

ADMINISTRATIVE PANEL DECISION

Valero Energy Corporation and Valero Marketing and Supply Company v.
Lisa Katz, Domain Protection LLC / Domain Hostmaster, Customer ID:
62520014085963
Case No. D2015-0787

1. The Parties

The Complainants are Valero Energy Corporation and Valero Marketing and Supply Company of San Antonio, Texas, United States of America (“United States”) (hereinafter “the Complainant”), represented by Fasthoff Law Firm PLLC, United States.

The Respondent is Lisa Katz, Domain Protection LLC of Dallas, Texas, United States / Domain Hostmaster, Customer ID: 62520014085963 of Fortitude Valley, Queensland, Australia.

2. The Domain Name and Registrar

The disputed domain name <valerorefinery.com> is registered with Fabulous.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 2, 2015. On May 4, 2015, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 5, 2015, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on May 6, 2015 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 May 6, 2015.

The Center verified that the Complaint together with the Amended Complaint (hereinafter the term “Complaint” will refer to the amended Complaint unless the context specifically indicates otherwise) satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy”), 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(a) and 4(a), the Center formally notified the Respondent of the Complaint and the proceedings commenced on May 13, 2015 through issuing, on May 13, 2015, a Written Notice of the Complaint (“Complaint Notice”), and a Notification of Complaint and Commencement of Administrative Proceedings (“Commencement Notification”). In accordance with the Rules, paragraph 5(a),

the due date for a response was set in the Commencement Notification to June 2, 2015. Further, as stated on page 5 of that notification, the Center provided a copy of the Complaint and all its attachments to the Respondent by e-mail, with hard-copies of the Complaint Notice also sent by courier to the Respondent. The Center did not send the Respondent a copy of the Commencement Notification by facsimile as the Respondent's contact information, maintained by the Registrar, did not include a facsimile number.

The Respondent did not submit any Response. Accordingly, on June 2, 2015, the Center notified the Parties of the Respondent's default.

Subsequently, and in response to the June 2, 2015 default notification, the Respondent sent an email message to the Center on June 3, 2015 stating that it had not received from the Center a copy of the Commencement Notification. Later on June 3, 2015, the Center replied, by email, and provided a copy of its prior May 13, 2015 communication, including the Commencement Notification and its attachments, to the Respondent. Thereafter, again on June 3, 2015, the Respondent replied, by email, back to the Center through which it: (a) stated that it had not previously seen the Commencement Notification and had never received a hard-copy of it, and (b) requested an opportunity to respond to the Complaint. On the following day, June 4, 2015, the Center informed the Respondent that, as stated in the Commencement Notification, the Center had sent that notification on May 13, 2015 to the Respondent's e-mail address and did not receive a bounce-back message, and, of the two identical hard-copy versions of the Complaint Notice sent by courier, the Complaint Notice sent to the United States was delivered and the one sent to Australia was undeliverable. The Center also informed the Respondent that: (a) the Rules do not expressly provide for party submission of any materials after the due date for a response has passed, and (b) thus, the discretion solely lies with the panel as to whether it will accept any such filing and, in conjunction, require any further procedural steps. On June 4, 2015, the Respondent replied to the Center's latest communication by stating:

"Your response is odd. / Seems clear you don't have a delivery receipt for us-- we did not receive any package. The fact that you sent another package to someone else, does not seem very relevant. /Our PO box is an official U.S. post office address. Not possible it was 'undeliverable'."

On June 5, 2015, the Center, responding to the Respondent's June 4th message, sent an e-mail communication to the Respondent: (a) specifying it had previously sent the Respondent on May 13, 2015 a copy of the Complaint Notice, the Commencement Notification together with a copy of the Complaint and its attachments, and (b) once again providing a copy, by email attachment, of the Commencement Notification and the Complaint including the latter's attachments. The Center again specified that the due date for any response was June 2, 2015 and thus far no response has been received. The Respondent, on June 6, 2015 replied, by email, to the Center's June 5th communication by stating:

"Your replies are very strange. / You previously sent a 'proof of mailing' to the post box that was not from any known postal service in the world, Swiss or otherwise. / You also acknowledge that the post was not delivered. Since the listed address is an official U.S. Post office box, it is not credible that anything was actually sent. The U.S. Post office does not refuse mail from any country (that we know of), and is never closed. / Do not see how you discharged your obligation under the "Rules", and your failure to so seems systematic and supported by repeated denials and affirmative misrepresentations of compliance. / Now you claim you also sent by fax. Please send a copy of the fax receipt."

