Decision for dispute CAC-UDRP-100252

Case number	CAC-UDRP-100252
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Domain names	alamoworks.com

Case administrator

Name	Tereza Bartošková (Case admin)

Complainant

Organization	Vanguard Trademark Holdings USA, LLC

Complainant representative

Organization	Harness, Dickey & Pierce, PLC

Respondent

Organization	DomainsbyProxy.com

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any decided or pending legal proceeding

IDENTIFICATION OF RIGHTS

Complainant is the holder of the domain name alamo.com, which is connected to its official website.

It is also of the following trademarks:

European Community trademark No. 1860592 registered on February 16th, 2002 for ALAMO in international classes 12, 16, 36 and 39;

United-States trademark No. 1,097,722 registered on July 25th, 1978 for ALAMO in International class 39;

United-States trademark No. 2,805,426 registered on January 13th, 2004 for ALAMO.COM in international class 35 and 39.

These rights are prior to the disputed domain name.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

FACTUAL AND LEGAL GROUNDS. ICANN Rule 3(b)(ix).

This is a Complaint filed on behalf of Vanguard Trademark Holdings USA LLC.

As of the date of Complainant's commencement of this proceeding, the domain name at issue, alamoworks.com, was registered by Domains by Proxy, Inc. Once notified of this complaint, the current record owner Domains by Proxy, Inc. instructed its Registrar to disclose another owner of the domain name at issue.

Regarding the issue of requiring a Complainant to prepare and file an amended complaint in a proceeding in which the record owner at the time of filing was a proxy/privacy service the Panel's decision in Vanguard Trademark Holdings USA LLC, v. WanZhongMedia c/o Wan Zhong , No. 100221 (Czech Arbitration Court, March 29, 2011) indicated as follows:

[I]t would be against the spirit and the essence of the system to oblige the Complainant to file a new Complaint or a amended Complaint each time the name of the Respondent is changed during the procedure because of the use of a proxy/privacy service provider…Therefore, the Panel takes the view that no amended Complaint is necessary. The initial Complaint has been regularly filed. From a procedural point of view, the change of the name of the Respondent after the notification of the Complaint shall be simply disregarded.

As a result, Complainant does not believe that it should be required to file an amended complaint once the Registrar "draws back the curtain" to reveal the supposed real owner of the domain name at issue

This Complaint is based on the following factual and legal grounds:

Vanguard Trademark Holdings USA LLC ("Complainant ") is the owner of the ALAMO mark which it licenses to Alamo Rent A Car.

Started in 1974, Alamo Rent A Car has locations in more than 42 countries worldwide, with more than 1,200 Alamo car rental locations throughout the United States, Canada, Europe, Latin America, the Caribbean, Asia Pacific, Africa and Australia. Long before the registration of the alamoworks.com domain name by its current owner and Registrar on 22 July 2010, Complainant's licensee has been engaged in the car rental business under the ALAMO mark.

Complainant's licensee, Alamo Rent A Car, operates an on-line car rental site at alamo.com. A copy of the alamo.com web page is attached as Annex 2.

Trademark/Service Mark Information: ICANN Rule 3(b)(viii).

Complainant has registered its ALAMO mark and owns the following European Community registration:

European Community Trademark Registration No. 1860592 dated 16 February 2002 for ALAMO in International Classes 12, 16, 36 and in International Class 39 for the following services: "provision of transport services including for both leisure and business purposes; hiring of transport vehicles including the provision of such services to the functioning of airports; loaning of vehicles; vehicle parking; hiring of vehicle accessories; inspection of vehicles before transport; travel for and escorting of travellers; provision of information about the transport of goods and information relating to tariffs, timetables and methods of transport; transport reservation and arranging services; vehicle rental, reservation and leasing services; relating online services; and related promotional and discount services; automobile rental and leasing services; car leasing services; vehicle rental, reservation and leasing services."

A print-out with details regarding this registration from the Office for Harmonization of Internal Markets ("OHIM") data base is attached as Annex 3.

In addition, Complainant has registered and owns the following United States registrations:

Registration No. 1,097,722 issued 25 July 1978
ALAMO in International Class 39 for “automotive renting and leasing services.”

Registration No. 2,805,426 issued 13 January 2004
ALAMO.COM in International Class 35 for “promoting the goods and services and of others through a membership benefit program which entitles members to receive discounts on renting and leasing vehicles” and in International Class 39 for “vehicle renting and reservation services; vehicle leasing services.”

