# Decision for dispute CAC-UDRP-100988

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| Case number | CAC-UDRP-100988 |
| Time of filing | 2015-05-06 14:13:45 |
| Domain names | emerldclub.com |

## Case administrator

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| Name | Lada Válková (Case admin) |

## Complainant

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| Organization | Vanguard Trademark Holdings USA, LLC |

## Complainant representative

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| Organization | Harness, Dickey & Pierce, PLC |

## Respondent

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| Organization | WHOIS Privacy Services Pty Ltd c/o Domain Hostmaster, Customer ID: 51460149787593 |

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings pending or decided between the same parties and relating to the disputed domain name.

IDENTIFICATION OF RIGHTS

Complainant has proved, to the satisfaction of the Panel, ownership of several EMERALD CLUB trademarks designating car rental services (class 39), including:

- Community trademark Reg. No. 190603 registered on September 10, 1998
- Trademark Reg. No. 1,482,719 registered on March 29, 1988 in the United States of America
- Trademark Reg. No. 746517 registered on October 16, 1997 in Australia

In addition, Complainant holds the domain name <emeraldclub.com>, registered on June 19, 1998, which resolves to the National's EMERALD CLUB login page.

FACTUAL BACKGROUND

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

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

Complainant, Vanguard Trademark Holdings USA, LLC, is the owner of the EMERALD CLUB mark which it licenses to 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, 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 offers online car rentals to EMERALD CLUB members. The domain name emeraldclub.com resolves to National's EMERALD CLUB login page.

THE PARTIES' CONTENTIONS

COMPLAINANT

Complainant claims that its registrations and extensive use of the EMERALD CLUB mark for car rental services sufficiently establish its right in the mark pursuant to paragraph 4(a)(i) of the Policy.

According to the Complainant, the disputed domain name emerldclub.com is confusingly similar to Complainant's registered EMERALD CLUB mark. The emerldclub.com domain name fully incorporates Complainant's EMERALD CLUB mark, merely deleting the "A" in EMERALD to mimic a common typographical error, removing the spaces between EMERALD and CLUB, and adding the generic top level domain identifier, ".com."

Furthermore Complainant contends its registrations for the EMERALD CLUB mark pre-date Respondent's ownership of the emerldclub.com domain by between thirteen and twenty-two years.

Complainant asserts Respondent has no rights or legitimate interests in the emerldclub.com domain name. On April 29, 2015, the web site at the emerldclub.com domain name resolved to a web page with a list of "Related Links" which contained links to web sites offering car rental services, including those of Complainant and its competitors.

In light of the long-standing use and registration of the EMERALD CLUB mark by Complainant in connection with car rental services, Respondent cannot have any legitimate rights in the emerldclub.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 and its competitors.

Respondent's use is neither a bona fide offering of goods or services pursuant to paragraph 4(c)(i) of the Policy nor a legitimate noncommercial or fair use pursuant to paragraph 4(c)(iii) of the Policy.

The WHOIS record lists "WHOIS Privacy Services Pty Ltd c/o Domain Hostmaster, Customer ID: 51460149787593" as the registrant for the emerldclub.com domain name. Neither the WHOIS record nor the web site to which the emerldclub.com domain name resolves gives any indication that Respondent is known as, operating a business as, or advertising as "Emerld Club."

Complainant has not licensed or otherwise permitted 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 emerldclub.com. In fact, any claim in that regard is easily dismissed since the emerldclub.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.

Finally, according to the Complainant the facts of record clearly support a finding that Respondent both registered and is using the emerldclub.com domain name in bad faith. Respondent's registration of a domain name that is merely a typographical error of Complainant's EMERALD CLUB mark 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. The web page at emerldclub.com also contains a link to Complainant's web site under its "Related Links" making confusion all the more likely.

The web page to which the emerldclub.com domain name resolves is a "pay-per-click" web page. It contains online advertising that will provide someone, presumably the Respondent, with revenue from "click-through" fees from Internet users who find their way to the web page at emerldclub.com. At least some Internet visitors to Respondent's web page at emerldclub.com will either not realize that they have been unwittingly directed to a web site that has no affiliation to Complainant or not care that they are not at Complainant's "official" web site and will "click through" the links provided by Respondent.

Respondent's bad faith is also clearly evident from the fact that the web page for emerldclub.com includes a link to the real EMERALD CLUB web page, with EMERALD CLUB spelled correctly, and for which National must pay a click-through fee if that link is used.

The emerldclub.com domain name can be considered typosquatting and thus evidence of Respondent's bad faith in registering and using the emerldclub.com domain name. Typosquatting points to the conclusion that Respondent was fully aware of Complainant and Complainant's rights in its mark prior to registering the emerldclub.com domain name. This is further proof of Respondent's bad faith registration and use of the emerldclub.com domain name.

The web page at emerldclub.com contains a "disclaimer" that the links on it are served automatically by third parties and that the domain owner and service provider have no relationship with the advertisers. Respondent may claim ignorance regarding the use being made of the emerldclub.com domain name. However, under the UDRP, absent a showing of some good faith attempt prior to receiving the UDRP complaint, to stop the inclusion of advertising or links which profit from trading on third-party trademarks, a domain name owner will be deemed responsible for content appearing on the web site at the domain names they own. This is true even if the owner is not exercising direct control over such content - for example, in the case of advertising links appearing on an "automatically" generated basis. No matter how it is viewed, the very essence of setting up the emerldclub.com web site must be that it does result in commercial gain from Internet users accessing other web sites through the emerldclub.com web site.

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.

