Decision for dispute CAC-UDRP-100742

Case number	CAC-UDRP-100742
Time of filing	2014-01-27 20:25:00
Domain names	alam.biz

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	Vanguard Trademark Holdings USA LLC

Complainant representative

Organization	Harness, Dickey & Pierce, PLC

Respondent

Organization	Domain Discreet Privacy Service

OTHER LEGAL PROCEEDINGS

N/A

IDENTIFICATION OF RIGHTS

The Complainant has to the satisfaction of the panel shown themselves to be the owner of the following protected rights:
Registered trade/service mark
Registered in several countries
Well-known/famous mark

which are then further enunciated in the reason for the decision below

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, alam.biz, is owned of record

by Domain Discreet Privacy Service. Once notified of this Complaint, the current record owner Domain Discreet Privacy Service will instruct its Registrar to disclose another entity as the owner of the domain name at issue.

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.

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

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

The Alamo Rent-A-Car (Alamo) car rental business began in 1974 in the United States. Alamo is an internationally recognized brand serving the daily rental needs of the leisure traveler throughout the United States, Canada, Mexico, the Caribbean, Latin America and Asia. Alamo expanded to Canada in 1989. Alamo opened its first car rental location in Europe in London in 1988 and Alamo has had a continuous presence in Europe for almost 25 years. Alamo continues to expand to new markets and Alamo expanded to Brazil in 2012 and Belize and the Turks and Caicos Islands in 2013.
Alamo was the first car rental company offering real time car rental reservation capabilities on the Internet in1996. Currently, Alamo operates web pages at www.alamo.com, www.alamo.ca, www.alamo.co.uk , www.alamo.de and www.alamo.mx that offer on-line vehicle rental reservation from all locations where Alamo operates.

Complainant, Vanguard Trademark Holdings USA LLC, owns registrations for the ALAMO mark in many countries throughout the world. For example, Complainant owns the following registrations for the ALAMO mark in Australia, Canada, the European Community, Hong Kong, Mexico, New Zealand, the United Kingdom and the United States:

Australian Registration No.465728 registered 01 June 1990 for ALAMO in Class 39 for automotive renting and leasing services.

Canadian Registration No.TMA402024 registered 28 August 1992 for ALAMO for automotive reservation services and automotive renting and leasing services.

European Community Registration registered 16 September 2002 for ALAMO in Class 39 for, inter alia, automobile rental and leasing services; vehicle rental, reservation and leasing services.

Hong Kong Registration No. 1994B00507 registered 02 March 1992 for ALAMO in Class 39 for vehicle rental and leasing services.

Mexican Registration No. 343510 registered 23 February 1988 for ALAMO in Class 39 for renting services and leasing of cars.

New Zealand Registration No. 182957 registered 26 September 1990 for ALAMO in Class 39 for automotive renting and leasing services.

United Kingdom Registration No. 1278578 registered 02 December 1988 in Class 39 for renting, leasing and hire services, all for vehicles.

United States Registration No. 1,097,722 registered 25 July 25 1978 for ALAMO in Class 39 for automotive renting and leasing services.

United States Registration No. 2,805,426 registered issued 13 January 2004 for ALAMO.COM in Class 39 for vehicle renting and reservation services; vehicle leasing services.

Based on the above, the applicant has established significant rights in ALAMO brand particularly in Australia, Canada, the European Community (including Germany and the United Kingdom), Hong Kong, Mexico and the United States.

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

Complainant's registrations and extensive use of the ALAMO mark for car rental services sufficiently establishes its right in the ALAMO mark pursuant to ICANN's Uniform Dispute Resolution Policy ("Policy") ¶ 4(a)(i). See Vivendi Universal Games v. XBNetVentures Inc., FA 198803 (Nat. Arb. Forum 11 November 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 domain name alam.biz is confusingly similar to Complainant's registered ALAMO mark because it consists of a common typographical error in which the person typing the word "Alamo" fails to include the final letter "o" combined with the generic top-level domain ".biz." This is generally referred to as "typo squatting" See The Vanguard Group, Inc. v. IQ Management Corporation, FA 328127 (Nat. Arb. Forum October 28, 2004) ("Furthermore, Respondent has engaged in typosquatting by registering a domain name that takes advantage of inadvertent errors made by Internet users….").

The incorporation of a common typo of a trademark is sufficient to establish that the domain name is identical or confusingly similar to a registered trademark. See Vanguard Trademark Holdings USA LLC v. Milan Kovac, FA 1394073 ("The Panel finds that the omission of a single letter does not remove the disputed domain name from the realm of confusing similarity. See Pfizer Inc. v. BargainName.com, D2005-0299 (WIPO Apr. 28, 2005) (holding that the <pfzer.com> domain name was confusingly similar to the complainant's PFIZER mark, as the respondent simply omitted the letter "i"); see also Myspace, Inc. v. Kang, FA 672160 (Nat. Arb. Forum June 19, 2006) (finding that the <myspce.com> domain name was confusingly similar to the complainant's MYSPACE mark and the slight difference in spelling did not reduce the confusing similarity)").

