Decision for dispute CAC-UDRP-101562

Case number	CAC-UDRP-101562
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Domain names	alamonow.com

Case administrator

Name	Aneta Jelenová (Case admin)

Complainant

Organization	Vanguard Trademark Holdings USA LLC

Complainant representative

Organization	Harness, Dickey & Pierce, PLC

Respondent

Name	Fred Wulff

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other proceedings, pending or decided, related to the Disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner, among others, of the following registrations for the trademark "ALAMO“:

- EUIPO trademark registration no. 001860592 “ALAMO”, granted on September 16, 2002, in classes 12, 16, 36 and 39;

- USPTO trademark registration no. 1097722 “ALAMO”, granted on July 25, 1978, in class 39.

FACTUAL BACKGROUND

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

FACTUAL AND LEGAL GROUNDS. ICANN Rule 3(b)(ix).

The Complaint filed on behalf of Vanguard Trademark Holdings USA LLC.

As of the date of the filing of the Complaint in this matter, the domain name at issue, <alamonow.com>, was owned of

record by WhoisGuard, Inc. c/o WhoisGuard Protected. Subsequent to the filing of the Complaint in this matter, according to the Registrar Verification, ownership of <alamonow.com> was changed to “Fred Wulff.”

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

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

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

Registration No. 001860592 registered 16 September 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 travellers; 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”

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

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

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 web site to make arrangements to rent a car from any Alamo location throughout the world.

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

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 (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 (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 domain name <alamonow.com> is confusingly similar to Complainant’s registered ALAMO mark. The <alamonow.com> domain name fully incorporates Complainant’s ALAMO mark, merely adding the generic term “now” 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 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 "now" does not distinguish the <alamonow.com> domain name from Complainant's ALAMO mark. See:

(1) Nike, Inc. and Nike Innovate, C.C. v. ZhangZhongwu / nike1, FA 1693280 (Forum Oct. 22, 2016) (finding that the domain name nikenow.com is confusingly similar to the NIKE mark).

(2) Moneytree, Inc. v. Matt Sims / MoneyTree Now, FA 1602721 (Forum Mar. 3, 2015) (finding that moneytreenow.com is confusingly similar to the MONEY TREE mark).

(3) Vanguard Trademark Holdings USA LLC v. National Chamber of Commerce for Women, FA 1466775 (Forum Nov. 30, 2012) (finding nowalamo.com and nowalamo.net confusingly similar to the ALAMO mark).

(4) West Publishing Corporation v. Domain Administrator Snapnames@whoiswatchdog.com, FA 1384845 (Forum May 17, 2011) (finding westlawnow.com confusingly similar to the WESTLAW mark).

(5) PFIP, LLC v. Premier Nexus, FA 130303016 (Forum Feb. 25, 2010) (finding planetfitnessnow.com confusingly similar to the PLANET FITNESS mark).

The addition of a generic top level domain identifier does not prevent the <alamonow.com> domain name from being confusingly similar to Complainant's ALAMO mark. See Jerry Damson, Inc. v. Tex. Int'l Prop. Assocs., FA 916991 (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 (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 4(a)(ii).

Respondent has no rights or legitimate interests in the <alamonow.com> domain name. On 05 June 2017, the web site at the <alamonow.com> domain name resolved to a web page with a list of "Related Links" which consisted exclusively of links to web sites offering car rental services, including those of Complainant's licensee and its competitors. The list of "Related Links" on the web page at <alamonow.com> included the following:

Alamo Car Rental Miami Airport
Alamo Miami
Alamo Car Hire
Alamo Orlando
Car Rental Companys
Luxury Car Rental Lax
Cheap Airport Car Rental Deals
Alamo Deals
Alamo Car Rental Las Vegas
Car Hire Miami Airport
Cheap Car Hire Miami

In light of the long-standing use and registration of the ALAMO mark by Complainant in connection with car rental services, Respondent cannot have any legitimate rights in the <alamonow.com> 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.

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 (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 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 (Forum Mar. 17, 2003) (finding that the respondent's diversionary use of the complainant's mark(s) to attract Internet users to its own web site was neither a bona fide offering of goods or services nor a legitimate noncommercial or fair use of the disputed domain names).

The Registrar Verification lists "Fred Wulff" as the Registrant for the <alamonow.com> domain name. Neither the WHOIS record nor the web site to which the <alamonow.com> domain name resolves give any indication that Respondent is known as, operating a business as, or advertising as "Alamonow". 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. See Haas Automation, Inc. v. Machine Tools 24-7 / Jon Beal, FA1201001425055 (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"). See also Disney Enterprises, Inc. v. online No.1 / OS1, FA 1307001512060 (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 Respondent is not known as or operating as "Alamonow," 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 (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). 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 (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).

Complainant has not licensed or otherwise permitted 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, Respondent is clearly not making any legitimate noncommercial or fair use of <alamonow.com>. In fact, any claim in that regard is easily dismissed since the <alamonow.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. 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 Complainant's licensee operates an online car rental web site at alamo.com. It is clear that Respondent has no legitimate rights in the <alamonow.com> domain name and, by the use of a confusingly similar domain name, is attempting to use the <alamonow.com> domain name to drive Internet traffic to its <alamonow.com> web site when Internet users are trying to reach the Complainant's ALAMO web site. 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 (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 Complainant makes a prima facie case that Respondent lacks rights and legitimate interests in the <alamonow.com> domain name under Policy 4(a)(ii), the burden shifts to Respondent to show it does have rights or legitimate interests. See Hanna-Barbera Prods., Inc. v. Entm't Commentaries, FA 741828 (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 (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.").