Copies of print-outs from the records of the United States Patent and Trademark Office showing the current status of each of these registrations are attached collectively as Annex 4.

In addition to its registrations in the European Community and the United States, Complainant has registered the ALAMO mark for vehicle rental services in many other countries.

1. Confusing similarity. ICANN Rule 3(b)(ix)(i); ICANN Policy ¶4(a)(i).

The domain name alamoworks.com is confusingly similar to the registered ALAMO mark as used in connection with vehicle rental services. The alamoworks.com domain name contains Complainant's ALAMO mark in its entirety followed by the generic term “works.”

It is well established in prior decisions that the addition of a generic or descriptive term to a trademark is not a distinguishing feature, inter alia, Barry D. Sears, Ph.D. v. YY / Yi Yanlin, WIPO Case No. D2007-0286 (“diet” added to ZONE mark); Fry’s Electronics, Inc. v. Whois ID Theft Protection, WIPO Case No. D2006-1435 (“electronics” added to FRY mark); Wal-Mart Stores, Inc. v. Henry Chan, WIPO Case No. D2004-0056 (“chase”, “girlsof”, “jobsat”, “sams”, “application”, “blackfriday”, “blitz”, “books”, “career(s)”, “check”, “flw”, “foundation”, “games”, “mart”, “photostudio”, “pictures”, “portrait”, “portraitstudio(s)”, “registry”, “retaillink” and “wire” added to WALMART mark); PepsiCo, Inc. v. Henry Chan, WIPO Case No. D2004-0033 (“chart”, “miusic”, “arena”, “sweep”, “nfl” and “coliseum” added to PEPSI mark); International Organization for Standardization ISO v. Quality Practitioners Institute and Web site Pros, Inc. and Quality, WIPO Case No. D2005-1028 (“net” and “training” added to ISO mark); Banca Intesa S.p.A. v. Roshan Wickramaratna, WIPO Case No. D2006-0215 (“online” added to BANCAINTESA mark); Groupe Auchan v. Jakub Kamma WIPO Case n° D 2007-0565, (addition of the term “software to the trademark AUCHAN.

Respondent must also believe that “alamoworks.com” is confusingly similar to the ALAMO mark since the web page at alamoworks.com contains numerous links to the site of Complainant’s licensee and other sites offering vehicle rental services in competition with Complainant’s licensee.

2. Right to or Legitimate Interests. ICANN Rule 3(b)(ix)(2); ICANN Policy ¶4(a)(ii).

The Respondent has no rights or legitimate interests in the disputed domain name.

The disputed domain name alamoworks.com resolves to a web page which contains links to web pages offering vehicle rental services. For example, the alamoworks.com web page has links to "Alamo® Official Site," "Avis Printable Coupon” (Avis is one of Complainant’s licensee’s primary competitor), “Car Rental at AAA,” “Hilo Cheap Car Rental,” “Alamo bath car rental,” “Alamo car rental heathrow airport,” “Alamo car lincoln rental,” and “Alamo car new rental york” all of which are sites offering car rental services from Complainant’s licensee and various other vehicle rental providers. A copy of the web page at alamoworks.com is attached as Annex 6.

In light of the long-standing use and registration of the ALAMO mark in connection with vehicle rental services throughout the world, Respondent cannot have any legitimate rights in the domain name at issue when used in connection with a web site that offers links to providers of car rental services. The fact that Respondent’s web page for the alamoworks.com domain name at issue includes links to the web sites that offer vehicle rental services by both Complainant’s licensee and

others who are in direct competition with those offered by Alamo Rent A Car is clear evidence that Respondent was well aware of the existence of Complainant.

Respondent's use is neither a bona fide offering of goods or services pursuant to Policy ¶4(c)(i) nor a legitimate noncommercial or fair use pursuant to Policy ¶4(c)(iii). See Golden Bear Int'l, Inc. v. Kangdeock-ho, FA 190644 (Nat. Arb Forum Oct. 17, 2003)("Respondent's use of a domain name confusingly similar to Complainant's mark(s) to divert Internet users to websites unrelated to Complainant's business does not represent a bona fide offering of goods or services under Policy ¶4(c)(i) or a legitimate noncommercial or fair use under Policy ¶4(c)(iii)."); see also Disney Eners., Inc. v. Dot Stop, FA 145227 (Nat. Arb. Forum Mar. 17, 2003)(finding that the respondent's diversionary use of the complainant's mark(s) to attract Internet users to its own website, which contained a series of hyperlinks to unrelated websites, was neither a bona fide offering of goods or services nor a legitimate noncommercial or fair use of the disputed domain names).

