Decision for dispute CAC-UDRP-100946

Case number	CAC-UDRP-100946
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Domain names	myemeraldclubsite.com

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	Vanguard Trademark Holdings USA LLC

Complainant representative

Organization	Harness, Dickey & Pierce, PLC

Respondent

Organization	Privacy Protection Service INC d/b/a PrivacyProtect.org

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any pending or decided proceeding related to the disputed domain name.

IDENTIFICATION OF RIGHTS

Complainant, Vanguard Trademark Holdings USA LLC, has proved to be the owner of the following registered trademarks:

CTM Registration No. 000190603 issued on September 10, 1998
EMERALD CLUB in Class 39 for “Automobile rental and reservation services in international class 39.”

US Registration No. 1,482,719 issued March 29, 1988
EMERALD CLUB in International Class 39 for “automobile rental services”.

The disputed domain is ‘myemeraldclubsite.com’, registered on December 29, 2014.

Complainant’s trademark registrations long predate Respondent’s registration of 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).

The Complainant, Vanguard Trademark Holdings USA, LLC, is the owner of the EMERALD CLUB mark which it licenses to the National Car Rental operating companies. Started in 1948, NATIONAL is a premium, 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. EMERALD CLUB is the name of National Car Rental's loyalty club that offers enhanced vehicle rental services to EMERALD CLUB members. The EMERALD CLUB web page offers online car rentals to EMERALD CLUB members.

The disputed domain is 'myemeraldclubsite.com', registered on December 29, 2014.

Complainant's trademark registrations long predate Respondent's registration of the disputed domain name.

Complainant holds and operates also the domain name emeraldclub.com.

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

COMPLAINANT'S CONTENTIONS:

1. Confusing similarity.

According to the Complainant its registration and extensive use of the EMERALD CLUB mark for automobile rental services sufficiently establishes its right in the mark pursuant to paragraph 4(a)(i) of the Policy.

The domain name at issue, myemeraldclubsite.com, fully incorporates Complainant's EMERALD CLUB mark, merely adding the generic terms "my" and "site", removing the spaces from EMERALD CLUB, and adding the generic top-level domain ".com."

The Complainant claims (and provide a list of relevant case law in that regard)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.
The addition of generic terms does not distinguish the myemeraldclubsite.com domain name from Complainant's EMERALD CLUB mark
Specifically, the addition of the terms "my" and "site" does not prevent the confusing similarity between myemeraldclubsite.com and Complainant's EMERALD CLUB mark.
Complainant's CTM registration for EMERALD CLUB issued in 1998 and its registration in the United States issued in 1998, pre-date the December 2014 registration date of the myemeraldclubsite.com domain name by more than 16 and 28 years respectively.

2. Rights to or Legitimate Interests.

The Complainant contends the Respondent has no rights or legitimate interests in the myemeraldclubsite.com domain name. Furthermore, the Complainant provides evidence that on February 12, 2015 and on March 8, 2015, the web site at the myemeraldclubsite.com resolved to a web page with a list of "Related Links" which consisted of links to web sites offering car rental services.

An example of the "Related Links" included the following:

National Rent a Car
National Emerald Club
Compare Car Hire Nice
Rental Car Hire

Car Rental Car Rental
Alamo Car Rental Claims
Car Hire Gran Canaria
Best Car Rental Site
Rental Car for Cheap
National

On both dates the myemeraldclubsite.com web site also contained at the top, “Click here to buy MyEmeraldClubSite.com for your website name!” and a link to a web page where a user could receive a price quote for purchasing the myemeraldclubsite.com domain name.

In light of the long-standing use and registration of the EMERALD CLUB mark by the Complainant in connection with car rental services, the Respondent cannot have any legitimate rights in the myemeraldclubsite.com domain name in connection with a site that serves only to drive Internet traffic to web sites offering car rental services, as well as containing a general offer to sell the domain name.

According to the Complainant Respondent’s use is neither a bona fide offering of goods or services pursuant to paragraph 4(c)(i) of the Policy nor a legitimate non-commercial or fair use pursuant to paragraph 4(c)(iii) of the Policy.
Furthermore, the Complainant emphasizes that the WHOIS record lists “Privacy Protection Service INC d/b/a PrivacyProtect.org” as the registrant for the myemeraldclubsite.com domain name at the time of commencement of the administrative proceeding. The web site to which the myemeraldclubsite.com domain name resolves gives no indication that the Respondent is known as, operating a business as, or advertising as “My Emerald Club Site.” Previous panels have found that, in the absence of evidence submitted by the respondent, the WHOIS record is the sole piece of relevant evidence when determining what a respondent is commonly known as there is nothing in the WHOIS record that would indicate the Respondent is or is commonly known as “My Emerald Club Site.”
The Complainant contends that the aforementioned facts support the conclusion that the Respondent is not known as or operating as “My Emerald Club Site,” but instead is attempting to use the goodwill generated by the EMERALD CLUB mark to drive Internet traffic to its web site through use of a confusingly similar domain name.

