Decision for dispute CAC-UDRP-100787

Case number	CAC-UDRP-100787
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Domain names	12emeraldclub.com

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	Vanguard Trademark Holdings USA LLC

Complainant representative

Organization	Harness, Dickey & Pierce, PLC

Respondent

Organization	WHOISGUARD PROTECTED c/o Whoisguard, Inc.

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of different trademark registrations for "EMERALD CLUB". In particular Vanguard Trademark Holdings USA LLC owns:

- CTM Registration for "EMERALD CLUB" n. 190603 filed on April 1, 1996, registered on September 10, 1998 and duly renewed for services in class 39;

- U.S. Registration for "EMERALD CLUB" n. 1482719 filed on July 28, 1987, registered on March 29, 1988 and duly renewed for services in class 39;

- Panamanian Registration for "EMERALD CLUB" n. 47732 filed on September 12, 1988, registered on August 24, 1990 and duly renewed for services in class 39.

FACTUAL BACKGROUND

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

The Complainant, Vanguard Trademark Holdings USA LLC, is the owner of different registrations for "EMERALD CLUB" in International Class 39 “Automobile rental and reservation services". The "EMERALD CLUB" mark is licensed by its owner to National Car Rental operating companies.
Started in 1948, "EMERALD CLUB" is a premium, internationally recognized brand serving the daily rental needs of the frequent airport business traveller throughout the United States, Canada, Mexico, the Caribbean, Latin America (including Panama) and Asia. Emerald Club is the name of National Car Rental’s loyalty club that offers enhanced vehicle rental services to Emerald Club members. In particular, the Emerald Club web site corresponding to the domain name <emeraldclub.com> offers online car rentals to Emerald Club members.

The domain name <12emeraldclub.com> is confusingly similar to Complainant’s registered "EMERALD CLUB" mark since it fully incorporates Complainant’s "EMERALD CLUB" mark, merely (i) adding the numeral “12” at the beginning, (ii) eliminating the space between EMERALD and CLUB, and (iii) adding the generic top level domain identifier, “.com” at the end. 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. Adding a numeral such as “12” to the front of the <12emeraldclub.com> domain name does not distinguish it from Complainant’s "EMERALD CLUB" mark. Likewise, the removal of the space between EMERALD and CLUB in the <12emeraldclub.com> domain name does not distinguish it from Complainant’s "EMERALD CLUB" mark. The addition of a generic top level domain identifier is also insufficient to distinguish the <12emeraldclub.com> domain name from Complainant’s "EMERALD CLUB" mark.

Complainant’s U.S. registration for its "EMERALD CLUB" mark for car rental services was granted on March, 1988. This registration is twenty five years older with respect to the registration of the <12emeraldclub.com> domain name since the contested domain name was registered on July 2013. On 8 April 2014 the <12emeraldclub.com> domain name resolved to a web page with a list of “Related Links” consisting of links to web sites offering car rental services, including those of Complainant’s licensee and its competitors. In light of the long-standing use and registration of the "EMERALD CLUB" mark by Complainant, the Respondent cannot have any legitimate rights in the <12emeraldclub.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.

The Complainant has not licensed or otherwise permitted the Respondent to use its "EMERALD CLUB" mark in connection with car rental services or any other goods or services or to apply for any domain name incorporating the "EMERALD CLUB" mark. In addition, Respondent is clearly not making any legitimate noncommercial or fair use of <12emeraldclub.com>. The web page corresponding to <12emeraldclub.com> is a generic web page commonly used by domain name owners seeking to monetize their domain names through “click-through” fees. As previously indicated, it is clear that Respondent has no legitimate rights in the <12emeraldclub.com> domain name and, by the use of a domain name confusingly similar to Complainant’s "EMERALD CLUB" mark, is attempting to use the <12emeraldclub.com> domain name to drive Internet traffic to its web site, corresponding to the domain name in dispute, when Internet users are trying to reach the Complainant's web site. Such use constitutes a lack of rights or legitimate interest in the disputed domain name

The Respondent’s registration of a domain name that combines Complainant’s "EMERALD CLUB" mark with the numeral “12” 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 "EMERALD CLUB" mark for car rental services. The 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.

