Decision for dispute CAC-UDRP-100639

Case number	CAC-UDRP-100639
Time of filing	2013-08-01 20:26:56
Domain names	alamocancuncarrental.com, cancuncarrentalalamo.com, cancuncarrentalnational.com, nationalcancuncarrental.com

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	Vanguard Trademark Holdings USA, LLC

Complainant representative

Organization	Harness, Dickey & Pierce, PLC

Respondent

Organization	Domains by Proxy, LLC

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which relate to the disputed domain names alamocancuncarrental.com, cancuncarrentalalamo.com, cancuncarrentalnational.com, and nationalcancuncarrental.com (the 'Domain Names').

IDENTIFICATION OF RIGHTS

Vanguard Trademark Holdings USA LLC (the 'Complainant'), is the owner of registered trade mark rights for car rental services in a number of territories across the world, including the trade marks ALAMO and NATIONAL in Mexico and the trade marks ALAMO, ALAMO.COM, NATIONAL and NATIONAL CAR RENTAL ('Car Rental' disclaimed) in the United States of America.

FACTUAL BACKGROUND

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

According to the WHOIS, the Domain Names are owned by Domains by Proxy, LLC.

Once notified of this complaint, the current record owner Domains by Proxy, LLC will instruct its Registrar to disclose the true owner of the domains name at issue. As a result of Czech Arbitration Court ADR case #100221, the Complainant does not

believe that is 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.

The Complainant is the owner of registered trade mark rights for car rental services in a number of territories across the world, including the trade marks ALAMO and NATIONAL in Mexico and the trade marks ALAMO, ALAMO.COM, NATIONAL and NATIONAL CAR RENTAL ('Car Rental' disclaimed) in the United States of America.

The Complainant is the owner of the ALAMO mark(s) which it licenses to Alamo Rent A Car and other operating entities. Started in 1974, Alamo Rent A Car is a value-oriented, internationally recognised brand serving the daily rental needs of the airport business traveller throughout the United States, Canada, Mexico, the Caribbean, Latin America, Asia and the Pacific Rim. Alamo also is the largest car rental provider to international travellers visiting North America. Complainant’s licensee operates on-line car rental sites at alamo.com and goalamo.com.

The Complainant is also the owner of the NATIONAL and NATIONAL CAR RENTAL marks that it licenses to National Car Rental and other operating entities. Started in 1948, National Car Rental is a premium, internationally recognised brand serving the daily car rental needs of the frequent airport business traveller throughout the United States, Canada, Mexico, the Caribbean, Europe, Latin America, Asia and the Pacific Rim.

1. Confusing similarity.

The Domain Names are confusingly similar to Complainant’s registered ALAMO and NATIONAL CAR RENTAL marks. The domain names alamocancuncarrental.com and cancuncarrentalalamo.com fully incorporate Complainant’s ALAMO mark, the generic term “car rental,” which describes the businesses that operate under Complainant’s marks, and the geographic term, “Cancun.” The domain names cancuncarrentalnational.com and nationalcancuncarrental.com both fully incorporate Complainant’s NATIONAL CAR RENTAL mark and merely split “National” and “Car Rental” and add the geographic term, “Cancun.”

The Complainant’s US registration for ALAMO for car rental services issued in 1978 and its registration for NATIONAL and NATIONAL CAR RENTAL for automobile rental services issued in 1989. These registrations pre-date the February 13, 2013 registration dates of the Domain Names.

2. Rights to or Legitimate Interests.

The Domain Names are inactive. The Respondent is not using the Domain Names in connection with a bona fide offering of goods or services, nor is there any indication that the Respondent is taking steps to use the Domain Names in connection with a bona fide offering of goods or services. There is nothing in the WHOIS database or otherwise to suggest that Respondent is or is generally known as any of the Domain Names. The Respondent has never been licensed, authorised, or permitted to use Complainant’s ALAMO, NATIONAL, or NATIONAL CAR RENTAL marks.

Any use the Respondent would make of any domain name incorporating Complainant’s ALAMO, NATIONAL, or NATIONAL CAR RENTAL marks would most likely violate the exclusive trade mark rights which the Complainant has long held in its marks.

Registered and used in Bad Faith.

As indicated, it appears that the Domain Names do not resolve to active web sites. It is well-settled that this type of passive holding of domain names can in certain circumstances be evidence of use in bad faith. Telstra Corporation Limited v. Nuclear Marshmallows (WIPO Case No. D2000-0003) February 18, 2000) cited.