The Respondent's burden in that case requires clear contemporaneous evidence of bona fide pre-complaint preparations such as (i) evidence of business formation -related due diligence/legal advice/correspondence, (ii) evidence of credible investment in website development or promotional materials such as advertising, letterhead, or business cards (iii) proof of a genuine (i.e., not pretextual) business plan utilizing the domain name, and credible signs of pursuit of the business plan, (iv) bona fide registration and use of related domain names, and (v) other evidence generally pointing to a lack of indicia of cybersquatting intent. If not independently verifiable by the panel, claimed examples of use or demonstrable preparations to use the domain name in connection with a bona fide offering of goods or services cannot be merely self-serving but should be inherently credible and supported by relevant pre-complaint evidence. See Harpo, Inc. and Oprah's Farm, LLC. v. Robert McDaniel, D2013-0585 (WIPO Jun. 17, 2013) ("The Respondent has asserted an intention to use the Domain Name for a noncommercial blog website. The Respondent has admittedly never developed such a website, however, and offers no supporting evidence of 'demonstrable preparations' for such use. The Panel concludes on the existing record that the second element of the Complaint has been established.") See also WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition.

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

The facts of record clearly support a finding that the Respondent both registered and is using the <alamonow.com> domain name in bad faith. The Respondent's has registered and is using a domain name that merely adds to Complainant's ALAMO mark the generic term "now" and a gTLD. Such use of a domain name 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 ALAMO mark for car rental services. 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 sites and the services offered at such web sites.

Complainant's European Community registration for the ALAMO mark issued in September, 2002. Complainant's U.S. registration for ALAMO issued in July, 1978. The <alamonow.com> domain name was registered on 09 February 2017 and, therefore, Complainant's registrations of the ALAMO mark pre-date the <alamonow.com> domain name by fourteen and thirty-eight years respectively.

The web page to which the <alamonow.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 <alamonow.com>.

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 <alamonow.com> domain name in bad faith pursuant to Policy 4(b)(iv). See Kmart v. Kahn, FA 127708 (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 (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).

Respondent's bad faith is also clearly evident from the fact that the web page for <alamonow.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.

Respondent may claim ignorance regarding the use being made of the alamonow.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. 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 <alamonow.com> web site must be that it does result in commercial gain from Internet users accessing other web sites through the <alamonow.com> web site.

From these facts, it is clear that Respondent's registration and use of the <alamonow.com> domain name falls squarely within the parameters of ICANN Policy 4(b)(iv). See G.D. Searle & Co. v. Celebrex Drugstore, FA 123933 (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 (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 <alamonow.com> domain name is confusingly similar to Complainant's ALAMO mark. Respondent has no legitimate rights in the <alamonow.com> domain name. Respondent has merely registered the <alamonow.com> domain name to capitalize on the goodwill that 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 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 <alamonow.com> is confusingly similar to the Complainant's "ALAMO" trademark, since the Disputed domain name incorporates the Complainant's trademark "ALAMO" in its entirety and the mere addition of the generic term "now" is not capable to dispel the confusing similarity arising from the Complainant's trademark's incorporation in the Disputed domain name.

Moreover, the Complainant contends, and the Respondent has not objected to these contentions, that the Respondent so far has neither made use of, or demonstrable preparations to use, the Disputed domain name in connection with a bona fide offering of goods or services, nor is the Respondent making a legitimate noncommercial or fair use of the Disputed domain name, nor is the Respondent commonly known thereunder. The Complainant has provided evidence that at some point before the filing of this Complaint the Disputed domain name redirected to a standard Pay-Per-Click (PPC) website with hyperlinks to a variety of third parties' commercial websites, some of which apparently are direct competitors of the Complainant on the car rental market. Many UDRP panels have found that the generation of PPC revenues by using a domain name that is confusingly similar to a trademark neither qualifies as a bona fide offering of goods or services nor as a legitimate noncommercial or fair use under the UDRP. Accordingly, the Panel has no difficulty in finding that the Respondent has no rights or legitimate interests in respect of the Disputed domain name <alamonow.com>.

Finally, the Complainant points to the fact, and the Panel agrees with this line of argumentation, that using the Disputed domain name, which is confusingly similar to the Complaint's "ALAMO" trademark, in order to generate PPC commissions by hyperlinking to active websites of the Complainant's competitors on the car rental market is a clear indication that the Disputed domain name was registered and is used by the Respondent intentionally attempting to attract, for commercial gain, Internet users to said website, by creating a likelihood of confusion with the Complainant's "ALAMO" trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website. Such circumstances shall be evidence of registration and use of the Disputed domain name in bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ALAMONOW.COM**: Transferred

PANELLISTS

Name	**Stephanie G. Hartung, LL.M.**

DATE OF PANEL DECISION 2017-07-04

Publish the Decision