Neither Complainant nor Complainant's licensee has licensed or otherwise permitted Respondent to use the ALAMO mark in connection with vehicle rental services or any other goods or services or to apply for any domain name incorporating the ALAMO mark. In addition, Respondent is clearly not making any legitimate noncommercial or fair use of "Alamo." In fact, any claim in that regard is easily dismissed since the web page used by Respondent is the type of web page commonly used by domain name owners seeking to "monetize" their domain names through Google's ads by Google program.

There is nothing in the WHOIS records or on Respondent's web page to indicate that Respondent is commonly known as "ALAMO WORKS." See Compagnie de Saint Gobain v. Com-Union Corp., D2000-0020 (WIPO Mar. 14, 2000) (finding no rights or legitimate interest where the respondent was not commonly known by the mark and never applied for a license or permission from the complainant to use the trademarked name); see also Charles Jourdan Holding AG v. AAIM, D2000-0403 (WIPO June 27, 2000) (finding no rights or legitimate interests where (1) the respondent is not a licensee of the complainant; (2) the complainant's prior rights in the domain name precede the respondent's registration; (3) the respondent is not commonly known by the domain name in question).

As indicated above, Complainant's licensee operates an on-line car rental web site at alamo.com. It is clear that Respondent has no legitimate rights in the domain name at issue and is attempting to divert Internet traffic to its website at the domain name alamoworks.com when Internet users type "alamoworks.com" or come across "alamoworks.com" via a web search engine such as Google, Yahoo! or Bing seeking the Alamo Rent A Car web page. Such a use constitutes a lack of rights or legitimate interest in the disputed domain names under ICANN Policy ¶¶ 4(c)(i) and (ii). See Big Dog Holdings, Inc. v. Day, FA93554 (Nat. Arb. Forum Mar. 9, 2000)(finding no legitimate use when respondent was diverting consumers to its own web site by using complainant's trademark(s)): see also MSNBC Cable, LLC v. Tysys.com, D2000-1204 (WIPO Dec. 8, 2000) (finding no rights or legitimate interest in the famous MSNBC mark where respondent attempted to profit using complainant's mark by redirecting Internet traffic to its own website).

Because of the commercial nature of Respondent's web site, it seems beyond question that the use of the domain name at issue is not a noncommercial or fair use under the Policy.

3. Registered and Used in Bad Faith. ICANN Rule 3(b)(ix)(3); ICANN Policy ¶4(a)(iii).

The facts of record suggest and support a finding that Respondent both registered and is using the alamoworks.com domain name at issue in bad faith. That Respondent registered a domain name confusingly to the ALAMO mark owned by the Complainant evidences a clear intent to trade upon the goodwill associated with Complainant's ALAMO mark for car rental services. Respondent is deliberately using a domain name that is confusingly similar to Complainant's mark to attract, for commercial gain, Internet users to its web site, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation or endorsement of its web site and the services offered at such web site. Respondent's bad faith is clearly evident from the fact that the links on the web page to which the alamoworks.com domain name at issue resolves provides links to car rental services, including those of Complainant, thereby continuing the charade by trying to trick people into believing they have reached the real ALAMO RENT A CAR web site.

A review of Respondent's web page at alamoworks.com makes it very clear that Respondent has set up its web site to which

the domain name at issue resolves with a view to commercial gain from “click-through” payments from the Ads by Google program. Although some visitors may realize that Respondent’s web page is not the “real” Alamo Rent A Car web page, there will inevitably be a number who do “click through”. The very essence of setting up the web site to which the alamoworks.com domain name at issue resolves must be that it does result in commercial gain from Internet users accessing the links through the alamoworks.com web site. Clearly Respondent does not operate a business known as “Alamo Works”, nor, to the best of Complainant’s knowledge, does it advertise under the “Alamo Works” name.