There is very little known about the Respondent. The following can be inferred:
1. The Respondent registered the Domain Names in February 2013;
2. Since the Respondent registered the Domain Names, it is almost certain that the Respondent was aware that the

Complainant had an established international reputation in the trademarks ALAMO, NATIONAL and NATIONAL CAR RENTAL and had established an Internet presence for car rental services using those marks;
3. The Respondent intentionally chose to register domain names which are comprised of Complainant's NATIONAL CAR RENTAL mark combined with a geographic term in the case of nationalcarrentalcancun.com and cancuncarrentalnational.com and comprised of Complainant's ALAMO mark and both a term describing the business in which the ALAMO mark is used and a geographic term;
4. Any attempt to actively use any of the Domain Names would inevitably lead to a likelihood of confusion to the source, sponsorship, affiliation, or endorsement of the registrant's web site among users of the Internet who would inevitably be led to believe that such a www site would be owned by, controlled by, established by or in some way associated with the Complainant;
5. The Respondent has deliberately concealed its identity by using Domains by Proxy;
6. The Respondent has engaged in "passive holding" of these domain names;
7. There is no evidence whatsoever as to the business activities of the Respondent and the Complainant has made out a prima facie case that the Respondent does not have any rights or legitimate interest in said domain names;
8. While it might be possible for the Respondent to have innocently registered a domain name including either the ALAMO mark or the NATIONAL CAR RENTAL mark but not both ALAMO and NATIONAL CAR RENTAL; and
9. Taking into account all of the above, it is not possible to conceive of any plausible actual or contemplated active use of the Domain Names by the Respondent that would be illegitimate and any such use would involve passing off, or an infringement of the Complainant's rights under trade mark law.

In the circumstances outlined above, this passive holding of the domain names at issue constitutes a use of said domain names in bad faith by the Respondent.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

The Domain Names are confusingly similar to the Complainant's registered ALAMO and NATIONAL CAR RENTAL marks.

The Respondent does not have any rights or legitimate interest in the Domain Names as it:
- is not a holder of the trade marks ALAMO or NATIONAL CAR RENTAL;
- does not use the trade marks ALAMO or NATIONAL CAR RENTAL and the Domain Names in connection with any offering of its own goods or services;
- is not authorised in any way or a licensee of the Complainant; and
- has not attempted to make any bona fide use of the Domain Names.

The Domain Names have been registered and are being used in bad faith.

RIGHTS

On the basis of the arguments set out on behalf of the Complainant, it has to the satisfaction of the Panel shown the Domain Names to be confusingly similar to trademarks or service marks 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 the Respondent to have no rights or legitimate interests in respect of the Domain Names (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 Names have been registered and are being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

PROCEDURAL FACTORS

PROCEDURAL POINT

After the Proceedings were initiated the Proxy Shield was lifted and the registrant of the Domain Names revealed as "Ivan Quinones Buenrostro, RESERVACIONES ELECTRONICAS DE MEXICO SA DE CV".

The Panel sees no reason why this Complaint should not proceed simply due to the fact that the Proxy Shield service has been lifted during the proceedings, and the true registrant name revealed. The Panel agrees with the reasoning of the Panel in Czech Arbitration Court ADR case #100221 in this regard:

"The Panel considers that in the absence of any written guidance in the UDRP, it 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.

This is not a decision against privacy/proxy provider; it is a mere procedural issue: changing the name of the Respondent after the notification of the Complaint should have no detrimental consequence on the procedural principles of the system. Based on the facts of each case, such 'transfer' could well have far-reaching implications on the merits, but from a procedural point of view this is a mere administrative decision of the holder.

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."

The Panel is satisfied therefore 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

Paragraph 4(a)(i) of the Policy

The Panel finds the Domain Names confusingly similar to the ALAMO, ALAMO.COM, NATIONAL and NATIONALCAR RENTAL trade marks in which the Complainant has registered rights.

Paragraphs 4(a)(ii) and 4(a)(iii) of the Policy

The Respondent failed to file an administratively compliant (or any) response. In the circumstances the Panel finds from the facts put forward that:

The Respondent has no rights or legitimate interests in respect of the Domain Names. There was nothing put forward in the case file which might suggest otherwise.

The Domain Names have been registered and are being used in bad faith:
- The Panel believes from the facts that the Respondent had the Complainant and its ALAMO, ALAMO.COM, NATIONAL and NATIONAL CAR RENTAL trade marks in mind when registering the Domain Names. In particular the Complainant's trade marks ALAMO and NATIONAL are registered in numerous territories including Mexico (the home territory of the Respondent according to the 'revealed' WHOIS database).
- The Panel finds that the Domain Names have, since registration, been held (passively) by the Respondent - quite possibly with the end purpose of selling the Domain Names to the Complainant for a sum which is in excess of the Respondent's out of pocket expenses related to the Domain Names (paragraph 4(b)(i)of the Policy).

- The Panel finds that the Domain Names are likely to have been registered in order to prevent the Complainant from reflecting their trade marks in the form registered in the Domain Names, and given the fact there are 4 Domain Names in issue, there is clearly a pattern of such conduct (paragraph 4(b)(ii)of the Policy).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ALAMOCANCUNCARRENTAL.COM**: Transferred
2. **CANCUNCARRENTALALAMO.COM**: Transferred
3. **CANCUNCARRENTALNATIONAL.COM**: Transferred
4. **NATIONALCANCUNCARRENTAL.COM**: Transferred

PANELLISTS

Name	**Steve Palmer**

DATE OF PANEL DECISION 2013-09-17

Publish the Decision