A number of other panels have also found that misspelling a mark by omitting a letter from a term in the mark does not avoid a finding of confusing similarity. See The Gap, Inc. v. Hanying Li, FA 1006001331209 (Nat. Arb. Forum July 29, 2010) (finding that <oldavy.com> domain name was confusingly similar to complainant's OLD NAVY mark); see also Hallelujah Acres, Inc. v. Manila Indus., Inc., FA 805029 (Nat. Arb. Forum Nov. 15, 2006) (holding that a respondent's <hacrs.com> domain name is confusingly similar to a complainant's HACRES mark because it merely omitted the letter "e" from the mark and added the generic top-level domain ".com").

The addition of a generic top level domain identifier is also insufficient to distinguish the alam.biz domain name from 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.").

Complainant's registrations listed above all pre-date the February, 2012 initial registration of the alam.biz domain name by many years.

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

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 alam.biz domain name in connection with a web page that has merely driven Internet traffic to other sites offering car rental services.

There is nothing to indicate that the Respondent has any rights or legitimate interests in the alam.biz domain name. On 17 December 2013, the alam.biz domain name resolved to a webpage with several lists of links. These lists of links are labeled, “Hot Favorites,” “Popular Links,” and “Top Links.” Each of these lists contained links to car rental websites including those of Complainant and its competitors. On 17 December 2013 the list of “Hot Favorites” was:

Alamo Car Hire
Car Rental Prices
Chauffeur Services
Rent a Sports Car
Airport Car Hire
Rent a Limo
Car Rental Discounts
One Way Car Rental

On 17 December 2013 the list of “Popular Links” was:

Luxury Coaches
Private Aircraft Charter
Coupons for Rental Cars
Group Travel Packages

On 17 December 2013 the list of “Top Links” was:

Sightseeing Tours
Guided Tours
Vacation Car Rental
Airport Shuttle Service

At present the web page at alam.biz states:

Register.com
Call us at (877) 454-5212
Sorry! This site is no longer available.
If you are the owner of this site, please call the number below and mention code WSN2240Z
Toll free within the U.S. & Canada: (877) 454-5212
Outside the U.S. & Canada: (902) 749-5312

In light of this historical use of the alamo.biz domain name and since the registration for alam.biz does not expire until 17 February 2015 there is nothing to prevent the owner of alam.biz from restoring the previous web pages at alam.biz.

Respondent’s use is neither a bona fide offering of goods or services pursuant to Policy ¶4(c)(i). 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 ¶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, 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).

None of the other factors considered as establishing Respondent's legitimate rights or interest in a domain name under the Policy are present here. There is nothing in the WHOIS records or on web page at alam.biz that give any indication that Respondent is known as "Alam." There is nothing to indicate that Respondent operates a business known as "Alam" or advertises under that name. 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 or confusingly similar to the ALAMO mark. Respondent is not making any legitimate noncommercial or fair use of "alam." 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 licensees operate online car rental websites at www.alamo.com, www.alamo.ca, www.alamo.co.uk , www.alamo.de and www.alamo.mx. A reasonable conclusion is that Respondent has no legitimate rights in the alam.biz domain name and is attempting to divert Internet traffic to its alam.biz domain name when Internet users are trying to reach one of the Alamo Rent A Car websites and such a use constitutes a lack of rights or legitimate interest in the alam.biz 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 website 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).

Once Complainant makes a prima facie case that Respondent lacks rights and legitimate interests in the alam.biz 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 (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. ICANN Rule 3(b)(ix)(3); ICANN Policy ¶ 4(c)(iii).

The facts of record suggest and support a finding that Respondent both registered and has used the alam.biz domain name in bad faith. Respondent's registration of a domain name that fully incorporates Complainant's ALAMO mark, merely misspelling it by deleting the "O" and adding the generic top-level domain ".biz, for a website that attempts to attract Internet users to Respondent's website, evidences a clear intent to trade upon the goodwill associated with Complainant's ALAMO mark for car rental services. Respondent has deliberately using a domain name that is confusingly similar to Complainant's mark to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation or endorsement of its website and the services offered at such websites.

The 17 December 2013 and 22 October 2012 webpages to which the alam.biz domain name resolved are "pay-per-click" webpages. They both contain online advertising that will provide someone, presumably the Respondent, with revenue from "click-through" fees from Internet users who find their way to the webpage at alam.biz. Many Internet visitors to Respondent's webpage at alam.biz will either not realize that they have been unwittingly directed to a website that has no affiliation to Alamo Rent A Car or not care that they are not at the "official" Alamo website and will "click through" to Alamo's website or websites of its competitors linked on Respondent's website.

The use of a business model based upon use of an infringing domain name to attract users to Respondent's website is clear evidence that Respondent registered and has used the alam.biz 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 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 ¶ 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 website without permission from that complainant).

Respondent's bad faith is also clearly evident from the fact that the webpage for alam.biz has included links to the real Alamo Rent A Car webpage and for which Alamo Rent A Car must pay a click-through fee if those links are used.