The business model based upon use of an infringing domain name to attract users to Respondent’s web site is clear evidence that Respondent registered and is using the domain name at issue in bad faith pursuant to Policy ¶ 4(b)(iv). See Kmart v. Kahn, FA 127708 (Nat. Arb. Forum Nov. 22, 2002)(finding that if a respondent profits from its diversionary use of a complainant’s mark when a domain name resolves to commercial websites and that respondent fails to contest a complaint, it may be concluded that the respondent is using the domain name in bad faith pursuant to Policy ¶ 4(b)(iv)); see also State Farm Mut. Auto. Ins. Co. v. Northway FA 95464 (Nat. Arb. Forum Oct. 11, 2000)(finding that a respondent registered the domain name <statefarmnews.com> in bad faith because that respondent intended to use a complainant’s marks to attract the public to the web site without permission from that complainant).

As a result, Respondent’s registration and use of the alamoworks.com domain name at issue falls squarely within the parameters of ICANN Policy ¶ 4(b)(iv). See G.D. Searle & Co. v. Celebrex Drugstore, FA 123933 (Nat. Arb. Forum Nov. 21, 2002)(finding that respondent registered and used the domain name in bad faith pursuant to ICANN Policy ¶ 4(b)(iv) because respondent was using the confusingly similar domain to attract Internet users to its commercial website). See also Mattel, Inc., v. .COM. Co., FA 12683 (Nat. Arb. Forum Dec. 2, 2002) citing Pavillion Agency, Inc. v. Greenhouse Agency Ltd., D2000-1221 (WIPO Dec. 4, 2000)(finding that the “domain names are so obviously connected with the complainant that the use or registration by anyone other than complainant suggests ‘opportunistic bad faith’”).

In summary, it cannot be disputed that the Complainant has long standing and well-recognized rights and goodwill in the ALAMO mark in connection with vehicle rental services. The alamoworks.com domain name is confusingly similar to Complainant’s ALAMO mark registered for vehicle rental services. Respondent has no legitimate rights in the domain name at issue. Respondent has merely registered the alamoworks.com domain name to capitalize on the goodwill that Complainant has developed in its ALAMO mark to drive Internet traffic inappropriately to Respondent’s web site for commercial gain.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the Domain Name is confusingly similar to a trademark or service mark in which the complainant has rights (within the meaning of paragraph 4(a)(i)of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown that Respondent has no right or legitimate interest in respect of the Domain Name (within the meaning of paragraph 4(a)(ii)of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown that the Domain Name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

PRINCIPAL REASONS FOR THE DECISION

The Panel finds that the disputed domain name alamoworks.com is confusingly similar to Complainant's trademark ALAMO.

The Panel also finds that Complainant is right to assert that Respondent has made no use of, or demonstrated preparations to use the disputed domain name in connection with a bona fide offering of goods or services, is not making a legitimate non-commercial or fair use of the disputed domain name, and is not commonly known under the disputed domain name. Indeed, a parking website containing links directing to Complainant's competitors and by which Respondent make commercial gains is not proof of legitimate interest.
In lack of any Response from Respondent, or any other information indicating the contrary, the Panel concludes that Respondent has no rights or legitimate interests in respect of the disputed domain name.

Lastly, Complainant has also proved that Respondent acted in bad faith in registering and using the domain name. Regarding the claim that the registration was made in bad faith, Complainant alleges that it has long standing and well recognized rights and goodwill in the trademark ALAMO. The Panel cannot take this argument into consideration since Complainant does not provide the Panel with any documents or evidence in support of this claim. Nevertheless, the famous nature of the trademark ALAMO has already been recognized by previous Panels (See for instance Alamo Rent-A-Car Management, LP v. Patrick Ory, WIPO Case No. D2003-0461). Therefore, the Panel considers that it is unlikely that Respondent could have ignored said trademark when the domain name was registered in July 2010. The domain name was in all likelyhood registered in bad faith, which has not been contested by Respondent.
The claim that the domain name was used in bad faith is supported by the facts and the evidence at hand. The domain name at issue resolved to a "pay per click" website containing links such as "Avis Printable Coupon" and providing Respondent with commercial gains. Furthermore Respondent has not demonstrated any right or interest to use the sign ALAMO. Accordingly, the use of the trademark ALAMO on Respondent's website is a clear indication that Respondent was acting in bad faith.
Therefore, the Panel deems that the domain name was registered in bad faith and is used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **ALAMOWORKS.COM**: Transferred

PANELLISTS

Name	**Nathalie Dreyfus**

DATE OF PANEL DECISION 2011-06-13

Publish the Decision