Decision for dispute CAC-UDRP-100783

Case number	CAC-UDRP-100783
Time of filing	2014-04-11 11:01:40
Domain names	nationalcarhouston.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 are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

Vanguard Trademark Holdings USA LLC, (the "Complainant") is the owner of the NATIONAL CAR, NATIONAL and NATIONAL CAR RENTAL marks (“NATIONAL marks”).

The Complainant is owner of the following registration for the NATIONAL CAR mark in the Benelux countries:

Reg. No. 781489 effective 02 December 2005 for NATIONAL CAR in International Classes 12, 36 and 39.

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

Reg. No. 1,537,711 issued 02 May 1989 for NATIONAL in International Class 39

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

FACTUAL BACKGROUND

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

FACTUAL AND LEGAL GROUNDS. Paragraph 3(b)(ix) of the Rules.

At the date the Complainant commenced this proceeding, Domains by Proxy, LLC, a domain privacy service was the registrant of the disputed domain name, nationalcarhouston.com. Once notified of this complaint, the current record owner Domains by Proxy, LLC will instruct its Registrar to disclose another owner of the domain name at issue.

In the Panel's decision in Vanguard Trademark Holdings USA LLC, v. WanZhongMedia c/o Wan Zhong, No. 100221 (Czech Arbitration Court, March 29, 2011) it was stated:

[I]t would be against the spirit and the essence of the system to oblige the Complainant to file a new Complaint or an 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, the Complainant asserts it should not be required to file an amended complaint once the Registrar "draws back the curtain" to reveal the real owner of the domain name at issue.

The Complainant is the owner of the NATIONAL CAR, NATIONAL and NATIONAL CAR RENTAL marks ("NATIONAL marks") which it licenses to National Car Rental operating companies.

The Complainant's registrations for its NATIONAL marks were all registered long prior to the January, 2014 initial registration of the disputed domain name, nationalcarhouston.com.

Started in 1948, NATIONAL CAR RENTAL is an internationally recognized brand serving the daily rental needs of the frequent airport business traveler throughout the United States, Canada, Mexico, the Caribbean, Latin America, Asia, and the Pacific Rim. The Complainant's licensee operates an online car rental site at nationalcar.com and the domain name nationalcar.be resolves to that online car rental site.

A. Confusing similarity. Paragraph 3(b)(ix)(i) of the Rules; paragraph 4(a)(i) of the Policy.

The Complainant asserts that:

1. Its registrations and extensive use of the NATIONAL marks for car rental services sufficiently establishes its right in the marks pursuant to ICANN's Uniform Dispute Resolution Policy ("Policy").

2. The domain name nationalcarhouston.com is confusingly similar to the Complainant's registered NATIONAL CAR mark. The nationalcarhouston.com domain name fully incorporates the Complainant's NATIONAL CAR mark and only adds the geographic term "Houston," and the .com generic top level domain identifier.

3. The domain name nationalcarhouston.com is confusingly similar to the NATIONAL mark in that it merely adds a descriptive term for the Complainant's business, "car" the geographic term "Houston," and the generic top level domain identifier, ".com." The nationalcarhouston.com domain name is also confusingly similar to the NATIONAL CAR RENTAL mark except for the deletion of the term "rental" and the addition of the generic top level domain identifier, ".com."

4. 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.

5. It is also well established that combining a mark with terms that describe the Complainant's business is an inadequate change to prevent confusing similarity.

6. In addition to the confusingly similar use of the Complainant's marks the Respondent has also added the geographic term "Houston". The Complainant's licensee operates at least six NATIONAL CAR RENTAL locations in the Houston area of the United States. The addition of a geographical identifier fails to distinguish the domain name from the mark pursuant to Policy.

7. The addition of a generic top level domain identifier is also insufficient to distinguish the nationalcarhouston.com domain name from the Complainant's NATIONAL marks.

B. Rights to or Legitimate Interests. Paragraph 3(b)(ix)(2) of the Rules; Paragraph 4(a)(ii) of the Policy.

The Complainant asserts that:

1. The Respondent has no rights or legitimate interests in the nationalcarhouston.com domain name.

2. On 04 February 2014 the nationalcarhouston.com domain name resolved to a parking page with a list of "Sponsored Listings" consisting of links unrelated to Complainant. This list of "Sponsored Listings" included:

T-Mobile® for Business
$3,000 Personal Loan
New Nissans From $9,990
Buy Car Here w/ No Credit
$19 Car Insurance – New
Find Used Cars for Sale
Bad Credit Auto Loans
Used Cars For Sale
Michelin® Official Site
2013 – Toyota Overstock

On March 27, 2014, the nationalcarhouston.com domain name resolved to a web site with the heading "Future home of something quite cool".

