Decision for dispute CAC-UDRP-101508

Case number	CAC-UDRP-101508
Time of filing	2017-04-12 10:10:00
Domain names	wedeliveralamo.online

Case administrator

Name	Aneta Jelenová (Case admin)

Complainant

Organization	Vanguard Trademark Holdings USA LLC

Complainant representative

Organization	Harness, Dickey & Pierce, PLC

Respondent

Name	Bryan Mayor

OTHER LEGAL PROCEEDINGS

No other legal proceedings are known by the Panel.

IDENTIFICATION OF RIGHTS

The Complainant Vanguard Trademark Holdings USA LLC owns different trademarks consisting of the word ALAMO. In particular the Complainant has fully proved to be the owner of the following signs:

- U.S. Trademark No. 1097722 for ALAMO registered on July 25, 1978, upon application made on May 18, 1977.
- EUTM No. 1860592 for ALAMO registered on September 16, 2002, upon application made on September 19, 2000.

FACTUAL BACKGROUND

Vanguard Trademark Holdings USA LLC ("Complainant"), is the owner of the ALAMO mark which it licenses to Alamo Rent A Car (“Alamo”). Started in 1974, Alamo is a value-oriented, internationally recognized brand serving the daily vehicle rental needs of the airport traveler throughout the United States, Canada, Mexico, the Caribbean, Latin America, Asia and the Pacific Rim. Alamo is the largest rent a car provider to international travelers visiting North America. Alamo operates an online vehicle rental site at <alamo.com> that offers vehicle rentals at all Alamo locations throughout the world. Anyone with internet access anywhere in the world can access the Alamo web site to make arrangements to rent a car from any Alamo location throughout the world.

In the Complainant’s view the registrations and extensive use of the "ALAMO" mark sufficiently establish its rights in the mark. Furthermore, according to the Complainant statement, the domain name <wedeliveralamo.online> is confusingly similar to the Complainant’s registered "ALAMO" mark since the domain name in dispute fully incorporates the Complainant’s "ALAMO" mark, merely adding the term “wedeliver” that describes a service offered by the same Alamo (the delivery of their rental car) and the generic top level domain identifier “.online.” As per the Complainant's submission the addition of the descriptive term “wedeliver” does not distinguish the <wedeliveralamo.online> domain name from the Complainant’s "ALAMO" mark.

In the Complainant's view also the Respondent believes that <wedeliveralamo.online> is confusingly similar to the "ALAMO" mark since the web page at <wedeliveralamo.online> features links to “Alamo Car Rental” and web sites offering car rental services.

In addition, the Complainant outlines that European Union trademark registration for the "ALAMO" mark was issued in September, 2002, while Complainant’s U.S. registration for "ALAMO" was issued in July, 1978. On the contrary the <wedeliveralamo.online> domain name was registered only on October 31, 2016 and, therefore, the Complainant’s registrations of the ALAMO mark pre-date the <wedeliveralamo.online> domain name by fourteen and thirty-eight years respectively.

The Complainant also assumes that Respondent has no rights or legitimate interests in the <wedeliveralamo.online> domain name and informs that on April 2017, the web site corresponding to the domain name <wedeliveralamo.online> resolved to a web page with a list of “Related Links” consisting of links to web sites offering car rental services, including those of Complainant’s licensee and its competitors.

The Complainant believes that in light of the long-standing use and registration of the "ALAMO" mark by the Complainant in connection with car rental services, the Respondent cannot have any legitimate rights in the <wedeliveralamo.online> domain name in connection with a site that serves merely to drive Internet traffic to web sites offering car rental services, including those of Complainant’s licensee and its competitors.

The Complainant underlines that the WHOIS record lists “Bryan Mayor” as the Registrant for the <wedeliveralamo.online> domain name and that neither the WHOIS record nor the web site to which the <wedeliveralamo.online> domain name resolves give any indication that Respondent is known as, operating a business as, or advertising as “We Deliver Alamo.” On this record, the Complainant believes that the Respondent has not been commonly known by the contested domain name so as to have acquired rights to or legitimate interests in it.

In particular, according to the Complainant, these facts suggest that the Respondent is not known as or operating as “We Deliver Alamo,” but that the same Respondent is attempting to use the goodwill generated by the "ALAMO" mark to drive Internet traffic to its web site through use of a confusingly similar domain name. This also in consideration of the fact that the Complainant has not licensed or otherwise permitted the Respondent to use its "ALAMO" mark in connection with car rental services or any other goods or services or to apply for any domain name incorporating the "ALAMO" mark.

In the Complianant's view the facts of record clearly support a finding that Respondent both registered and is using the <wedeliveralamo.online> domain name in bad faith. Actually, the Respondent has registered and is using a domain name that merely adds to Complainant’s "ALAMO" mark a generic wording and a gTLD; such use of the <wedeliveralamo.online> domain name for a web site that attempts to attract Internet users to the Respondent’s web page evidences a clear intent to trade upon the goodwill associated with Complainant’s "ALAMO" mark for car rental services.
In other words the Complianant's believes that the Respondent is deliberately using a domain name that is confusingly similar to the Complainant’s mark to attract, for commercial gain, Internet users to its web site, by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation or endorsement of its web sites and the services offered at such web sites.