On June 9, 2015, the Center, in reply to the Respondent's June 6th message, stated that the June 6th message would be provided to the Panel for its consideration, once nominated.

The Center received nothing further from the Respondent.

The Center appointed Peter L. Michaelson as the sole panelist in this matter on June 9, 2015. 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

As reflected in the registration record for the disputed domain name in the Whois database (a copy of the records appears in Annex 1 to the Complaint), the disputed domain name <valerorefinery.com> was registered on February 4, 2005 and is set to expire on February 4, 2016.

A. The Complainant's VALERO Marks

As indicated in the Complaint, the Complainant owns various United States trademark registrations for the mark VALERO in both block letters and stylized forms, including, for some of its registrations, the latter with a design element. The Complainant has provided, in Annex 4 to the Complaint, copies of its trademark registration certificates. A sample of those registrations is as follows:

1. VALERO (block letters)
United States registration no.: 1,314,004
registered: January 8, 1985; filed: August 1, 1983

This mark is registered for use in connection with: "Oil and gas exploration, production, processing and distribution services" in international class 42. This registration claims a date of first use and first use in commerce in connection with these services of February 7, 1983.

2. VALERO (block letters)
United States registration no.: 2,560,091
registered: April 9, 2002; filed: May 8, 2000

This mark is registered for use in connection with: "Retail store services featuring convenience store items, food products, toiletries, fuel, and lubricants" in international class 35. This registration claims a date of first use and first use in commerce in connection with these services of June 15, 2000.

3. VALERO (stylized with design)
United States registration no.: 2,656,973
registered: December 3, 2002; filed: June 7, 2000

This mark is registered for use in connection with: "Convenience store services" in international class 35, and "Automobile service station services and car wash services" in international class 37. This registration claims a date of first use and first use in commerce in connection with these services, recited in both classes 35 and 37, of August 15, 2000.

B. The Parties and their interaction

The Complainant is a large independent oil refiner. It has continuously used its mark VALERO in commerce for more than 30 years. During that time, it has spent tens of millions of United States dollars advertising, marketing, and promoting its VALERO brand in the United States and throughout the world in a wide variety of media formats, including print, television, radio, Internet, billboards, and signage.

Additionally, the Complaint has continuously owned and operated an Internet website under the domain name <valero.com> for many years and also utilizes that name for company email addresses through which it communicates internally, with customers, vendors, and the public in general.

When the Respondent registered the disputed domain name, the Complainant was listed as the 22nd largest company in the United States according to *Fortune* magazine – a copy of the corporate ranking, as it appeared in *Fortune* from 2004-2014, is provided in Annex 7 to the Complaint.

The Respondent, at least as of May 1, 2015, uses the disputed domain name to resolve to its website which consists of a parking page containing lists of sponsored click-through links to third-parties and, in conjunction with these links, apparently employs [...] LLC's domain name commercialization service. A screen shot of the home page of that site appears in Annex 6 to the Complaint.

5. Parties' Contentions

A. Complainant

(i) Identical or Confusingly Similar

The Complainant contends that the disputed domain name is confusingly similar to its VALERO marks.

Specifically, the disputed domain name contains the VALERO marks to which the generic word "refinery" has been appended, with that word being incapable of adding sufficient distinctiveness whatsoever to the resulting disputed domain name to mitigate any resulting user confusion between the name and its marks.

Hence, the Complainant believes that it has satisfied the confusing similarity/identity requirement in paragraph 4(a)(i) of the Policy.

(ii) Rights or Legitimate Interests

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraph 4(a)(ii) of the Policy.

First, the Respondent has never been commonly known by the disputed domain name, has not used or made demonstrable preparations to use the disputed domain name, and is not making a legitimate noncommercial or fair use of the disputed domain name without intent for commercial gain. Further, the Complainant has never licensed the Respondent to use any of the VALERO Marks, and the Respondent is not otherwise authorized to act on the Complainant's behalf.