The Complainant claims it has not licensed or otherwise permitted the Respondent to use its EMERALD CLUB mark in connection with car rental services or any other goods or services or to apply for any domain name incorporating the EMERALD CLUB mark. The Respondent is clearly not making any legitimate noncommercial or fair use of myemeraldclubsite.com. Any claim in that regard is easily dismissed since the myemeraldclubsite.com web page is a generic type of web page commonly used by domain name owners seeking to monetize their domain names through “click-through” fees.

3. Registered and used in Bad Faith.

According to the Complainant the facts of record clearly support a finding that the Respondent both registered and is using the myemeraldclubsite.com domain name in bad faith. Respondent’s registration of a domain name that fully incorporates Complainant’s EMERALD CLUB mark and merely adds generic words and a gTLD for a web site that attempts to attract Internet users to Respondent’s web page evidences a clear intent to trade upon the goodwill associated with Complainant’s EMERALD CLUB mark for car rental services. The 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 sites.

The web page to which the myemeraldclubsite.com domain name resolves is a “pay-per-click” web page. It contains online advertising that will provide someone, presumably the Respondent, with revenue from “click-through” fees from Internet users who find their way to the web page at myemeraldclubsite.com. At least some Internet visitors to Respondent’s web page at myemeraldclubsite.com will either not realize that they have been unwittingly directed to a web site that has no affiliation to the National EMERALD CLUB or not care that they are not at the “official” EMERALD CLUB web site and will

“click through” the links provided by the Respondent.

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

The Complainant contends that the Respondent’s bad faith is also clearly evident from the fact that the web page for myemeraldclubsite.com includes a link to the real National EMERALD CLUB web page and for which National must pay a click-through fee if that link is used. The fact that the myemeraldclubsite.com web page has a link to Complainant’s actual EMERALD CLUB page is evidence that the Respondent had actual knowledge of Complainant and thus registered and is using the myemeraldclubsite.com domain name in bad faith.
The fact that the myemeraldclubsite.com web page contains at the top, “Click here to buy MyEmeraldClubSite.com for your website name!” and a link to a web page where a user could receive a price quote for purchasing the myemeraldclubsite.com domain name is additional evidence of the bad faith use of the myemeraldclubsite.com domain name.

Respondent may claim ignorance regarding the use being made of the myemeraldclubsite.com domain name. However, under the UDRP, absent a showing of some good faith attempt prior to receiving the UDRP complaint, to stop the inclusion of advertising or links which profit from trading on third-party trademarks, a domain name owner will be deemed responsible for content appearing on the web site at the domain names they own. This is true even if the owner is not exercising direct control over such content - for example, in the case of advertising links appearing on an "automatically" generated basis, such as may be the case here. See Villeroy & Boch AG v. Mario Pingerma, D2007-1912 (WIPO February 14, 2008) (finding domain owner responsible for parking page created by the Registrar even though Respondent had no knowledge of the contents of the parking page’s contents). No matter how it is viewed, the very essence of setting up the myemeraldclubsite.com web site must be that it does result in commercial gain from Internet users accessing other web sites through the myemeraldclubsite.com web site.

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.

As of the date of Complainant’s commencement of this proceeding, the domain name at issue, myemeraldclubsite.com, was registered in the name of Privacy Protection Service INC d/b/a PrivacyProtect.org c/o Domain Admin, a domain privacy service.

Once notified of this complaint the Registrar disclosed the real owner of the domain name at issue.

The current record owner is Prakhar Bindal, Gurgaon, Haryana, India.

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».

This Panel agrees with the above quoted decision. However, it considers appropriate to list the real owner, i.e.: Prakhar Bindal, as the Respondent.

PRINCIPAL REASONS FOR THE DECISION

REGARDING THE PROCEDURE

The name of the Respondent was changed after the Complaint was initiated by Complainant: while the Respondent was Privacy Protection Service INC d/b/a PrivacyProtect.org at the time of the Complaint, it was changed to Prakhar Bindal after the Complaint was notified to the (first) Respondent. This was possible because the Respondent was apparently using a proxy registration provider.