3. The Respondent's use of the nationalcarhouston.com domain name is neither a bona fide offering of goods or services pursuant to paragraph 4(c)(i) of the Policy nor a legitimate noncommercial or fair use pursuant to paragraph 4(c)(iii) of the Policy.

4. The WHOIS record lists "Domains by Proxy, LLC" as the registrant for the nationalcarhouston.com domain name. The web site to which the nationalcarhouston.com domain name resolves gives no indication that the Respondent is known as, operating a business as, or advertising as "National Car Houston".

5. These facts suggest that the Respondent is not known as or operating as "National Car Houston", but instead is attempting to use the goodwill generated by the NATIONAL marks to drive Internet traffic to its web site through use of a confusingly similar domain name. Again, this use fails to establish a paragraph 4(c)(i) of the Policy bona fide offering, or paragraph 4(c)(i) of the Policy legitimate noncommercial or fair use.

6. The Complainant has not licensed or otherwise permitted the Respondent to use its NATIONAL marks in connection with any goods or services or to apply for any domain name incorporating the NATIONAL marks. In addition, the Respondent is clearly not making any legitimate noncommercial or fair use of nationalcarhouston.com. In fact, any claim in that regard is easily dismissed since at least sporadically, the nationalcarhouston.com home page was a generic type of web page commonly used by domain name owners seeking to monetize their domain names through "click-through" fees.

7. The Complainant's licensee operates an online car rental web site at nationalcar.com. It is clear that the Respondent has

no legitimate rights in the nationalcarhouston.com domain name and, by the use of a confusingly similar domain name, has sought to use the nationalcarhouston.com domain name to drive Internet traffic to its nationalcarhouston.com web site when Internet users are trying to reach the National Car Rental web site. Such use constitutes a lack of rights or legitimate interest in the disputed domain name under paragraphs 4(c)(i) and (ii) of the Policy.

8. Once the Complainant makes a prima facie case that the Respondent lacks rights and legitimate interests in the nationalcarhouston.com domain name under paragraph 4(a)(ii) of the Policy, the burden shifts to the Respondent to show it does have rights or legitimate interests. See Hanna-Barbera Prods., Inc. v. Entm't Commentaries, FA 741828 (Nat. Arb. Forum Aug. 18, 2006) (holding that the complainant must first make a prima facie case that the respondent lacks rights and legitimate interests in the disputed domain name under UDRP 4(a)(ii) before the burden shifts to the respondent to show that it does have rights or legitimate interests in a domain name); see also AOL LLC v. Gerberg, FA 780200 (Nat. Arb. Forum Sept. 25, 2006) ("Complainant must first make a prima facie showing that Respondent does not have rights or legitimate interest in the subject domain names, which burden is light. If Complainant satisfies its burden, then the burden shifts to Respondent to show that it does have rights or legitimate interests in the subject domain names.").

C. Registered and used in Bad Faith. Paragraph 3(b)(ix)(3) of the Rules; paragraph 4(c)(iii) of the Policy.

The Complainant asserts that:

1. The facts of record suggest and support a finding that the Respondent both registered and is using the nationalcarhouston.com domain name in bad faith. The Respondent's registration of a domain name that contains a geographic location where the Complainant's National Car Rental licensee operates combined with (1) the Complainant's NATIONAL CAR mark, (2) the Complainant's NATIONAL mark plus a term descriptive of the Complainant's business and (3) the Complainant's NATIONAL CAR RENTAL mark minus the word "rental" from for a web site that at least sporadically has attempted to attract Internet users to the Respondent's web page, evidences a clear intent to trade upon the goodwill associated with the Complainant's NATIONAL marks.

2. The Respondent has deliberately used 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.

3. While the nationalcarhouston.com domain name may currently resolve to a web page announcing that it is the "Future home of something quite cool" there is nothing to prevent the Respondent from again using the nationalcarhouston.com domain name for a site with links to web sites unrelated to the Complainant's licensees. Nor is the fact that nationalcarhouston.com is currently inactive change the fact that it was registered and used in bad faith. As has been stated in several UDRP decisions, inactivity or passive holding can in specific cases be regarded as "use" in bad faith within the meaning of paragraph 4(a)(iii) of the Policy. The fact that the domain name was at some stage used actively to direct to a website unrelated to Complainant's licensees can be regarded as further evidence of use in bad faith under paragraph 4(b)(iv) of the Policy.

4. 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 nationalcarhouston.com domain name in bad faith pursuant to paragraph 4(b)(iv) of the Policy.

