Decision for dispute CAC-UDRP-101510

Case number	CAC-UDRP-101510
Time of filing	2017-04-12 10:41:38
Domain names	alamoverde.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	Vanguard Trademark Holdings USA LLC

Complainant representative

Organization	Harness, Dickey & Pierce, PLC

Respondent

Organization	Super Privacy Service c/o Dynadot

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant is the owner of several trademarks containing the name “ALAMO”, all registered well before the Respondent registered the disputed domain name, including:

EU trademark 001860592 (word trademark ALAMO; filing date 19/09/2000; registration date 16/09/2002; classes 12, 16. 36. and 39);

US trademark 73127031 - 1097722 (word trademark ALAMO; filing date 18/05/1977; registration date 25/07/1978; class 39).

The Complainant filed evidence that its word trademarks are actively being used (evidence of use of the marks by a licensee of the Complainant via the website available at the domain name <alamo.com>).

FACTUAL BACKGROUND

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

FACTUAL AND LEGAL GROUNDS

This is a Complaint filed on behalf of Vanguard Trademark Holdings USA LLC.

As of the date of the filing of the Complaint in this matter, the disputed domain name at issue, <alamoverde.com>, is owned of record by Super Privacy Service c/o Dynadot.

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

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

The Complainant is the owner of the following registration in the European Community for the ALAMO mark:

Registration No. 001860592 registered September 16, 2002
ALAMO in International Class 12 for "Vehicles; apparatus for locomotion by land, air or water"; International Class 16 for "Printed matter; printed publications; periodicals; books; newsletters; magazines; pamphlets; catalogues; notebooks; writing pads; manuals; brochures; diaries and calendars; advertising material; paper, cardboard and goods made from these materials"; International Class 36 for "Financial and insurance services; financial and insurance management; valuation services; valuation management; relating online services; and related promotional and discount services"; and International Class 39 for "Provision of transport services including for both leisure and business purposes; hiring of transport vehicles including the provision of such services to the functioning of airports; loaning of vehicles; vehicle parking; hiring of vehicle accessories; inspection of vehicles before transport; travel for and escorting of travelers; provision of information about the transport of goods and information relating to tariffs, timetables and methods of transport; transport reservation and arranging services; vehicle rental, reservation and leasing services; relating online services; and related promotional and discount services; automobile rental and leasing services; car leasing services; vehicle rental, reservation and leasing services".

The Complainant is also the owner of the following registration for the relevant mark in the United States:

Registration No. 1,097,722 issued July 25, 1978
ALAMO in International Class 39 for "automotive renting and leasing services".

The Complainant, Vanguard Trademark Holdings US, LLC, 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 website to make arrangements to rent a car from any Alamo location throughout the world.

1. Confusing similarity

The Complainant's registrations and extensive use of the ALAMO mark sufficiently establish its rights in the mark pursuant to Policy ¶ 4(a)(i). See Vivendi Universal Games v. XBNetVentures Inc., FA 198803 (Nat. Arb. Forum Nov. 11, 2003) ("Complainant's federal trademark registrations establish Complainant's rights in the BLIZZARD mark."); See also Mothers Against Drunk Driving v. phix, FA 174052 (Nat. Arb. Forum Sept. 25, 2003) (finding that a complainant's registration of the MADD mark with the United States Patent and Trademark Office established its rights in the mark for purposes of Policy ¶ 4(a)(i)).

The disputed domain name is confusingly similar to the Complainant's registered ALAMO mark. The disputed domain name fully incorporates the Complainant's ALAMO mark, merely adding the generic term "verde" ("green" in English), and the generic top level domain identifier, ".com."

The incorporation of a trademark in its entirety into a domain name is sufficient to establish that the disputed 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) ("a domain name that reproduces the trademark in its entirety is confusingly similar to the mark" when the disputed domain names <hürriyet.com>, <hürriyetemlak.com>, and <hürriyetoto.com> fully incorporated the complainant's HURRIYET mark); See also Bayerische Motoren Werke AG, Sauber Motorsport AG v. Petaluma Auto Works, D2005-0941 (WIPO Oct. 20, 2005) ("It has been stated in several decisions by prior UDRP administrative panels that incorporating a trademark in its entirety into a domain name can be sufficient to establish that the domain name is identical or confusingly similar to a registered trademark" when the <bmwsauberf1.com> domain name fully incorporated complainant's BMW and SAUBER marks).

The addition of the generic term "verde" ("green" in English) does not distinguish the disputed domain name from the Complainant's ALAMO mark. See Yahoo! v. [--], FA0801001139567 (Nat. Arb. Forum, Mar. 12, 2008) in which the Panellist stated:

"Next, Complainant claims that Respondent's <yahoogreen.com> domain name is confusingly similar to its YAHOO! mark, as Respondent simply omits the exclamation point from the mark and adds the generic term "green." Previous panels have found, and this Panel so finds, that such slight alterations to a mark do not render a disputed domain name distinct from the mark. In addition, as a top-level domain is required in all domain names, Respondent's inclusion of the generic top-level domain ".com" is irrelevant. Thus, the Panel concludes that the <yahoogreen.com> domain name is confusingly similar to Complainant's YAHOO! mark, as contemplated by Policy ¶ 4(a)(i)."