(iii) Registered and Used in Bad Faith

The Complainant also contends that the Respondent has registered and is using the disputed domain name in bad faith pursuant to paragraph 4(a)(iii) of the Policy.

Inasmuch as the Complainant has used its VALERO marks in commerce for more than 30 years, and at the time the Respondent registered the name, the Complainant was the 22nd largest company in the United States, the Respondent was clearly aware of the Complainant. In spite of that knowledge, the Respondent intentionally registered the disputed domain name, containing the Complainant's marks, in order to commercially profit from those marks. Further, by doing so, the Respondent, in registering the disputed domain name, prevented the Complainant from reflecting its VALERO marks in a corresponding domain name.

B. Respondent

In view of the lack of a Response filed by the Respondent as provided under paragraph 5 of the Rules, this proceeding has proceeded by way of default. Hence, under paragraphs 5(e), 14(a) and 15(a) of the Rules, the Panel is directed to decide this administrative proceeding on the basis of the Complainant's undisputed factual representations.

6. Discussion and Findings

A. Notice

For the sake of brevity, the Panel will not summarize here the communications that occurred between the Respondent and the Center between June 3-9, 2015 concerning the nature of the notice provided by the Center and its adequacy, but instead will simply refer the reader to that portion of the Procedural History

section above which delineates those communications.

The Panel finds that the notice provided by the Center fully complied with the dictates of paragraph 2(a) of the Rules and thus the Center properly discharged all its obligations under the Rules to provide proper notice to the Respondent of this proceeding.

To the extent the Respondent did not receive physical notice of this proceeding from the Center, any failure is likely due to the Respondent's own fault in providing the Registrar what may have been defective contact information, which prevented delivery of the Complaint Notice sent by courier. Further, the Center did not receive a bounce-back or other error message to its communication, including the Commencement Notification, sent by email on May 13, 2015 to the Respondent's address at [...]@domainp.net. Moreover, for the communications that occurred between June 3-9, 2015, the Respondent sent its messages to the Center from this address with the Center having sent its replies to the Respondent, to this very same address. As this address was functional at least between June 3-9, 2015 and there is no evidence it was not similarly functional on May 13, 2015, the Panel infers that the Respondent received notice of this proceeding on May 13, 2015, including the Commencement Notification and all its attachments, including the Complaint, by email at this address.

Moreover, paragraph 2(a) of the Rules does not require that the communication actually be received by a respondent through any or all of the different modalities the Center used, but only that notice was transmitted to a respondent through these modalities, *i.e.* that the Center employ "reasonably available means calculated to achieve actual notice to Respondent" and, once done, "[a]chieving actual notice, or employing the following measures to do so, shall discharge this responsibility". The Center used all means then available to it as specified in paragraphs 2(a)(i)-(iii) of the Rules and employed all the Respondent's contact information then provided in the Registrar's Whois database for the disputed domain name and verified to the Center by the Registrar, thus fully discharging its responsibilities.

Given the successful delivery by courier of the Complaint Notice to at least one of the Respondent's listed addresses, as well as the fact that the Respondent communicated with the center at all times from the same e-mail address, one that was copied in the Center's Commencement Notification email to the parties, the Panel believes the Respondent was properly notified of the commencement of the proceedings and the Complaint. Once the Center has fully discharged its responsibility under paragraph 2(a) – as it has done here, it owes the Respondent no further duty in providing notice.

B. Identical or Confusingly Similar

The Panel finds that the disputed domain name is confusingly similar to the Complainant's mark VALERO marks.

