Decision for dispute CAC-UDRP-100843

Case number	CAC-UDRP-100843
Time of filing	2014-08-11 15:28:44
Domain names	12emeraldclub.net

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	Vanguard Trademark Holdings USA LLC

Complainant representative

Organization	Harness, Dickey & Pierce, PLC

Respondent

Organization	WHOISGUARD, INC. c/o Whois Protected

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to 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 class39;
-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;
-Panamian 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 record owner of the different trade marks in different areas.
The Complainant, Vanguard Trademark Holdings USA, LLC, is the owner of the EMERALD CLUB mark which it licenses to the National Car Rental operating companies.

12emeraldclub.net, is owned of record by WHOISGUARD, INC. c/o WHOISGUARD PROTECTED, a domain privacy service.
The Complainant Vanguard Trademark Holdings USA, LLC, is the owner of the EMERALD CLUB mark which it licenses to the National Car Rental operating companies. Started in 1948, NATIONAL is a premium, internationally recognized brand serving the daily rental needs of the frequent airport business traveler throughout the United States, Canada, Mexico, the Caribbean, Latin America (including Panama), Asia, and the Pacific Rim. Emerald Club is the name of National Car Rental's loyalty club that offers enhanced vehicle rental services to Emerald Club members. The Emerald Club web page at emeraldclub.com offers online car rentals to EMERALD CLUB members".

It was discovered by the Complainant that the Respondent has registered the domain name "12emeraldclub.net" which is confusingly similar to Complainant's registered "EMERALD CLUB mark". The Complainant argues that disputed domain name "12emeraldclub.net " is confusingly similar to the trade mark and branded goods "EMERALD CLUB ". The Complainant believes that this is contrary to paragraph 4 (a) and 4 (b) of the Uniform Domain Name Dispute Resolution Policy ("UDRP").

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

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).

A) Complainant

Complainant, Vanguard Trademark Holdings USA LLC is the record owner of the following registration for the relevant mark in different areas:
12emeraldclub.net, is owned of record by WHOISGUARD, INC. c/o WHOISGUARD PROTECTED, a domain privacy service.
Complainant does not believe that it should be required to file an amended complaint once the Registrar "draws back the curtain" to reveal the real owner of the domain name at issue.
Complainant, Vanguard Trademark Holdings USA, LLC, is the owner of the EMERALD CLUB mark which it licenses to the National Car Rental operating companies
Complainant's registrations and use of the EMERALD CLUB mark for car rental services sufficiently establishes its right in the mark pursuant to ICANN's Uniform Dispute Resolution Policy ("Policy") 4(a)(i).
The domain name 12emeraldclub.net is confusingly similar to Complainant's registered EMERALD CLUB mark. The 12emeraldclub.net domain name fully incorporates Complainant's EMERALD CLUB mark, merely adding the numeral "12" at the beginning, eliminating the space between EMERALD and CLUB, and adding the generic top level domain identifier, ".net" 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.net domain name does not distinguish it from Complainant's EMERALD CLUB mark.
The Respondent has no rights or legitimate interests in the 12emeraldclub.net domain name. On 03 August 2014 the 12emeraldclub.net 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.:
National Rent a Car
National Emerald Club
National Car Hire
Emerald Club Car Rental
Anfi Emerald Club Tauro
Car Hire Gran Canaria
Alamo Car Rental Claims
Car Rental Companys
Cheapest Car Hire London

Car Rental Car Renta
The web site to which the 12emeraldclub.net domain name resolves gives no indication that Respondent is known as, operating a business as, or advertising as “12 Emerald Club.” The WHOIS record is the sole piece of relevant evidence when determining what a respondent is commonly known.
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, the Respondent is clearly not making any legitimate noncommercial or fair use of 12emeraldclub.net. In fact, any claim in that regard is easily dismissed since the 12emeraldclub.net 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.
The facts of record suggest and support a finding that Respondent both registered and is using the 12emeraldclub.net domain name in bad faith. 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. 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.
On these bases, 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.net domain name is confusingly similar to Complainant’s EMERALD CLUB mark. Respondent has no legitimate rights in the 12emeraldclub.net domain name. Respondent has merely registered the 12emeraldclub.net 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.
The Complainant concludes that the Respondent has registered and is using the disputed domain name in bad faith.

B) Respondent

The Respondent did not respond to the Complainant at all even it is obliged to do so.

RIGHTS

The Compainant 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

1. The main issues under UDRP are whether:

i. the domain names are identical or confusingly similar to a domain name or a trademark or service mark in which the Complainant has rights; and
ii. the Respondent has no rights or legitimate interests with respect to the domain names; and
iii. the domain names has been registered and is being used in bad faith.

2. The Panel reviewed carefully all documents provided by the Complainant. The Panel also visited all available websites and public information concerning disputed domain name, namely the WHOIS database and related trademark register databases.

3. The Uniform Domain Names Dispute Resolution Policy in its Article 4 defines what has to be understood as an evidence of the registration and use of the domain name in bad faith.

Namely Article 4, letter b), para. iv) has to be considered in this case.

The Rules for Uniform Domain Name Dispute Resolution Policy clearly says in its Article 3 that any person or entity may initiate an administrative proceeding by submitting a Complaint in accordance with the Policy describing according to para (ix), sub para (iii) why the domain name(s) should be considered as having been registered and being used in bad faith.

4. The panel therefore came to the following conclusions:

a) The Complainant has clearly proven that he has long standing rights in the mark “EMERALD CLUB”. The Complainant provided prima facie evidence that the Respondent does not have rights or legitimate interest 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 Complainant´s marks in the disputed domain name. On the basis of evidence submitted and in the absence of Response the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.
Domain names to be identical or confusingly similar

b) It is also clear and proven that there is a similarity between properly registered and used domain names and trademarks of the Complainant and the disputed domain name as to the misspelling/typosquatting; phonetic similarity, optical similarity; conceptual/intellectual similarity. It is constantly decided not only in proceedings at this body bud also at WIPO that adding a letter, number, any figure is not enough to make a distinction to another original trade mark and/or domain name.

Respondent not having rights or legitimate interest with respect to the disputed domain name

c) It has to be stressed that it was proven by documents delivered by the Complainant and from the factual situation on the internet that there is no legitimate interest of the Respondent in the disputed domain name.

Domain name has been registered and is used in bad faith

d) It was proven that the Respondent has registered the disputed domain name only after the confusingly similar domain names of the Complainant has been registered and properly used long time in business.

e) It is therefore clear that there is a high probability of a speculative behaving of the Respondent. On top of that it was not proven that the owner of the disputed domain name is active in business and therefore this based on the previous decision and practice of the arbitrators may lead to the conclusion that the use of this domain name is speculative by the Respondent.

f) From the IP law perspective it is clear that the similar confusing domain names were used by the Complainant for a long time before the disputed domain name was registered and used by the Respondent.

g) Therefore it has to be concluded that the Respondent has registered/acquired the disputed domain name primarily for the purpose of his own benefit when disrupting the business of the Complainant and therefore the Respondent is using the domain name in a bad faith. The domain name shall be transferred to the Complainant without a delay.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **12EMERALDCLUB.NET**: Transferred

PANELLISTS

Name	**Vít Horáček**

DATE OF PANEL DECISION 2014-09-18

Publish the Decision