Obviously, the Respondent believes that disputed domain name is confusingly similar to the ALAMO mark since the web page at <alamoverde.com> features links to "Alamo Car Rental" and websites offering car rental services.

The addition of a generic top level domain identifier does not prevent the disputed domain name from being confusingly similar to the Complainant's ALAMO mark. 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.").

The Complainant's European Community registration for the ALAMO mark issued in September, 2002. The Complainant's U.S. registration for ALAMO issued in July, 1978. The disputed domain name was registered on October 31, 2016 and, therefore, the Complainant's registrations of the ALAMO mark pre-date the disputed domain name by fourteen and thirty-eight years respectively.

2. Rights to or Legitimate Interests

The Respondent has no rights or legitimate interests in the disputed domain name. On March 29, 2017, the website <alamoverde.com> resolved to a web page with two lists of "Related Links" which contained links to websites offering car rental services, including those of the Complainant's licensee and its competitors. The first list of "Related Links" on the web page at <alamoverde.com> included the following:

Alamo Car Rental
Alamo Car Hire
Cheap Airport Car Rental Deals
Alamo Car Hire Miami Airport
Car Rental at Lax
Alamo Miami
Dollar Car Rental Miami
Alamo Orlando

Car Rental Car Rental
Discount Car Rental Companies

The second list of “Related Links” on the web page at <alamoverde.com> included the following:

Cheap One Way Car Rental Alamo Auto
Cheap Car Rental in Orlando Alamo Discount
Luxury Car Rental in Las Vegas Budget Rental Maui
Alamo Coupons Fort Lauderdale Car Rental
Cheapest Car Rental Rates Cheap Carrentals
Alamo Ren [sic] a Car Hot Wire Car Rental
National Car Rental Coupons El Alamo
Alamo Blanco Fort Alamo
Cheap Car Hire Advantage Car Rental SFO
Cheap Rental Thrifty Car Rental Phone Number

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 disputed domain name in connection with a site that serves merely to drive Internet traffic to web sites offering car rental services, including those of the Complainant’s licensee and its competitors.

The Respondent’s use is neither a bona fide offering of goods or services pursuant to Policy ¶4(c)(i) nor a legitimate noncommercial or fair use pursuant to Policy ¶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 the Complainant’s business does not represent a bona fide offering of goods or services under Policy ¶4(c)(i) or a legitimate noncommercial or fair use under Policy ¶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 was neither a bona fide offering of goods or services nor a legitimate noncommercial or fair use of the disputed domain names).

The WHOIS record lists “Super Privacy Service c/o Dynadot” as the Registrant for the disputed domain name. Neither the WHOIS record nor the website to which the disputed domain name resolves give any indication that the Respondent is known as operating a business or advertising as “Alamoverde.” 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 the Respondent is commonly known as. See Haas Automation, Inc. v. Machine Tools 24-7 / Jon Beal, FA1201001425055 (Nat. Arb. Forum Feb. 29, 2012) (“Respondent may well be known in the community as a vendor of used Haas equipment, but it has not shown that it is known as such by the name HAAS. The relevant evidence presented consists exclusively of the WHOIS information”). There is nothing in the WHOIS record that would indicate the Respondent is or is commonly known as “Alamoverde.” See Disney Enterprises, Inc. v. online No.1 / OS1, FA 1307001512060 (Nat. Arb. Forum Sept. 13, 2013) (“the pertinent WHOIS information identifies the registrant of the domain name only as “online No. 1 / OS1,” which does not resemble the domain name. On this record, we conclude that Respondent has not been commonly known by the contested domain name so as to have acquired rights to or legitimate interests in it within the meaning of Policy ¶ 4(c)(ii).”).

These facts suggest that the Respondent is not known as or operating as “Alamoverde,” but instead 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. See Educ. Broad. Corp. v. DomainWorks Inc., FA 882172 (Nat. Arb. Forum Apr. 18, 2007) (concluding that the respondent was not commonly known by the <thirteen.com> domain name based on all evidence in the record, and the respondent did not counter this argument in its response). Again, this use fails to establish a Policy ¶ 4(c)(i) bona fide offering, or Policy ¶ 4(c)(iii) legitimate noncommercial or fair use. See U.S. Franchise Sys., Inc. v. Howell, FA 152457 (Nat. Arb. Forum May 6, 2003) (holding that the respondent’s use of the complainant’s mark and the goodwill surrounding that mark as a means of attracting Internet users to an unrelated business was not a bona fide offering of goods or services).

