

.nz Dispute Resolution Service

DRS Reference: 1121

Vanguard Trademark Holdings USA, LLC v Li Yu

Key words -

Identical or similar trade mark or name

Registered mark - well-known mark - identical

Unfair registration

Unfair registration – unfair use – offer to sell, rent or otherwise transfer – likely to confuse, mislead or deceive - pattern of registration

1. Parties

Complainant:

Vanguard Trademark Holdings USA, LLC

600 Corporate Park Drive

St. Louis, Missouri

UNITED STATES OF AMERICA

Represented by: David Haarz, Harness, Dickey & Pierce, PLC

Respondent:

Li Yu

Tanggou town North-west No. 3

Shuyang, Suqian

CHINA

2. Domain Name

2.1 <alamo.nz> (the “Domain Name”)

3. Procedural history

3.1 The Complaint was lodged on 2 September 2015. The Domain Name Commission (DNC) notified the Respondent of the validated Complaint on 4 September 2015. The Domain was locked on 3 September 2015, preventing any changes to the record until the conclusion of these proceedings.

3.2 No Response was received.

3.3 The Complainant paid the DNC the appropriate fee on 1 October 2015 for a decision of an Expert, pursuant to Paragraph 9 of the .nz Dispute Resolution Service Policy ("the Policy").

3.4 Clive Elliott QC, the undersigned, ("the Expert") confirmed to the DNC on 6 October 2015 that he knew of no reason why he could not properly accept the invitation to act as expert in this case and that he knew of no matters which ought to be drawn to the attention of the parties, which might appear to call into question his independence and/or impartiality.

4. Factual background

4.1 The Respondent registered the Domain Name on 8 April 2015.

5. Parties' contentions

5.1 Complainant

5.1.1 Complainant asserts that it is the owner of the ALAMO mark, which it licenses to Alamo Rent A Car and other operating entities ("Alamo").

5.1.2 Complainant states that Alamo commenced business in 1974 and is the largest vehicle rental provider to international travellers visiting North America; and that its brand is internationally recognised; serving the daily vehicle rental needs throughout the United States, Canada, Mexico, the Caribbean, Latin America, Asia and the Pacific Rim.

5.1.3 Complainant also states that Alamo operates an online vehicle rental site at <alamo.com>, which directs to the Alamo home page. Complainant submits that the Domain Name also directs to the Alamo home page.

5.1.4 Complainant advises that it has registered its ALAMO mark in many countries throughout the world. This includes New Zealand. Complainant claims to have registered the ALAMO mark in New Zealand as follows:

- Reg. No. 182957 issued September 26, 1990, ALAMO in International Class 39 for "automotive renting and leasing services"
- Reg. No. 172291 issued October 26, 1990 ALAMO in International Class 16 for "printed matter used in connection with renting and leasing of automobiles and trucks"

5.1.5 Complainant asserts that the Domain Name is identical to its ALAMO mark, other than the addition of the ".nz" country code top-level domain, and that Respondent has no rights or legitimate interests in the Domain Name. Complainant further asserts that Respondent has registered the Domain Name to take unfair advantage of the goodwill Complainant has built in its ALAMO mark, and such registration and use is unfairly detrimental to Complainant's rights.

5.1.6 Complainant notes that on July 29, 2015 the Domain Name resolved to a web page with a list of "Related Links" consisting of links to websites offering vehicle rental services, including those of Complainant and its competitors. The Domain Name web page also makes a generalized offer to sell the

Domain Name by stating at the top of the page: "*The domain Alamo.nz is listed for sale. Click here to inquire about this domain name.*"

