Decision for dispute CAC-UDRP-100677

Case number	CAC-UDRP-100677
Time of filing	2013-10-11 16:33:04
Domain names	national-car-hire.net

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	Vanguard Trademark Holdings USA LLC

Complainant representative

Organization	Harness, Dickey & Pierce, PLC

Respondent

Name	Gregg Housh

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other pending or decided legal proceedings which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant, Vanguard Trademark Holdings USA LLC is the record owner of the following registrations for the relevant marks in the United States:

Reg. No. 1,537,711 issued May 2, 1989
NATIONAL in International Class 39 for “automobile rental services”

Reg. No. 1,540,913 issued May 23, 1989
NATIONAL CAR RENTAL (“car rental” disclaimed) in International Class 39 for “automobile rental services”

In addition to its registrations in the United States, the Complainant has registered the NATIONAL and NATIONAL CAR RENTAL marks for vehicle rental services in many foreign countries. The Complainant is the record owner of the following registration for the relevant mark in the United Kingdom:

Reg. No. 00002017578 issued March 1, 1996

NATIONAL & Design in International Class 39 for “automobile rental and reservation services”

The Complainant is the record owner of the following registrations for the relevant marks in Europe, as issued by the Office for Harmonization for the Internal Market (OHIM):

Reg. No. 000190413 issued April 2, 1996
NATIONAL in International Class 39 for “automobile rental and reservation services”

Reg. No. 000190439 issued April 3, 1996
NATIONAL CAR RENTAL in International Class 39 for “automobile rental and reservation services”

FACTUAL BACKGROUND

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

Vanguard Trademark Holdings USA LLC v.
Domainmonster.com Privacy Service c/o Identity Protect Limited

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, national-car-hire.net, is owned of record by Domainmonster.com Privacy Service. A copy of the WHOIS record for the national-car-hire.net domain name from the records of the Registrar (as of the date of commencement of this proceeding) is attached as Exhibit 1. Subsequent to the filing of thie complaint in this matter, the Registrar advised that the real owner is "Gregg Housh".

Although not required to do so as per the Panel’s decision in Vanguard Trademark Holdings USA LLC, v. WanZhongMedia c/o Wan Zhong, No. 100221 (Czech Arbitration Court, March 29, 2011), Complainant has amended the complaint to reflect "Gregg Housh" as the Respondent.

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

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

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NATIONAL CAR RENTAL in International Class 39 for “automobile rental and reservation services”

The NATIONAL and NATIONAL CAR RENTAL marks will be referred to collectively as “the NATIONAL marks.”

The Complaint licenses the NATIONAL marks to various National Car Rental operating companies. Started in 1948, National Car Rental is a premium, internationally recognized brand serving the daily car rental needs of the frequent airport business traveler throughout the United States, Canada, Mexico, the Caribbean, Europe, Latin America, Asia and the Pacific Rim. Complainant’s licensee operates an on-line car hire site for its UK customers at nationalcar.co.uk. The nationalcarhire.co.uk URL also “resolves” to the National Car Rental UK home page. On that site customers can “Book Your Car Hire”, get a “Car Hire Quote” and get a “Van Hire Quote.”

Complainant’s licensee also operates a similar on-line car hire site at nationalcar.com. The nationalcarhire.com URL also “resolves” to the National Car Rental US home page.

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

The domain name, national-car-hire.net, is confusingly similar to the Complainant’s registered NATIONAL marks. The domain name at issue fully incorporates the Complainant’s NATIONAL mark, replaces spaces with hyphens, adds a generic term that describes Complainant’s goods and services - “car hire,” and adds the generic top level domain “.net.”
The domain name, national-car-hire.net, takes the Complainant’s registered NATIONAL CAR RENTAL mark and merely substitutes “hire” for “rental”, replaces spaces with hyphens and adds the generic top level domain “.net”.

It has been stated by several UDRP panels that the incorporation of a trademark in its entirety into a domain name is sufficient to establish that the domain name is identical or confusingly similar to a registered trademark. See Hürriyet Gazetecilik ve Matbaacılık Anonim Şirketi v. Moniker Privacy Services / Kemal Demircioglu, D2010-1941 (WIPO Jan. 28, 2011))(the domain names hürriyet.com, hürriyetemlak.com, and hürriyetoto.com are confusingly similar to the HURRIYET mark) and Bayerische Motoren Werke AG, Sauber Motorsport AG v. Petaluma Auto Works, D2005-0941 (WIPO Oct. 20, 2005) (bmwsauberf1.com is confusingly similar to BMW). This is particularly true when the domain name combines a mark with a term that describes the Complainant’s business.