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 addition, the Respondent is clearly not making any legitimate non-commercial or fair use of <alamoverde.com>. In fact, any claim in that regard is easily dismissed since the <alamoverde.com> is a generic type of web page commonly used by domain name owners seeking to monetize their domain names through "click-through" fees. See Compagnie de Saint Gobain v. Com-Union Corp., D2000-0020 (WIPO Mar. 14, 2000) (finding no rights or legitimate interest where the respondent was not commonly known by the mark and never applied for a license or permission from the complainant to use the trademarked name); See also Charles Jourdan Holding AG v. AAIM, D2000-0403 (WIPO June 27, 2000) (finding no rights or legitimate interests where (1) the respondent is not a licensee of the complainant; (2) the complainant's prior rights in the domain name precede the respondent's registration; (3) the respondent is not commonly known by the domain name in question).

As previously indicated the Complainant's licensee operates an online car rental website at <alamo.com>. It is clear that the Respondent has no legitimate rights in the disputed domain name and, by the use of a confusingly similar domain name, is attempting to use the disputed domain name to drive Internet traffic to its <alamoverde.com> website when Internet users are trying to reach the Complainant's ALAMO website. Such use constitutes a lack of rights or legitimate interest in the disputed domain name under ICANN Policy ¶ 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 web site).

Once the Complainant makes a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name under Policy ¶ 4(a)(ii), 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.").

3. Registered and used in Bad Faith

The facts of record clearly support a finding that the Respondent both registered and is using the disputed domain name in bad faith. The Respondent has registered and is using the disputed domain name that merely adds to the Complainant's ALAMO mark the generic term "verde" and a gTLD. Such use of a domain name for a website that attempts to attract Internet users to the Respondent's web page evidences a clear intent to trade upon the goodwill associated with the Complainant's ALAMO mark for car rental services. 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 website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of its websites and the services offered at such websites. The web page <alamoverde.com> also has links web pages with direct links to the Alamo website making confusion all the more likely.

The web page to which the disputed 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 <alamoverde.com>. At least some Internet visitors to the Respondent's web page <alamoverde.com> will either not realize that they have been unwittingly directed to a website that has no affiliation to the Complainant or not care that they are not at the Complainant's "official" website 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 the Respondent's website is clear evidence that the Respondent registered and is using the disputed domain name in bad faith pursuant to Policy ¶ 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 web sites 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 ¶ 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).

The Respondent's bad faith is also clearly evident from the fact that the web page for <alamoverde.com> includes links to web pages with a direct link to the real ALAMO web page and for which Alamo must pay a click-through fee if that link is used.

The Respondent may claim ignorance regarding the use being made of the disputed 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 website 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. 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 <alamoverde.com> website must be that it does result in commercial gain from Internet users accessing other websites through the <alamoverde.com> website.

From these facts, it is clear that the Respondent's registration and use of the disputed domain name falls squarely within the parameters of ICANN Policy ¶ 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 ¶ 4(b)(iv) because respondent was using the confusingly similar domain to attract Internet users to its commercial web site); 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'").

In summary, 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. The disputed domain name is confusingly similar to the Complainant's ALAMO mark. The Respondent has no legitimate rights in the disputed domain name. The Respondent has merely registered the disputed domain name to capitalize on the goodwill that the Complainant has in its ALAMO mark to drive Internet traffic inappropriately to other websites 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 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 disputed 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 disputed 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.

PRINCIPAL REASONS FOR THE DECISION

The Panel finds that the disputed domain name is confusingly similar to the Complainant's registered ALAMO word trademarks. The disputed domain name fully incorporates the Complainant's ALAMO marks, merely adding the generic term "verde" ("green" in English), and the generic top level domain identifier, ".com."

The Complainant rightfully contends that the Respondent has made no use of, or demonstrable preparations to use the disputed domain name in connection with a bona fide offering of goods or services, is not making a legitimate non-commercial or fair use of the disputed domain name, and is not commonly known under the disputed domain name. The Complainant submitted evidence that the website at the disputed domain name resolves to a web page with sponsored links to websites offering car rental services, including those of the Complainant's licensee and its competitors. Such use is neither a bona fide offering of goods or services pursuant to Policy ¶4(c)(i), nor a legitimate non-commercial or fair use pursuant to Policy ¶4(c)(iii). Neither the WHOIS record, nor the website to which the disputed domain name resolves give any indication that the Respondent is known as operating a business, or advertising as "Alamoverde." This suggests that the Respondent is not known as or operating as "Alamoverde," but instead is attempting to use the goodwill generated by the ALAMO marks to drive Internet traffic to its website through use of a confusingly similar domain name. The Complainant alleges that it 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 lack of any Response from the Respondent, or any other information indicating the contrary, the Panel concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

The Complainant proved that the Respondent is using the disputed domain name to attract, for commercial gain, Internet users to its own website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of its websites and the services offered at such websites. The Complainant submitted evidence that the web page at <alamoverde.com> contains sponsored links to web pages which offer car rental services which are competing with the services offered by the Complainant's licensee. The Panel accepts that the Respondent has registered and is using the disputed domain name to capitalize on the goodwill that the Complainant has in its ALAMO mark to drive Internet traffic inappropriately to other websites for commercial gain. The Panel finds that the Respondent has registered and is using the disputed domain name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ALAMOVERDE.COM**: Transferred

PANELLISTS

Name	**Bart Van Besien**

DATE OF PANEL DECISION 2017-05-22

Publish the Decision