In summary, according to the Complainant assertions:

a) it cannot be disputed that the Complainant has longstanding and well-recognized rights and goodwill in its "ALAMO" mark in connection with car rental services;
b) the <wedeliveralamo.online> domain name is confusingly similar to the Complainant's "ALAMO" mark;
c) the Respondent has no legitimate rights in the <wedeliveralamo.online> domain name;
d) the Respondent has merely registered the <wedeliveralamo.online> domain name to capitalize on the goodwill that the Complainant has in its "ALAMO" mark 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 disputed 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 UDRP 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 disputed domain name (within the meaning of paragraph 4(a)(ii)of UDRP Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii)of UDRP 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 Complaint was originally filed by the Complainant on April 5, 2017 indicating WhoisGuard Inc as Respondent.
On April 12, 2017 the Czech Arbitration Court ("CAC") sent to the Complainant the Notification of Deficiecies in Complaint according to paragraph 4(d) of the Policy since the Registrar's verification of April 5, 2017 had revealed that WhoisGuard is no longer providing any services to the disputed domain name and that the effective Registrant was Bryan Mayor. In the same comunication the CAC informed Complainant that he must submit the Amended Complainant within 5 days of the date of the Notification.

On April 13, 2017 the Complainant filed the Amended Complaint indicating Bryan Mayor as Respondent and on April 18, 2017 the CAC comunicated that the Complaint was admitted to proceed further in the Administrative Proceeding.

PRINCIPAL REASONS FOR THE DECISION

Paragraph 4(a) of the UDRP Policy provides that to obtain the transfer of the disputed domain name, complainant must prove that each of the following elements is present:
(i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
(ii) the respondent has no rights or legitimate interests in respect of the disputed domain name; and
(iii) the disputed domain name has been registered and is being used in bad faith.

A) The Complainant has established that it has rights in the trademark "ALAMO" since 1977. The Complainant's trademark was registered well before the registration of the disputed domain name (October 31, 2016). The disputed domain name <wedeliveralamo.online> is composed of (i) the wording "wedeliver", (ii) the Complainant's trade mark ALAMO and (iii) the top-level domain name ".online" to create the domain name <wedeliveralamo.online>.
The wording "wedeliver" is generic in the case at hand especially in consideration of the fact that the Complainant operates in the rental car sector which may include the car delivery service. In consideration of the above, it is clear that the only

distinctive part of the disputed domain name is the Complainant’s mark "ALAMO". Adding generic words to this mark do not prevent the disputed domain name being confusingly similar to the Complainant's trade mark "ALAMO". In addition, it must be considered that the relevant comparison to be made is with the first portion of the domain name only (i.e., “wedeliveralamo"), as it is well-established that the top-level domain name (in this case .online) should be disregarded for this purpose (see Playboy Enterprises International, Inc. v. John Taxiarchos, WIPO Case No. D2006-0561; Burberry Limited v. Carlos Lim, WIPO Case No. D2011-0344; Magnum Piercing, Inc. v. The Mudjackers and Garwood S. Wilson, Sr., WIPO Case No. D2000-1525).
The Panel finds that the disputed domain name is confusingly similar to the Complainant’s mark "ALAMO". Therefore, in the Panel's view the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B) The Complainant has long standing rights in the mark "ALAMO". The Complainant provided prima facie evidence that the Respondent does not have rights or legitimate interests in respect of the disputed domain name as it is not commonly known under the disputed domain name and as the Respondent was never authorized or licensed or otherwise permitted by the Complainant to use the disputed domain name. The Respondent, in the absence of any response, has not shown any facts or elements to justify legitimate rights or interests in the disputed domain name. Therefore, on the basis of the evidences 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. Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C) The Panel is of the opinion that the disputed domain name has been registered in bad faith because the Respondent was or must have been perfectly aware of the existence of "ALAMO" trademark, which is highly distinctive and unique for the registered services, when it registered the domain name <wedeliveralamo.online>. Furthermore the Respondent is using the disputed domain name for a parking site that diverts Internet users to, inter alia, websites of the Complainant's competitors and licencees .The above represents an action taken by the Respondent to intentionally attract, for commercial gain, Internet users by creating a likelihood of confusion with Complainant’s "ALAMO" mark as to the source, sponsorship, affiliation, or endorsement of Respondent’s website. Previous Panels have held that using the domain name as a parking page with pay-per-click links to third party websites may be evidence of bad faith when the registrant is using the domain name in this manner because of the similarity to the Complainant’s trademark in the hope and expectation that the similarity will lead to confusion on the part of Internet users and results in an increased number of Internet users being drawn to that domain name parking page (MpireCorporation v. Michael Frey, WIPO Case No. D2009-0258; Paris Hilton v. Deepak Kumar, WIPO Case No. D2010-1364 and La Fee v. Pavol Icik, WIPO Case No. D2013-0526). Therefore, the Panel finds that the Complainant has also satisfied 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. **WEDELIVERALAMO.ONLINE**: Transferred

PANELLISTS

Name	**Avv. Guido Maffei**

DATE OF PANEL DECISION 2017-05-19

Publish the Decision