The term “car hire” is a generic term that is descriptive of the services for which the Complainant has registered its NATIONAL marks and that is synonymous with the term “car rental.” It is well established that combining a mark with terms that describe Complainant’s business is an inadequate change to prevent confusing similarity. See Vanguard Trademark Holdings USA LLC v. Purple Bucquet / Purple, FA1340439 (Nat. Arb. Forum October 10, 2010) (nationalcarhire.com is confusingly similar to the NATIONAL CAR RENTAL mark) and Vanguard Trademark Holdings USA LLC v. Muhammad Faisal Shah, FA1372555 (Nat. Arb. Forum January 13, 2011) (enterprisecarhire.net and enterprisecarhire.org are confusingly similar to the ENTERPRISE RENT-A-CAR mark). See also Chanel, Inc. v. Cologne Zone, D2000-1809 (WIPO Feb. 22, 2001) (“CHANEL, the salient feature of the Domain Names, is identical to a mark in which Complainant has shown prior rights. The addition of the generic term, “perfumes” is not a distinguishing feature, and in this case seems to increase the likelihood of confusion because it is an apt term for Complainant’s business.”) and Gillette Co. v. RFK Assocs., FA 492867 (Nat. Arb. Forum July 28, 2005) (finding that the additions of the term “batteries,” which described the complainant’s products, and the generic top-level domain “.com” were insufficient to distinguish the respondent’s <duracellbatteries.com> from the complainant’s DURACELL mark).

Previous panels have determined that the removal of spaces coupled with the addition of hyphens and a gTLD are not sufficient to distinguish the domain name at issue from a Complainant’s mark. See Vanguard Trademark Holdings USA LLC v. Private Whois Service c/o national-car-rental.com, FA 1337422 (Nat. Arb. Forum August 30, 2010) (national-car-rental.com

is confusingly similar to NATIONAL CAR RENTAL mark). See also George Weston Bakeries Inc. v. McBroom, FA 933276 (Nat. Arb. Forum Apr. 25, 2007) (finding that eliminating the space between terms of a mark still rendered the <gwbakeries.mobi> domain name identical to the complainant's GW BAKERIES mark); Pirelli & C. S.p.A. v. Tabriz, FA 921798 (Apr. 12, 2007) (finding that the addition of a hyphen between terms of a registered mark did not differentiate the <p-zero.org> domain name from the P ZERO mark under Policy par. 4(a)(i)); and Reese v. Morgan, FA 917029 (Nat. Arb. Forum Apr. 5, 2007) (finding that the mere addition of the generic top-level domain ".com" is insufficient to differentiate a domain name at issue from a mark).

The addition of a generic top level domain identifier is also insufficient to distinguish the national-car-hire.net domain name from Complainant's NATIONAL marks. See Jerry Damson, Inc. v. Tex. Int'l Prop. Assocs., FA 916991 (Nat. Arb. Forum Apr. 10, 2007) ("The mere addition of a generic top-level domain ("gTLD") ".com" does not serve to adequately distinguish the Domain Name from the mark."); see also Katadyn N. Am. v. Black Mountain Stores, FA 520677 (Nat. Arb. Forum Sept. 7, 2005) ("[T]he addition of the generic top-level domain (gTLD) ".net" is irrelevant for purposes of determining whether a domain name is identical to a mark.").

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

The Respondent has no rights or legitimate interests in the national-car-hire.net domain name. The national-car-hire.net domain name resolves to a web page that contains links to car rental websites. These links include the websites of the Complainant and its competitors. On September 18, 2013 the national-car-hire.net website contained at least the following links:

Enterprise
National
Avis
Budget
and Alamo

In light of the long-standing use and registration of the NATIONAL marks in connection with car rental and car hire services in the United States, United Kingdom, and Europe, the Respondent cannot have any legitimate rights in the national-car-hire.net domain name in connection with a site that merely drives Internet traffic to other websites.

Respondent's use is neither a bona fide offering of goods or services pursuant to Policy par. 4(c)(i) nor a legitimate noncommercial or fair use pursuant to Policy par. 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 par. 4(c)(i) or a legitimate noncommercial or fair use under Policy par. 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).

As previously indicated the Complainant's licensee operates an on-line car hire web site at nationalcar.co.uk and nationalcarhire.co.uk. It is clear that the Respondent has no legitimate rights in the domain name at issue and is attempting to divert Internet traffic to its national-car-hire.net domain name when Internet users are trying to reach the National Rent A Car web site. Such a use constitutes a lack of rights or legitimate interest in the disputed domain names under ICANN Policy paragraphs 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).