From a simple comparison of the disputed domain name to the Complainant's VALERO marks, no doubt exists that the disputed domain name is confusingly similar to the Complainant's marks. The differences between the disputed domain name and the marks amount to the generic word "refinery" having been appended to the marks to form a composite term and the generic Top-Level Domain ("gTLD") ".com" having been appended to that term to form the disputed domain name, with the last addition being irrelevant in this case in assessing confusing similarity or identity under paragraph 4(a)(i) of the Policy and thus ignored. It is now very well-established in UDRP precedent, including numerous decisions previously rendered by this Panel, that a minor variation, such as adding a short letter or number group, or even generic or highly descriptive words, or geographic identifiers, such as a country name, to a mark, is usually insufficient in and of itself, when used in forming a domain name that results from modifying the mark, to confer requisite and sufficient distinctiveness to that name to avoid user confusion. Here, adding the word "refinery" in the manner which the Respondent specifically did, to the term "Valero" clearly resulted in such a minor variation. See, *e.g.*, *Cummins Inc. v. Jamie Lent*, WIPO Case No. D2015-0188; *Staatliche Porzellan-Manufaktur Meissen GmbH v. Buy Meissen*, WIPO Case No. D2013-1687; *Forideas Pty Limited v. Movember Organization*, WIPO Case No. D2013-1385; *AlgaeCal Inc. v. AlgaeCal Fraud*, WIPO Case No. D2013-1248; *General Motors LLC v. Carol Schadt*, WIPO Case No. D2012-2106; *National Westminster Bank plc v. Steve Mart*, WIPO Case No. D2012-1711; *Tommy Bahama Group, Inc. v. Berno Group International*, WIPO Case

No. D2012-0531; *National Association of Realtors v. Hammerberg & Associates, Inc.*, WIPO Case No. D2012-0075; *Space Needle LLC v. Erik Olson*, WIPO Case No. D2011-0931; *Oakley, Inc. v. Kate Elsberry, Elsberry Castro*, WIPO Case No. D2009-1286; *Clearwire Legacy, LLC v. Leon Ganesh*, WIPO Case No. D2010-0148; *Burberry Limited v. Domain Admin*, WIPO Case No. D2009-0703; *Krispy Kreme Doughnuts, Inc. v. John Sharp*, WIPO Case No. D2009-0099; *MasterCard International Incorporated v. Global Prepaid*, WIPO Case No. D2008-2008; *HRB Innovations Inc., Express Tax Service Inc. v. Calvin Brown*, WIPO Case No. D2008-1072; *Dreamworks Animation, LLC v. Creahq, Mike Furlong*, WIPO Case No. D2008-0505; *Marvel Manufacturing Company Inc. v. Koba Internet Sales, LP*, WIPO Case No. D2008-0265; *MySpace, Inc. v. Edwin De Jesus, EDJ Associates Inc.*, WIPO Case No. D2007-1878; *BlackRock, Inc. v. blackrockfinancialservices.com*, WIPO Case No. D2007-1627; *F. Hoffmann-La Roche AG v. Transliner Consultants*, WIPO Case No. D2007-1359; *National Football League v. Peter Blucher d/b/a BluTech Tickets*, WIPO Case No. D2007-1064; *Toilets.com, Inc. v. Rons Porta Johns*, WIPO Case No. D2007-0952; *Associated Bank Corp. v. Texas International Property Associates*, WIPO Case No. D2007-0334; *Gerber Childrenswear Inc. v. David Webb*, WIPO Case No. D2007-0317; *SPX Corporation v. Hevun Diversified Corporation*, NAF Claim No. 791657; *Google Inc. v. Jennifer Burns*, NAF Claim No. 726096; *The Cheesecake Factory Inc. and The Cheesecake Factory Assets Co., LLC v. Say Cheesecake*, WIPO Case No. D2005-0766; *Napster, Inc. v. Giovanni Vinscani*, WIPO Case No. D2005-0531; *Caesars Entertainment, Inc. v. Nova Internet Inc.*, WIPO Case No. D2005-0411; *Lockheed Martin Corporation v. The Skunkworx Custom Cycle*, WIPO Case No. D2004-0824; *Lockheed Martin Corporation v. Deborah Teramani*, WIPO Case No. D2004-0836; *National Collegiate Athletic Association v. Dusty Brown*, WIPO Case No. D2004-0491.

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's VALERO marks. Hence, the Complainant has satisfied its burden under paragraph 4(a)(i) of the Policy.

C. Rights or Legitimate Interests

Based on the evidence of record here, the Panel finds that no basis exists which would appear to legitimize a claim of rights or legitimate interests by the Respondent to the disputed domain name under paragraph 4(c) of the Policy.