5. In light of the Complainant's long established rights in its NATIONAL CAR, NATIONAL and NATIONAL CAR RENTAL marks, it is almost impossible to perceive a legitimate use that the Respondent might make of nationalcarhouston.com.

6. From the above it is clear that the Respondent's registration and use of the nationalcarhouston.com domain name falls squarely within the parameters of paragraph 4(b)(iv) of the Policy.

7. In summary, the Complainant has long standing and well-recognized rights and goodwill in its NATIONAL CAR, NATIONAL

and NATIONAL CAR RENTAL marks. The nationalcarhouston.com domain name is confusingly similar to the Complainant's NATIONAL CAR, NATIONAL and NATIONAL CAR RENTAL marks. The Respondent has no legitimate rights in the nationalcarhouston.com domain name. The Respondent has registered and used the nationalcarhouston.com domain name to capitalize on the goodwill that the Complainant has developed in its NATIONAL CAR, NATIONAL and NATIONAL CAR RENTAL marks to drive Internet traffic inappropriately to other web sites 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 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).

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).

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.

The registrar of the disputed domain name has disclosed that that the registrant of the disputed domain name was changed from Domains By Proxy. The WHOIS information for the disputed domain name now states:

Registrant Name: ali ekhlassi
Registrant Organization: National Car LLC.

Based on the decision No 100221 Vanguard Trademark Holdings USA LLC, v. WanZhongMedia c/o Wan Zhong, No. 100221, the Panel finds that the change of name of the registrant after notification of the Complaint will be disregarded.

PRINCIPAL REASONS FOR THE DECISION

1. Identical or confusingly similar

The Complainant is the owner of rights in the trade marks NATIONAL, NATIONAL CAR and NATIONAL CAR RENTAL. These registrations predate the registration of the disputed domain name, nationalcarhouston.com, on 25 January 2014.

It has been held in numerous Panel decisions that the generic top level suffix '.com' can be disregarded when considering if the disputed domain name is confusingly similar to the trade mark in which the complainant has rights.

The disputed domain name, nationalcarhouston.com, incorporates the Complainant's trade mark NATIONAL CAR and adds

to it the geographic term 'Houston'. The addition of the geographic identifier 'Houston' fails to prevent the domain name being confusingly similar to the Complainant's mark NATIONAL CAR.

Further, the disputed domain name nationalcarhouston.com incorporates the Complainant's mark NATIONAL and adds to it the descriptive words 'car' and the geographic term 'Houston'. The addition of a descriptive term 'car', and geographic identifier 'Houston', both of which are associated with the Complainant's business do nothing to reduce the association with the name NATIONAL or prevent the disputed domain name being confusingly similar to the Complaint's trade mark, NATIONAL.

The Panel finds that the disputed domain name is confusingly similar to the Complainant's trade marks NATIONAL and NATIONAL CAR.

2. Rights to or Legitimate Interests.

The Complainant has long standing rights in the marks NATIONAL, NATIONAL CAR and NATIONAL CAR RENTAL. The Complainant has not licenced or otherwise permitted the Respondent to use the Complainant's marks in the disputed domain name.

The nationalcarhouston.com domain name initially resolved to a parking page with a list of sponsored listings consisting of links unrelated to the Complainant and subsequently changed to a page with the title 'Future of something quite cool' . The Respondent's use of the disputed domain name, nationalcarhouston.com, does not appear to be a bona fide offering of goods or services.

There is no evidence that the Respondent is known as or is operating a business as 'National Car Houston'. There appears no reason why the Respondent would use the Complainant's marks other than to attempt to create an impression of association with the Complainant and drive Internet traffic to its web site through use of a confusingly similar domain name.

On the basis of evidence submitted and in the absence of a Response the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

3. Registered and used in bad faith

The Complainant has long standing rights its marks NATIONAL CAR, NATIONAL and NATIONAL CAR RENTAL which predate the registration of the disputed domain name.

It appears that the disputed domain name has been used for commercial gain the though sponsored listings on the website using the disputed domain name. There appears to be no reason why the Respondent would register the disputed domain name that incorporates the Complainant's trade marks, plus a geographic location where Complainant’s National Car Rental licensee operates, other than to trade off the goodwill in the Complainant's marks NATIONAL CAR, NATIONAL and NATIONAL CAR RENTAL.

On the basis of the evidence submitted by the Complainant and the absence of a Response the Panel finds that the disputed domain name has been registered and 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. **NATIONALCARHOUSTON.COM**: Transferred

PANELLISTS

Name	Mrs Veronica Bailey

DATE OF PANEL DECISION 2014-05-20

Publish the Decision