The fact that the alam.biz domain name is currently being used "passively" does not negate a finding of bad faith. Panels have consistently held that passive holding of domain names can, under certain circumstances, be considered bad faith use of the domain name. See Telstra Corporation Limited v. Nuclear Marshmallows, No. D2000-0003 (WIPO February 18, 2000) and Malayan Banking Berhad v. Beauty, Success & Truth International, D2008-1393 (WIPO December 8, 2008) ("As alleged by the Complainant, passive holding which is interspersed with sporadic or intermittent use of the disputed domain name, as in the present case, has also been found to be bad faith use. See Ferrari S.p.A. v. American Entertainment Group, Inc., WIPO Case No. D2004-0673.").

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

As a result, Respondent's registration and use of the alam.biz 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 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. The alam.biz domain name is confusingly similar to Complainant's ALAMO mark. Respondent has no legitimate rights in the alam.biz domain name. Respondent has merely registered and used the alam.biz 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.

Index of Annexes
Vanguard Trademark Holdings USA LLC v.
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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

Given that
1. the Complainant is the owner of trade mark alamo and long-term user of "alamo.com" and that

2. the Complainant is actively using alamo.com for a legitimate range of activities that can be ascertained and which are evidenced in the attachments to the Complaint

3. the Complainant owns several trademarks and communicates on the Internet through various websites worldwide; the main one is “alamo.com” , but the Complainant has also registered numerous domain names similar to trademark “alamo.com” All of these being registered and used by the Complainant long before 2012

and that

4. the disputed domain name alam.biz has been registered on 18/02/2012 and that

5. there appears to be no legitimate reason or corresponding rights for which the Respondent could have registered the disputed domain name and that

6. there appears to be no legitimate reason for which the disputed domain name is currently being used and that the Domain Name has been registered in bad faith. In this latter respect the Panel is following the reasoning as adopted in UDRP Case 100540 Remy Martin vs. Jiang Yuanha, and specifically the reasoning previously cited in Thiercelin vs. MEDICALECPO.com as expounded in Telstra Corporation Limited v. Nuclear Marshmallows (telstra.org) which construed "use" broadly to include inactive use. It stated: "[P]aragraph 4(b) recognises that inaction (e.g. passive holding) in relation to a domain name registration can, in certain circumstances, constitute a domain name being used in bad faith." Passive holding is explicitly alleged by the Complainant and has also been closely looked at by the Panel which finds that one of the critical factors in this case is the lack of evidence of good faith use. If one is in good faith when registering a domain name, then the intention is understandably to use it for the purposes of one's business or activity. If it remains unused for an unreasonable length of time then such registration is open to accusation of constituting „passive holding“. Irrespective of whether the domain name was registered before or after some of the Complainant's marks, the current holder of the domain name does not seem to have used it or currently be using it. In fairness to all parties concerned, this Panel would have been prepared to consider, say, a case of genuine identical names established in different jurisdictions which just happened to be identical by pure co-incidence. In this case however we received no evidence which may have persuaded one that such was the case and when a TLD lies un-used for a length of time and this lack of use is then un-contested, the allegation of bad faith specifically made in this case regarding „passive holding“ remains un-challenged so on the balance of probability one is inclined to accept it. The panellist personally tried loading the domain (several weeks or months after the Complainant claimed to have done so) but to no avail. Had one found a genuine business there or some form of appropriate use then this decision would have been made more difficult. As it is, with no apparent good faith use and in a no response situation it is reasonable to accept the Complainant's allegation since no contrary evidence was received nor could one independently detect any proof to the contrary.

The current passive use is only one indicator of bad faith. The Complainant has also submitted persuasive and unrefuted

evidence that previously and specifically on 17 December 2013 and 22 October 2012 webpages to which the alam.biz domain name resolved are “pay-per-click” webpages. They both contain online advertising that will provide someone, presumably the Respondent, with revenue from “click-through” fees from Internet users who find their way to the webpage at alam.biz. Many Internet visitors to Respondent’s webpage at alam.biz will either not realize that they have been unwittingly directed to a website that has no affiliation to Alamo Rent A Car or not care that they are not at the “official” Alamo website and will “click through” to Alamo’s website or websites of its competitors linked on Respondent’s website. This constitutes additional and sufficient evidence of bad faith insofar as it suggests that the intention of the holder of domain alam.biz simply wished to generate revenue from "click-through" fees of internet users searching for an official alamo web-site.

This behaviour is inconsistent with that of a Respondent who had registered a domain name in good faith with the intention of using it for a legitimate business and this turned out to be an accidental or co-incidental similarity to the domain names in which the Complainant has proven legitimate rights.

In the light of the above, denying the use of the contested domain name to the Complainant would unreasonably prevent the trademarks owner from using the rights conferred by his marks and it is therefore reasonable and appropriate within the letter and intent of the UDRP rules that the complaint is accepted and domain name transferred to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ALAM.BIZ**: Transferred

PANELLISTS

Name	**Joseph Cannataci**

DATE OF PANEL DECISION 2014-02-21

Publish the Decision