Decision for dispute CAC-UDRP-100650

Case number	CAC-UDRP-100650
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Domain names	itsalamo.com

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	Vanguard Trademark Holdings USA LLC

Complainant representative

Organization	Harness, Dickey & Pierce, PLC

Respondent

Organization	Above.com Domain Privacy

OTHER LEGAL PROCEEDINGS

None

IDENTIFICATION OF RIGHTS

The Complainant is owner of various registered ALAMO trademarks in the United States of America and Community trademarksfor, 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, itsalamo.com, is owned of record by Above.com Domain Privacy. The current record owner was Above.com Domain Privacy when the Complaint was notified. As requested in the notification of the Complaint, the Registrar, Above.com, Pty. Ltd., disclosed the identity of the owner of the domain name at issue. The Registrant is Transure Enterprise Ltd, domiciled in the Virgin Islands (British).

The Complainant did not amend his complaint, pursuant to the communication of this information.

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 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.

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.

The 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 the ALAMO mark for vehicle rental services in many foreign countries. Complainant is the record owner of the following registrations for the relevant marks in Australia:

Reg. No. 465728 registered from May 22, 1987
ALAMO in International Class 39 for "automotive renting and leasing services"

Reg. No. 521018 registered from October 13, 1989
ALAMO RENTACAR in International Class 39 for "automotive renting and leasing services"

Reg. No. 839992 registered from June 22, 2000
ALAMO & Design in International Class 39 for "vehicle leasing and rental services"

Complainant has also registered the ALAMO mark for vehicle rental services in the European Community. Complainant is the record owner of the following registration for the relevant mark in the European Community:

Reg. No. 001860592 registered September 16, 2002

ALAMO in International Classes 12, 16, 36, and 39 for “vehicles; apparatus for locomotion by land, air or water,” “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,” “financial and insurance services; financial and insurance management; valuation services; valuation management; relating online services; and related promotional and discount services,” and “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 the owner of the ALAMO mark which it licenses to Alamo Rent A Car. Started in 1974, Alamo Rent A Car ("Alamo") has locations in more than 42 countries worldwide, with more than 1,200 Alamo car rental locations throughout the United States, Canada, Mexico, the Caribbean, Latin America and Asia. Alamo started the car rental industry’s first real-time Internet booking engine in 1995 and the first online check-in system in 2005. Alamo is the largest car rental provider to international travelers visiting North America and is the "Official Rental Car" of Walt Disney World ® Resort and Disneyland® Resort. Complainant’s licensee, Alamo Rent A Car, operates an on-line car rental site at alamo.com.

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

The domain name, itsalamo.com, is confusingly similar to Complainant’s registered ALAMO mark. The domain name at issue fully incorporates Complainant’s ALAMO mark with the addition of the generic term “its” and the generic top level domain “.com.” A general rule under [ICANN] Policy par. 4(a)(i) is that a domain name is confusingly similar to third-party mark(s) where the domain name fully incorporates the mark(s) and simply adds additional words. It has been stated in numerous panel decisions that 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. Hürriyet Gazetecilik ve Matbaacılık Anonim Şirketi v. Moniker Privacy Services / Kemal Demircioglu, WIPO Case No. D2010-1941 (<hürriyetemik.com> and <hürriyetoto.com> are confusingly to HURRIYET); Bayerische Motoren Werke AG, Sauber Motorsport AG v. Petaluma Auto Works, WIPO Case No. D2005-0941 (bmwsauberf1.com is confusingly similar to BMW).

Previous panels have also concluded that the addition of a term such as “its” and a gTLD are insufficient in distinguishing a disputed domain name from a complainant’s mark. See Siemens AG v. Dorfeev, Kostantin, WIPO Case No. D2013-0923 (<itssiemens.com> is confusingly similar to the SIEMENS mark) and Lockheed Martin Corporation v. Ndolin Gendeng. Nat. Arb. Forum FA1354945 (December 7, 2010)(<itskunkworks.com> is confusingly similar to the SKUNK WORKS mark). See also Burberry Limited v. Byung-Choon Kim. WIPO Case No.D2005-0704 (<itsburberry.com> confusingly similar to BURBERRY mark). See also Nevada State Bank v. Modern Ltd. – Cayman Web Dev., FA 204063 (Nat. Arb. Forum Dec. 6, 2003) (“It has been established that the addition of a generic top-level domain is irrelevant when considering whether a domain name is identical or confusingly similar under the Policy.”).

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 itsalamo.com domain name. The itsalamo.com domain name resolves to a web page with various links, under the heading “Related Searches,” including, “Cheap One Way Car Rental” and “Car Rental Agencies.” Each of these links directs to a page with links to car rental websites including those of Complainant and its competitors.

In light of the long-standing use and registration of the ALAMO mark in connection with car rental services in the United States, the European Community and Australia, Respondent cannot have any legitimate rights in the itsalamo.com domain name in connection with a site that merely drives Internet traffic to other websites.

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 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 itsalamo.com. In fact, any claim in that regard is easily dismissed since the itsalamo.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, Alamo Rent A Car, operates an on-line car rental web site at alamo.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 itsalamo.com domain name when Internet users type in "itsalamo.com" trying to reach the Alamo Rent A Car web site or otherwise reach the web site at itsalamo.com. Such a use constitutes a lack of rights or legitimate interest in the disputed domain name 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 with the common pronoun "its", for a web site 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 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(s) as to the source, sponsorship, affiliation or endorsement of its web sites and the services offered at such web site.

The web page to which the itsalamo.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 itsalamo.com. Many Internet visitors to Respondent's web page at itsalamo.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 website.

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

Clearly Respondent does not operate a business known as "Its Alamo" 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 itsalamo.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 in connection with car rental services. The itsalamo.com domain name is confusingly similar to Complainant's ALAMO mark for car rental services. Respondent has no legitimate rights in the itsalamo.com domain name. Respondent has merely registered the itsalamo.com domain name to capitalize on the goodwill that Complainant has developed in its ALAMO mark 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 addition of the generic term "its" and the top level domain ".com". The addition of the terms "its" 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 focuses on the ALAMO trademark. 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. **ITSALAMO.COM**: Transferred

PANELLISTS

Name	**Marie Emmanuelle Haas**

DATE OF PANEL DECISION 2013-09-25

Publish the Decision