Based on the facts shown above, the Complainant has made a prima facie case that the Respondent lacks a legitimate interest or right in the national-car-hire.net domain name. Once the Complainant had made a prima facie case that the

Respondent lacks a legitimate interest or right, the burden shifts to the Respondent to prove its right or legitimate interest in the domain name. F. Hoffman-LaRoche AG v. Steven Pratt, D2010-0047 (WIPO March 8, 2010); Canadian Tire Corporation Limited v. Swallowlane Holdings Ltd., D2009-0828 (WIPO Aug. 10, 2009).

3. Registered and used in Bad Faith. ICANN Rule 3(b)(ix)(3); ICANN Policy par. 4(c)(iii).

The facts of record suggest and support a finding that the Respondent both registered and is using the national-car-hire.net domain name in bad faith. The Respondent's registration of a domain name that is confusingly similar to both the NATIONAL and the NATIONAL CAR RENTAL marks for a web site that attempts to attract Internet users to the Respondent's web site, evidences a clear intent to trade upon the goodwill associated with the Complainant's NATIONAL marks for car rental and car hire services. The Respondent is deliberately using a domain name that is confusingly similar to the Complainant's marks to attract, for commercial gain, Internet users to its web site, by creating a likelihood of confusion with the Complainant's marks as to the source, sponsorship, affiliation or endorsement of its web sites and the services offered at such web sites.

The web page to which the national-car-hire.net domain name resolves appears to be a hybrid combining a "pay-per-click" web page with a "content farm" web page. The "pay-per-click" portion of the web page at national-car-hire.net contains on-line advertising that will provide the Respondent with revenue from "click-through" fees from Internet users. Some Internet visitors to the Respondent's web page at national-car-hire.net will either not realize that they have been unwittingly directed to a web site that has no affiliation to National Car Rental or not care that they are not at the "official" National Car Rental web site and will "click through" to the National Car Rental website or the websites of its competitors via links on the Respondent's website.

The "content farm" portion of the web pages at national-car-hire.net consists of user-generated content that focuses on keyword density more than the quality of the writing. This keyword density is designed to satisfy algorithms for maximal retrieval by automated search engines. Their main goal is to generate advertising revenue through attracting reader page views.

No matter how it is viewed, the very essence of setting up the national-car-hire.net website must be that it does result in commercial gain to the Respondent as owner of the national-car-hire.net domain name.

The business model based upon use of an infringing domain name to attract users to the Respondent's web site is clear evidence that the Respondent registered and is using the national-car-hire.net domain name in bad faith pursuant to Policy par. 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 par. 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).

In addition, Respondent's bad faith is clearly evident from the fact that the home page for the domain name national-car-hire.net includes a link to the real National Car Rental web site and for which National Car Rental must pay a click-through fee if that link is used.

As a result, Respondent's registration and use of the domain name at issue falls squarely within the parameters of ICANN Policy par. 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 par. 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'").

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the Domain Name is identical or 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 the Respondent to have no rights or legitimate interests in respect of the Domain Name (within the meaning of paragraph 4(a)(ii)of the Policy). There is nothing in the WHOIS records or use of the national-car-hire.net domain that provides any indication that the Respondent is or is generally known as “National-Car-Hire”. The Complainant has not licensed or otherwise permitted the Respondent to use its NATIONAL marks in connection with car rental services or any other goods or services or to apply for any domain name incorporating the NATIONAL marks.

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the Domain Name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy). The Respondent has only registered the national-car-hire.net domain name to capitalize on the goodwill that Complainant has developed in its marks to drive Internet traffic inappropriately to another website for commercial gain.

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

The Complainant has well recognized rights in its NATIONAL and NATIONAL CAR RENTAL marks in connection with car hire services. The national-car-hire.net domain name is confusingly similar to both the NATIONAL and NATIONAL CAR RENTAL marks for car hire services. Respondent has no legitimate rights in the national-car-hire.net domain name. The Respondent has merely registered the national-car-hire.net domain name to capitalize on the goodwill that the Complainant has developed in its NATIONAL and NATIONAL CAR RENTAL marks to drive Internet traffic inappropriately to another website for commercial gain.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **NATIONAL-CAR-HIRE.NET**: Transferred

PANELLISTS

Name	**Thomas Hoeren**

DATE OF PANEL DECISION 2013-11-08

Publish the Decision