As well explained in Vanguard Trademark Holdings USA LLC, v. WanZhongMedia c/o Wan Zhong, No. 100221 (Czech Arbitration Court, March 29, 2011): «neither the UDRP nor the UDRP-Rules deal with the rather recent phenomenon of privacy proxy services and, consequently, give no guidance on how to deal with the issues caused by such services (see ADR case nr 100093). Moreover, the ICANN Registrar Accreditation Agreement does not contain any provision regulating Whois information provided by privacy/proxy service providers. The UDRP procedure has demonstrated to be efficient and cost-effective, notably because the system is based on simple procedural principles including the fact that from a procedural point of view: (i) once the Complaint is filed, the domain name is frozen until there is a decision and (ii) the Complaint is filed against (and notified to) the person appearing to be the domain name holder in the Whois Database. 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. .. omissis . ...Therefore, the Panel takes the view that no amended Complaint is necessary. The initial Complaint has been regularly filed.».

This Panel agrees with the above quoted opinion that the Complaint was filed correctly and that no amended Complaint was necessary.

In addition this Panel notes that in UDRP cases involving privacy or proxy services in which the disclosure of an underlying registrant has been clear and timely, previous panels have elected to disregard the privacy or proxy service entirely and focus solely on the registrar-confirmed registrant.

Consistently, this Panel considers it appropriate to indicate as the Respondent of the disputed domain name the real owner, i.e. Prakhar Bindal.

* * *

Complainant’s registration and extensive use of the EMERALD CLUB mark for automobile rental services sufficiently establishes its right in the mark pursuant to paragraph 4(a)(i) of the Policy.

The domain name at issue, myemeraldclubsite.com, fully incorporates Complainant’s EMERALD CLUB mark, merely adding the generic terms “my” and “site”, removing the spaces from EMERALD CLUB, and adding the generic top-level domain “.com.”

This Panel believes that the addition of the generic terms "my" and "site" does not distinguish the myemeraldclubsite.com domain name from Complainant’s EMERALD CLUB mark.

Therefore this Panel considers the disputed domain name to be confusingly similar to the Complainant's marks pursuant to paragraph 4(a)(i) of the Policy.

* * *

The Respondent has no connection or affiliation with Complainant, which has not licensed or otherwise authorised the Respondent to use or apply for any domain name incorporating Complainant’s trademark.

The Respondent does not appear to make any legitimate use of the domain name for non-commercial activities. Indeed, the disputed domain name appears to be used to drive Internet traffic inappropriately to other web sites for commercial gain.

The Respondent does not appear to have been commonly known by the disputed domain name.

The Respondent has not proved, affirmed or even alleged to have legitimate rights (within the meaning of paragraph 4(a)(ii)of the Policy) to the disputed domain name.

Therefore, the Respondent has not shown any facts or elements to justify prior rights and/or legitimate interests in the disputed domain name in accordance with the UDRP Policy. The Respondent did not provide any elements to demonstrate, as requested by the Policy, that it used or made preparations to use the disputed domain name or a name corresponding to it in connection with a bona fide offering of goods or services.

Accordingly, the Panel finds that the Complainant has satisfied the burden of proof with respect to paragraph 4(a)(ii) of the Policy.

* * *

The web page for myemeraldclubsite.com includes a link to the real National EMERALD CLUB web page and for which National must pay a click-through fee if that link is used. The fact that the myemeraldclubsite.com web page has a link to Complainant’s actual EMERALD CLUB page is evidence that the Respondent had actual knowledge of the Complainant and of its activities and trademarks.

In addition, the myemeraldclubsite.com web page contains at the top, “Click here to buy MyEmeraldClubSite.com for your website name!” and a link to a web page where a user could receive a price quote for purchasing the myemeraldclubsite.com domain name.

The business model based upon use of an infringing domain name to attract users to Respondent’s web site is clear evidence that the Respondent registered and is using the myemeraldclubsite.com domain name in bad faith pursuant to paragraph 4(b)(iv) of the Policy.

Therefore this Panel agrees with the Complainant that from all the above it is clear that Respondent’s registration and use of the myemeraldclubsite.com domain name falls squarely within the parameters of bad faith use and registration within the meaning of the ICANN Policy.

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

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **MYEMERALDCLUBSITE.COM**: Transferred

PANELLISTS

Name	**Dr. Fabrizio Bedarida**

DATE OF PANEL DECISION 2015-04-29

Publish the Decision