- 5.1.7 Complainant asserts that as a global provider of vehicle rental services it operates in many countries around the world and accordingly, customers expect it to operate ALAMO vehicle rental websites with many different country-code top level domains. It submits that Respondent's registration and use of the Domain Name is likely to confuse, mislead, and/or deceive people or businesses into believing that the Domain Name is authorized and operated by Alamo or that Alamo does not offer vehicle rental services to residents of New Zealand.
- 5.1.8 It is noted by Complainant that Respondent has been the subject of a previous complaint under the .nz Dispute Resolution Policy. See *Missoni SPA v. Li Yu*, DRS Ref. 784 (.nz Dispute Resolution Service July 11, 2012). In that case, Respondent combined the MISSONI mark with the ".co.nz" second and country code level domains to create the missoni.co.nz domain name. The Expert held that, "[i]n the present case, the inference is inescapable that the Respondent is using the disputed domain name in a way that is likely to confuse or mislead internet users into believing that the disputed domain name is registered to, operated or authorized by or otherwise connected with the Complainant." The Expert found that the Respondent was, "clearly engaging in cybersquatting" and that the Respondent, "had no right to register this name."
- 5.1.9 Complainant contends that the facts of the *Missoni* case are nearly identical to the present case, and that while one case is not enough to create a presumption, the *Missoni* case suggests that Respondent has intentionally registered the Domain Name because it is confusingly similar to Complainant's ALAMO mark and that Respondent is using that confusing similarity to unfairly take advantage of Complainant.
- 5.1.10 Complainant further contends that Respondent's use of the Domain Name is not a genuine offering of goods or services as there is nothing in the WHOIS record for the Domain Name or the <alamo.nz> web page to indicate that Respondent is commonly known as 'Alamo' or that Respondent has any rights in a trademark containing 'Alamo' or similar to 'Alamo'. In addition, Respondent's use is not a legitimate non-commercial or fair use of the Domain Name.
- 5.1.11 Complainant argues that its ALAMO mark is not descriptive or generic for vehicle rental services and Respondent's use of the Domain Name is not consistent with any fair descriptive or generic use of ALAMO. Complainant has never licensed or otherwise permitted Respondent to use its ALAMO mark or to apply for any domain name incorporating the ALAMO mark.
- 5.1.12 Finally, Complainant submits that on the balance of the probabilities, registration of the Domain Name by the Respondent is unfair in that it takes unfair advantage of and is detrimental to Complainant's long - established rights in its ALAMO mark.

5.2 Respondent

- 5.2.1 No Response was received.

6. Discussion and findings

6.1 The dispute is governed by the Policy issued by the Domain Name Commission. The relevant portions of the Policy for present purposes are as follows:

“3. Definitions ...

Unfair Registration means a Domain Name which either:

- (i) was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; OR
- (ii) has been, or is likely to be used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.

4. Dispute Resolution Service

4.1 This Policy and Procedure applies to Respondents when a Complainant asserts to the DNC according to the Procedure that:

4.1.1 The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and

4.1.1 The Domain Name, in the hands of Respondent, is an Unfair Registration.

5. Evidence of Unfair Registration

5.1 A non-exhaustive list of factors which may be evidence that the Domain Name is an Unfair Registration is set out in paragraphs 5.1.1 - 5.1.5:

5.1.1 Circumstances indicating the Respondent has registered or otherwise acquired the Domain Name primarily:

- (a) for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;
- (b) as a blocking registration against a name or mark in which the Complainant has rights; or
- (c) for the purpose of unfairly disrupting the business of the Complainant; or

5.1.2 Circumstances demonstrating that the Respondent is using the Domain Name in a way which is likely to confuse, mislead or deceive people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant;

5.1.3 The Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under.nz or otherwise) which correspond to well known names or trade marks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern;

5.1.4 The Complainant can demonstrate that the Respondent has knowingly given false contact details to a Registrar and/or to the DNC; or

5.1.5 The Domain Name was registered arising out of a relationship between the Complainant and the Respondent, and the circumstances indicate that it was intended by both the Complainant and the Respondent that the Complainant would be entered in the Register as the Registrant of the Domain Name;”

6.2 In order to support a complaint Complainant must satisfy three elements:

6.2.1 Rights in respect of a name or mark (para 4.1.1);

6.2.2 Identity or similarity between that name or mark and the Domain Name (para 4.1.1); and

6.2.3 Unfair registration in the hands of Respondent (para 4.1.2).

These are dealt with below.