The Complainant has never authorized the Respondent to utilize any of the VALERO marks nor does the Complainant apparently have any relationship or association whatsoever with the Respondent.

The record before the Panel is simply devoid of any evidence which proves that the Respondent actually acquired any recognition in the marketplace to become commonly known by the disputed domain name, a name similar to it, or more generally the term "valero". Given the exclusive trademark rights that reside in the Complainant and the reputation now inherent in its VALERO marks, the Respondent could not legitimately acquire any public association between itself and the VALERO marks or even any mark similar thereto, at least for the goods and services provided by the Complainant under its marks.

This is so in light of the Complainant's exclusive trademark rights which date back to February 7, 1983 and the reputation which those marks have since acquired – which predate, by at least two decades, the date, February 4, 2005, when the Respondent registered the disputed domain name. See, e.g., *Cummins, Staatliche Porzellan-Manufaktur Meissen GmbH, Forideas, National Westminster, Tommy Bahama, Space Needle, Oakley, Burberry, HRB Innovations and MySpace*, all cited *supra*; and *General Motors LLC v. Carol Schadt*, WIPO Case No. D2012-2106. As such, the Respondent could never likely become commonly known by the disputed domain name or the VALERO marks, for any of the goods and services which are either identical or sufficiently similar to those listed on the Complainant's trademark registrations, without infringing on the exclusive trademark rights of the Complainant. Hence, the Respondent does not fall within paragraph 4(c)(ii) of the Policy.

There can simply be no question that the Respondent was well aware of the Complainant, its VALERO marks and the Complainant's exclusive rights in those marks, and the reputation of those marks when the Respondent registered the disputed domain name. Yet, in spite of that knowledge, the Respondent

intentionally registered the disputed domain name containing the term “valero” and used that name as an address of its website which provided sponsored links to various third-party sites. Thus, the Respondent is using the disputed domain name and exploiting the reputation inherent in the Complainant’s VALERO marks without the Complainant’s permission, authority, or consent to receive click-through income. The Respondent’s actions of illicitly exploiting the reputation of a rights-holder’s mark, certainly in this fashion, is not a *bona fide* offer within the meaning of paragraph 4(c)(i) of the Policy.

Lastly, as the Respondent’s use of the disputed domain name is commercial in nature, this use does not constitute either a noncommercial or fair use under paragraph 4(c)(iii) of the Policy.

As such, based on the evidence presently before the Panel, the Respondent does not fall within any of paragraphs 4(c)(i)-(iii) of the Policy. Also, there is simply no evidence that the Respondent has acquired, through any other means, any rights or legitimate interests in the disputed domain name.

Accordingly, the Panel concludes that the Respondent has no rights or legitimate interests in the disputed domain name within paragraph 4(a)(ii) of the Policy.

D. Registered and Used in Bad Faith

The Panel finds that the Respondent’s actions, with respect to the disputed domain name, constitute bad faith registration and use.

It is indisputable that the Respondent was well aware of the Complainant, its reputation, its VALERO marks and the exclusive rights which the Complainant had in those marks when the Respondent registered the disputed domain name. Yet, in spite of that knowledge and in the absence of any authority to do so from the Complainant, the Respondent intentionally chose and registered the disputed domain name containing the term “valero” for its potential to cause confusion with those marks. Relying on that confusion, the Respondent used the disputed domain name to direct Internet users to its own website through which it provided lists of sponsored links to third-party websites and, as a result of which, commercially benefited by likely deriving click-through revenue therefrom.

Hence, the Panel concludes that the Respondent’s registration and use of the disputed domain name fall within the bad faith provision of paragraphs 4(a)(iii) and 4(b)(iv) of the Policy.

Thus, the Panel concludes that the Complainant has provided sufficient proof of its allegations, with respect to the disputed domain name, to establish a case under paragraph 4(a) of the Policy upon which the relief it now seeks can be granted.

7. Decision

Accordingly, under paragraphs 4(i) of the Policy and 15 of the Rules, the Panel grants the relief sought by the Complainant and orders the disputed domain name <valerorefinery.com> be transferred to the Complainant.

Peter L. Michaelson

Sole Panelist

Date: June 16, 2015