reference to paragraph 4(c)(ii) of the Policy that there is no evidence that the Respondent has been commonly known by the disputed domain name. The Whois record does not mention the name "havinol", and, as noted above, the Respondent's claimed German registered company does not exist on the appropriate register. With reference to paragraph 4(c)(iii) of the Policy, the use of the disputed domain name is clearly commercial in nature, as the presence of the Respondent's online shop at the associated website signifies intent for commercial gain.

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 notes that the Respondent has registered the disputed domain name shortly after the decision in a previous case under the Policy, *ADDINOL Lube Oil GmbH v. Digital Marketing, Strabonet*, supra, in which the panel ordered transfer of the domain name concerned. That domain name, <havinol.com> is largely identical to the disputed domain name in the present case, as previously discussed, and the disputed domain name has been used for the same website (with minor adjustments) to which the domain name <havinol.com> previously pointed. Furthermore, the website under the disputed domain name contains a reference to said website and includes an email address with that domain name. Given that the registration of the disputed domain name comes immediately on the heels of the said previous case, and that the respondent in the previous case appears to be connected to the Respondent in the present case, demonstrated by the use of the same associated website, the Panel finds that the disputed domain name was registered in the knowledge of the Complainant's rights and with intent to target these.

The Panel in the present case has reached the same conclusion as the panel in the said previous case, namely that the Respondent has adopted the sign "Havinol" due to its resemblance to the Complainant's distinctive (and non-descriptive) trademark, and has set out to mislead the consuming public into thinking that the Respondent and its products are the goods of, or authorized by, the Complainant, by copying its trade dress and using this in connection with the said sign. The Respondent did not claim that it had rights and legitimate interests in the domain name <havinol.com> in the previous case, nor has it claimed rights and legitimate interests in the disputed domain name in the present case. It has not put forward any possible good faith motivation regarding the registration and use of the disputed domain name, and the Panel cannot conceive of any such motivation based upon the present record. In all of these circumstances, the Panel is of the opinion that the Respondent registered and used the disputed domain name in bad faith.

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 <havinol.co> be transferred to the Complainant.

/Andrew D. S. Lothian/

Andrew D. S. Lothian

Sole Panelist

Date: August 14, 2024