7 Decision

7.1 **Rights in respect of a name or mark (Para 4.1.1 of Policy)**

- 7.1.1 In terms of assessing whether Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name the Expert first has to consider the wording of the Policy.
- 7.1.2 The expression "Rights" is referred to in the definition of "Unfair Registration" in paragraph 3 of the Policy and is directed to a Domain Name which "took unfair advantage of or was unfairly detrimental to Complainant's Rights" in some way. The primary question is whether some disadvantage or detriment occurs vis-a-vis Complainant's Rights.
- 7.1.3 Pursuant to paragraph 3 of the Policy Complainant must establish the requisite Rights in order to establish that some form of disadvantage or detriment is likely to occur through the existence or use of the Domain Names by Respondent.
- 7.1.4 Complainant asserts that it is the owner of the ALAMO mark ("Complainant's Trade Mark"), which it licenses to Alamo Rent A Car and other operating entities ("Alamo"). Alamo commenced business in 1974. It is the largest vehicle rental provider to international travellers visiting North America. Its brand is recognised in a large number of countries around the world. Further, Complainant relies on its registration of the ALAMO trade mark in many countries throughout the world and in particular on trade mark registration numbers 182957 and 172291 in New Zealand.
- 7.1.5 Respondent does not dispute these assertions. On this basis, the Expert is satisfied that Complainant has established sufficient Rights in respect of a name or mark which is identical or similar to the Domain Name.

7.2 Identity or similarity (Para 4.1.1 of Policy)

- 7.2.1 Complainant's Trade Mark and the Domain Name both contain, as an essential part, the word "Alamo". Complainant's Trade Mark and the Domain Name are for all intents and purposes the same. This ground is thus established.

7.3 Unfair registration (Para 4.1.2 of Policy)

- 7.3.1 As noted in paragraph 6.1 above, a number of factors may be taken into account as evidence that the Domain Name is an Unfair Registration. This requires the Expert to be satisfied that Respondent has registered or otherwise acquired the Domain Name primarily for certain purposes.
- 7.3.2 The essential question under Rule 4.1.2 of the Policy is whether the Domain Name, in the hands of Respondent is an Unfair Registration. Complainant's primary complaint is that Respondent is using the Domain Name in a way which is likely to confuse, mislead or deceive people or businesses. Complainant submits that Respondent is using the Domain Name in a way that is likely to lead people into believing that the Domain Name is registered to, operated or authorised by Complainant.

- 7.3.3 Complainant alleges that on July 29, 2015 the Domain Name resolved to a web page which linked to websites offering vehicle rental services, including those of Complainant and its competitors. Further, it is alleged that the said web page made a generalized offer to sell the Domain Name. None of this is disputed by Respondent.
- 7.3.4 Complainant submits that as a global provider of vehicle rental services customers expect it to operate ALAMO vehicle rental websites around the world. Complainant further submits that Respondent's registration and use of the Domain Name is likely to confuse, mislead, and/or deceive people or businesses into believing that the Domain Name is authorized and operated by Alamo or conversely that Alamo does not offer vehicle rental services to residents of New Zealand.
- 7.3.5 The Expert is satisfied that the way in which Respondent has used the Domain Name wrongly suggests Respondent's website or webpage is somehow approved by, or associated or connected with Complainant or alternatively that it is not associated or connected with Complainant, but is run by an un-connected entity. In the latter situation, this would tend to suggest that other entities in this region are entitled to use Complainant's Trade Mark (with Complainant's express or tacit approval). Either way, a misleading and potentially damaging impression is likely to arise.
- 7.3.6 The Expert is required, pursuant to paragraph 6 of the Policy, to take into account a range of factors which may indicate that the Domain Name is not in fact an Unfair Registration. However, given that Respondent has failed to file a Response and explain its position and attempt to justify the registration and use of the Domain Name in the aforesaid manner, the Expert is not able to give any real weight to these considerations.

8 Decision

- 8.1 Complainant has thus established each part of paragraph 4.1 of the Policy and is entitled to the relief sought. In the result, the Expert orders that the Domain Name be transferred from Respondent to Complainant.

Place of decision Auckland

Date October 22, 2015

Expert Name Clive Elliott QC



Signature