At the time of the commencement of this proceeding, the owner of the record of the disputed domain name was WHOIS Privacy Services Pty Ltd c/o Domain Hostmaster, Customer ID: 51460149787593. Once notified of the Complaint, Registrar

disclosed another owner for the disputed domain name Lisa Katz. Complainant preferred not to change the Respondent's name in the Complaint based on the arguments of CAC decision No. 100221. Accordingly, the Panel finds the CAC followed the correct procedure in accordance with the Policy and the Rules and accepts the request of Complainant that the Complaint proceeds against WHOIS Privacy Services Pty Ltd c/o Domain Hostmaster, Customer ID: 51460149787593.

Furthermore, on May 12 and 13, 2015, the CAC received emails from Respondent claiming it is impossible for them to access the online platform. However, the Respondent accessed the online platform on May 29, 2015. Therefore, the Panel is of the opinion that the Respondent was given a fair chance to respond.

PRINCIPAL REASONS FOR THE DECISION

(1) The disputed domain name is confusingly similar to the trademark EMERALD CLUB to which Complainant has rights pursuant to paragraph 4(a)(i) of the Policy.

It results from the aforementioned trademark registrations and the submitted evidence of extensive use of the said trademarks in relation with car rental services that Complainant has rights in "EMERALD CLUB".

The disputed domain name <emerldclub.com> fully incorporates the sign EMERALD CLUB, merely omitting the letter "A" in EMERALD to mimic a common typographical error (see Geocities v. geociies.com, WIPO Case No. D2000-0326: "Evidence has been provided that demonstrates that third parties have made typographical errors that led to the user mistakenly being directed to the Respondent's web site due to the misspelling of the term").

Neither the omission of the letter "A" or of the space between the words "emerld" and "club", nor the addition of the generic top-level domain (gTLD) ".com" serve to prevent any likelihood of confusion (see F. Hoffmann-La Roche AG v. Macalve e-dominios S.A., WIPO Case No. D2006-0451).

Therefore, the Panel finds that the disputed domain name is confusingly similar to Complainant's trademark pursuant to paragraph 4(a)(i) of the Policy.

(2) Respondent has no rights or legitimate interest in the disputed domain name pursuant to paragraph 4(a)(ii) of the Policy.

Complainant contends that the WHOIS record, which can be considered as providing pertinent information (see Disney Enterprises, Inc. v. online No. 1 / OS1, NAF Claim No. 1512060), demonstrates that Respondent has never been commonly known by the disputed domain name.

Further, Complainant has never granted any license or other authorization to Respondent to use the EMERALD CLUB trademark or to register a corresponding domain name.

Therefore, pursuant to paragraph 4(c)(ii) of the Policy, Respondent has never been commonly known by the disputed domain name to which it has not acquired any right.

The disputed domain name resolves to a website displaying commercial links to other websites offering car rental services, including those of Complainant and its competitors.

The Panel finds that Complainant has made a prima facie case that Respondent is thus using the disputed domain name for the purpose of benefiting from the goodwill of Complainant's trademark by driving internet traffic to its website, misleading the users into believing that they are actually accessing Complainant's website, and eventually monetizing the disputed domain name through a "pay-per-click" web page.

As the Respondent failed to object to the above-mentioned Complainant's allegations, the Panel concluded that the aforementioned assertions are true.

In these circumstances, the Panel finds that Respondent's use of the disputed domain name does not amount to a bona fide

offering of goods or services pursuant to paragraph 4(c)(i) of the Policy.

Further, the Panel finds that Complainant has made a prima facie case that Respondent is not making a legitimate noncommercial or fair use of the disputed domain name, but on the contrary is showing intent for commercial gain to misleadingly divert consumers or tarnish Complainant's trademark, pursuant to paragraph 4(c)(iii) of the Policy (see MSNBC Cable, LLC v. Tysys.com, WIPO Case No. D2000-1204).

Therefore, the Panel concludes that Respondent lacks rights and legitimate interest in the disputed domain name pursuant to paragraph 4(a)(ii) of the Policy.

(3) Respondent has registered and uses the disputed domain name in bad faith pursuant to paragraph 4(a)(iii) of the Policy.

Complainant has proved that Respondent's domain name is a mere typographical error of Complainant's trademark and domain name <emeraldclub.com> made in order to lead the users to believe that they are accessing Complainant's website, and thus to benefit from the goodwill of the trademark at issue (see Geocities v. geociies.com, supra: " the evidence supports Complainant's assertion that the apparent purpose of the misdirection is to create commercial opportunities for the Respondent, either in the form of payment for access to the Respondent's web-sites, or through sales of products offered for sale on those web-sites by the Respondent").

The said website resolves to commercial links to other websites offering car rental services, including those of Complainant and its competitors.

Further, pursuant to paragraph 4(b)(iv) of the Policy, the Panel finds that Respondent is clearly attempting to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of its website and the products or services offered at such on its website (see G.D. Searle & Co. v. Celebrex Drugstore, NAF Claim No. 123933).

This type of behaviour, defined as typosquatting, shows that Respondent knew about Complainant's trademarks at the time it registered the disputed domain name, which thus clearly demonstrates bad faith registration (see Macy's Inc. and its subsidiary Macy's West Stores, Inc. Stores Inc. v. David Ghou, NAF Claim No. FA1552898).

Therefore, on the basis of the foregoing elements, the Panel concludes that Respondent has registered and uses the disputed domain name in bad faith pursuant to paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **EMERLDCLUB.COM**: Transferred

## PANELLISTS

| Name | **Nathalie Dreyfus** |
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DATE OF PANEL DECISION 2015-06-16

Publish the Decision