Decision for dispute CAC-UDRP-100648

Case number	CAC-UDRP-100648
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Domain names	ALAMORENTALS.COM

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	Vanguard Trademark Holdings USA, LLC

Complainant representative

Organization	Harness, Dickey & Pierce, PLC

Respondent

Organization	PrivacyProtect.org ID#10760

OTHER LEGAL PROCEEDINGS

None.

IDENTIFICATION OF RIGHTS

The Complainant is owner of various registered ALAMO trademarks in the United States of America for, inter alia, automotive renting and leasing services dating back to 1978, and claims to have similar registered trademark registrations in many countries outside the United States of America.

FACTUAL BACKGROUND

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

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

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

As of the date of Complainant’s commencement of this proceeding, the domain name at issue, alamorentals.com, is owned of record by Privacyprotect.org ID #10760.

Complainant’s counsel contacted PrivacyProtect.org and requested that it identify the owner of alamorentals.com so that

the owner could be named in the UDRP. By email dated 9 July 2013 PrivacyProtect.org refused to provide the identity of the owner of alamorentals.com. As a result, Complainant was forced to file this complaint in the name of PrivacyProtect.org and PrivacyProtect.org should remain as the named Respondent.

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 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…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, Complainant does not believe that is should be required to file an amended complaint once the Registrar "draws back the curtain" to reveal the supposed real owner of the domain name at issue.

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

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

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

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

Reg. No. 2,805,426 issued January 13, 2004
ALAMO.COM in International Class 35 for "promoting the goods and services of others through a membership benefit program which entitles members to receive discounts on renting and leasing vehicles" and International Class 39 for "vehicle renting and reservation services; vehicle leasing services".

Registration No. 2,427,041 issued February 6, 2001
ALAMO & Design in International Class 39 for "automotive renting and leasing services."

Registration No. 2,427,040 issued February 6, 2001
ALAMO & Design in International Class 39 for "automotive renting and leasing services."

In addition to its registrations in the United States, Complainant has registered its ALAMO mark(s) for vehicle rental services in many foreign countries.

Complainant, Vanguard Trademark Holdings USA LLC, is the owner of the ALAMO mark(s) which it licenses to Alamo Rent A Car and other operating entities. Started in 1974, Alamo Rent A Car is a value-oriented, internationally recognized brand serving the daily rental needs of the airport business traveler throughout the United States, Canada, Mexico, the Caribbean, Latin America, Asia and the Pacific Rim. Alamo also is the largest car rental provider to international travelers visiting North America. Complainant's licensee operates an on-line car rental site at alamo.com and alamocarentals.com.

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

The domain name, alamorentals.com, is confusingly similar to Complainant's registered ALAMO mark(s). The domain name at issue fully incorporates Complainant's ALAMO mark(s) with the addition of a term that indicates rental car services. A general rule under [ICANN] Policy par. 4(a)(i) is that a domain name is confusingly similar to a third-party mark(s) where the domain name fully incorporates the mark(s) and simply adds additional words that correspond to the goods or services

offered by the third party under the mark. Sony Kabushiki Kaisha v. 0-0 Adult Video Corp., FA 475214 (Nat. Arb. Forum June 27, 2005).

Complainant's US registration for ALAMO for rental car services issued on July 25, 1978. Although the WHOIS records indicate that alamorentals.com was initially registered in 2002, it was owned by Kevin Daste at least through 1 March 2007. PrivacyProtect.org did not become the owner of the alamorentals.com domain name until sometime after 3 October 2009. In any event, Complainant's rights in the ALAMO mark for rental car services pre-date any rights held by the current owner by more than 20 years.

The remedies under the Policy are injunctive rather than compensatory in nature, and the concern is to avoid ongoing or future confusion as to the source of communications, goods, or services. See The Hebrew University of Jerusalem v. Alberta Hot Rods, WIPO Case No. D2002-0616; The E.W. Scripps Company v. Sinologic Industries, WIPO Case No. D2003-0447 (the Policy does not contemplate a defense of laches, which is inimical to the Policy's purposes). See also Tom Cruise v. Network Operations Center/ Alberta Hot Rods, WIPO Case No. D2006-0560 (finding no meaningful precedent under the Policy for refusing to enforce trademark rights based on delay in bringing a complaint). See also The Jennifer Lopez Foundation v. Jeremiah Tieman, et al., WIPO Case No D2009-0057 March 24, 2009).

The primary reason that there was no earlier challenge to the domain name at issue in the past is that Complainant's predecessors-in-interest were using their financial resources to stay in business. ANC Rental, the then owner of National Car Rental and Alamo Rent-A-Car, filed for bankruptcy protection in November, 2001. In October, 2003, it sold both National Car Rental and Alamo Rent-A-Car to a "buyout firm," Cerberus Capital Management ("Cerberus"). Cerberus attempted to turn the operations around and in July, 2006 reorganized them as Vanguard Car Rental Group ("Vanguard") in connection with a proposed stock offering. The plan for stock offering to raise needed capital was abandoned in April, 2007. Subsequently, in August, 2007, the owners of Enterprise Rent-A-Car acquired the assets of Vanguard and in 2009, National Rental Car and Alamo Rent-A-Car became operating units under Enterprise Holdings, Inc. Once Enterprise was able to review and organize the trademark assets of Alamo Rent-A-Car, it began to take action against those entities that it believed were infringing the ALAMO mark.