It cannot be disputed that the Complainant has long standing and well-recognized rights and goodwill in its "EMERALD CLUB" mark in connection with car rental services. The <12emeraldclub.com> domain name is confusingly similar to

Complainant’s EMERALD CLUB mark. The Respondent has no legitimate rights in the <12emeraldclub.com> domain name. The Respondent has merely registered the <12emeraldclub.com> domain name to capitalize on the goodwill that Complainant has developed in its "EMERALD CLUB" 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 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.

The disputed domain name <12emeraldclub.com> was registered on July 26, 2013 by using a privacy shield service "WHOISGUARD PROTECTED c/o Whoisguard, Inc.”. Following a request for registrar verification, the Registrar revealed the identity of the underlying registrant of the disputed domain name as Joycee Buenaflor, 16th Floor PBCOM Building, Makati, Metro Manila 0727.

Based on the decision No 100221 Vanguard Trademark Holdings USA LLC, v. WanZhongMedia c/o Wan Zhong, No. 100221, the Panel finds that the change of name of the registrant after notification of the Complaint will be disregarded.

PRINCIPAL REASONS FOR THE DECISION

A) The disputed domain name <12emeraldclub.com> combines three elements: (1) the wording "emeraldclub" preceded by (2) the numeral “12” and (3) the top level domain name .com The relevant comparison to be made is with the portion of the domain name "emeraldclub”. Actually, it is well established that the top-level domain name (i.e., “.com”) should be disregarded for this purpose (see, between many others, Playboy Enterprises International, Inc. v. John Taxiarchos, WIPO Case No. D2006 0561). Furthermore, the mere addition of the numeral “12” does not distinguish it from Complainant’s EMERALD CLUB mark. (see Microgaming Software Systems Limited v. WhoisGuard, WIPO Case. No. D2008-0613 in which it was stated that adding the numeral “7” before the domain name <microgaming.com> to make <7microgaming.com> did not add distinctive matter that would distinguish it from the claimant’s MICROGAMING mark). Finally the removal of the space between EMERALD and CLUB in the domain name in dispute is not relevant in order to find any possible dissimilarity between <12emeraldclub.com> and the older trademark "EMERALD CLUB".

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademarks "EMERALD CLUB".

B) The Complainant has long standing rights in the mark "EMERALD CLUB". 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 is not commonly known under the disputed domain name and as the Respondent was never authorized to use the domain name by the Complainant. The Respondent, in the absence of any response, has not shown any facts or element to justify prior rights or legitimate interests in the disputed domain name. The Complainant has not licenced or otherwise permitted the Respondent to use the Complainant's marks in the disputed domain name. On the basis of evidence submitted and in the absence of a Response the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

C) The Panel is of the opinion that the disputed domain name has been registered in bad faith because the Respondent was or must have been perfectly aware of the existence of "EMERALD CLUB" trademark, which is distinctive and unique for the registered services, when it registered the domain name <12emeraldclub.com>. Furthermore the Respondent is using the disputed domain name for a parking site that diverts Internet users to, inter alia, websites of the Complainant's competitors and licencees .The above represents an action taken by the Respondent to intentionally attract, for commercial gain, Internet users by creating a likelihood of confusion with Complainant’s "EMERALD CLUB" mark as to the source, sponsorship, affiliation, or endorsement of Respondent’s website. Previous Panels have held that using the domain name as a parking page with pay-per-click links to third party websites may be evidence of bad faith when the registrant is using the domain name in this manner because of the similarity to the Complainant’s trademark in the hope and expectation that the similarity will lead to confusion on the part of Internet users and results in an increased number of Internet users being drawn to that domain name parking page (MpireCorporation v. Michael Frey, WIPO Case No. D2009-0258; Paris Hilton v. Deepak Kumar, WIPO Case No. D2010-1364 and La Fee v. Pavol Icik, WIPO Case No. D2013-0526).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **12EMERALDCLUB.COM**: Transferred

PANELLISTS

Name	**Avv. Guido Maffei**

DATE OF PANEL DECISION 2014-05-28

Publish the Decision