2. Rights to or Legitimate Interests. ICANN Rule 3(b)(ix)(2); ICANN Policy par. 4(a)(ii).

Respondent has no rights or legitimate interests in the disputed domain name. The disputed domain name resolves to a web page with a series of links under the heading "Related Searches". These links include, ""Alamo Rent A Car", "Car Rentals," "Alamocarrentals", "Cheapest rent a Car", "Airport Car Rental Deals", "Hertz Car Rental", "Budget Car Rental Coupons", "Alamo Car Rental UK", and "Rent a Car in Orlando Airport". Each of these links directs to a page with links to car rental websites including those of Complainant's licensee and its competitors.

In light of the long-standing use and registration of the ALAMO mark(s) in connection with car rental services in the United States, Respondent cannot have any legitimate rights in the alamorentals.com domain name in connection with a site that merely drives Internet traffic to other websites, particularly those offering vehicle rental services in competition with Complainant's licensee.

Respondent's use is neither a bona fide offering of goods or services pursuant to Policy par. 4(c)(i) nor a legitimate noncommercial or fair use pursuant to Policy par. 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 Complainant's business does not represent a bona fide offering of goods or services under Policy par. 4(c)(i) or a legitimate noncommercial or fair use under Policy par. 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, which contained a series of hyperlinks to unrelated websites, was neither a bona fide offering of goods or services nor a legitimate noncommercial or fair use of the disputed domain names).

Complainant has not licensed or otherwise permitted Respondent to use its ALAMO mark(s) in connection with car rental services or any other goods or services or to apply for any domain name incorporating the ALAMO mark(s). In addition,

Respondent is clearly not making any legitimate noncommercial or fair use of “Alamo Rentals.” In fact, any claim in that regard is easily dismissed since the alamorentals.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 on-line car rental web site at alamo.com and alamocarrentals.com. It is clear that Respondent has no legitimate rights in the domain name at issue and is attempting to divert Internet traffic to its alamorentals.com domain name when Internet users type in “alamorentals.com” trying to reach the Alamo Rent A Car web site and such a use constitutes a lack of rights or legitimate interest in the disputed domain names under ICANN Policy paragraphs 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 website).

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

The facts of record suggest and support a finding that Respondent both registered and is using the domain name at issue in bad faith. Respondent’s registration of a domain name that combines Complainant’s ALAMO mark(s) with the generic term “rentals” that describes Complainant’s use of the ALAMO mark(s) and that attempts to attract Internet users to Respondent’s web site evidences a clear intent to trade upon the goodwill associated with Complainant’s ALAMO mark(s) for rental car services. Respondent is deliberately using a domain name that is confusingly similar to Complainant’s mark(s) to attract, for commercial gain, Internet users to its web site, by creating a likelihood of confusion with Complainant’s mark(s) as to the source, sponsorship, affiliation or endorsement of its web sites and the services offered at such web sites.

The web page to which the alamorentals.com domain name resolves appears to be a “pay-per-click” web page. It contains on-line advertising that will provide the Respondent with revenue from “click-through” fees from Internet users who find their way to the web page at alamorentals.com. Many Internet visitors to Respondent’s web page at alamorentals.com will either not realize that they have been unwittingly directed to a web site that has no affiliation to Alamo Rent-a-Car or not care that they are not at the “official” Alamo web site and will “click through” to Alamo’s website or websites of its competitors linked on Respondent’s websites.

No matter how it is viewed, the very essence of setting up the alamorentals.com website must be that it does result in commercial gain from Internet users accessing websites through the alamorentals.com web site.

Clearly Respondent does not operate a business known as “Alamo Rentals” nor, to the best of Complainant’s knowledge, does it advertise under that name.

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 alamorentals.com domain name in bad faith pursuant to Policy par. 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 websites 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 par. 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).

As a result, Respondent’s registration and use of the domain name at issue falls squarely within the parameters of ICANN

Policy par. 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 par. 4(b)(iv) because respondent was using the confusingly similar domain to attract Internet users to its commercial website). 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 long standing and well-recognized rights and goodwill in its ALAMO mark(s) in connection with car rental services. The alamorentals.com domain name is confusingly similar to Complainant’s ALAMO mark(s) for car rental services. Respondent has no legitimate rights in the alamorentals.com domain name. Respondent has merely registered the alamorentals.com domain name to capitalize on the goodwill that Complainant has developed in its ALAMO mark(s) to drive Internet traffic inappropriately to another website 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.

PRINCIPAL REASONS FOR THE DECISION

In absence of arguments to the contrary and on the basis of the arguments and evidence submitted by the Complainant, the Panel established that the Complaint satisfied all three elements of paragraph 4(a) of the Policy for the following reasons:
(i) the disputed domain name includes the entire ALAMO trademark in which the Complainants has rights, combined with the generic term "rentals" and the top level domain ".com". The addition of the terms "rentals" to ALAMO does not take away the confusion, but rather enhances the confusion between the disputed domain name and the Complainant’s trademark as it identifies the main services for which the Complainant's trademarks are registered. According to the standard case law, the top level domain is disregarded for the likelihood of confusion test;
(ii) 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 was not commonly known under the disputed domain name and was not authorized to use the disputes domain name by the Complainant; and
(iii) the Panel is of the opinion that the disputed domain name has been registered and used in bad faith because the Panel considers it obvious that the Respondent must have had the ALAMO trademark, which is distinctive and unique for the registered services, in mind when it registered and used the disputed domain name for a parking site that diverts Internet users to, inter alia, websites of the Complainant's competitors.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ALAMORENTALS.COM**: Transferred

PANELLISTS

Name	**Alfred Meijboom**

DATE OF PANEL DECISION 2013-09-04

Publish the Decision