

.nz Dispute Resolution Service

DRS Reference: 1122

Key words

Domain name – enterpriserentacar.nz

Identical or similar trade mark or name – registered mark – identical – similar

Unfair Registration – unfair registration – unfair use – offer to sell, rent or otherwise transfer – likely to confuse, mislead or deceive – no use for genuine offering of goods or services – no legitimate non-commercial or fair use – respondent having no connection with name or registered mark

Procedure – remedies – transfer

1. Parties

Complainant:

Enterprise Holdings, Inc
600 Corporate Park Dr
St Louis, Missouri
UNITED STATES OF AMERICA

Respondent:

Bai Xiqing
Fuli JiaYuan
19 Zhuang 302 Shi
Huzhou, Zhejiang
CHINA

2. Domain Name

enterpriserentacar.nz ("the Domain Name")

3. Procedural history

- 3.1 The Complaint was lodged by the Complainant's representative (David Haarz of Harness, Dickey & Pierce, PLC at Reston, Virginia, United States of America) on 2 September 2015. The domain was locked on 3 September 2015, preventing any changes to the record until the conclusion of this case. The .nz Domain Name Commission ("DNC")¹ notified the Respondent of the validated Complaint by letter dated 4 September 2015.

¹ Domain Name Commission Limited is a company wholly-owned by InternetNZ (Internet New Zealand Inc) responsible for the day-to-day oversight of the .nz domain name registration and management system.

- 3.2 The letter from the DNC to the Respondent dated 4 September 2015 attached a copy of the Complaint and a copy of the DNC Dispute Resolution Policy (“the Policy”)². The letter advised the Respondent as follows:

In accordance with the Procedure, you have 15 working days, ie until 25 September 2015 to respond to the complaint. In order to be valid, your response must comply with the Procedure, and must be received by the DNC in both hard copy and electronic form.

If you respond within the deadline, the Complainant will be given an opportunity to submit a written reply, and the matter will then be referred for mediation. The Domain Name Commission makes no charge for this service. If mediation is not successful, the matter may be referred to an independent expert for a decision.

Please note that no decision has been made at this stage.

Do not ignore this letter. If you do not submit a response by the deadline, this matter may be referred to an independent expert for a decision without further reference to you, which may result in the transfer, suspension or cancellation of the domain name.

- 3.3 The Respondent did not submit a Response to the Complaint. By letter dated 29 September 2015, the DNC advised the Respondent that the Complaint would be referred to an independent expert for a decision if the Complainant paid the appropriate fees by 13 October 2015. The Complainant paid the appropriate fees on 2 October 2015.
- 3.4 Terence Stapleton QC, the undersigned, confirmed to the DNC 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. On 6 October 2015, Mr Stapleton was appointed to act as the independent expert in this case (“the Expert”) pursuant to paragraph 9 of the Policy.

4. Factual background

- 4.1 The Complainant’s vehicle rental business began in the United States of America in 1973. The Complainant’s business is now one of the largest vehicle rental businesses in the world with 2012 revenues of approximately US\$12 billion. The Complainant and its affiliated companies employ more than 74,000 people and own almost 1.3 million cars and trucks worldwide.
- 4.2 The Complainant’s ENTERPRISE RENT-A-CAR mark is an internationally recognised brand serving the daily vehicle rental needs of customers, including both business and holiday travellers, worldwide. Anyone with internet access can access the Complainant’s online vehicle rental sites and make arrangements to hire a rental vehicle from the Complainant in many countries around the world.

² Words beginning with upper case letters in this decision indicate terms defined in paragraph 3 of the Policy.

- 4.3 The Complainant has registered its ENTERPRISE RENT-A-CAR mark in many countries around the world. The Complainant is the owner of New Zealand Trade Mark registration number 784001 ENTERPRISE RENT-A-CAR (Combined) in class 39 in relation to vehicle rental and leasing services and reservation services for the rental and leasing of vehicles (“the Complainant’s trade mark”).
- 4.4 The Complainant’s trade mark has a deemed registration date of 8 February 2008 and is current until 8 February 2018 when it is due for renewal. The Respondent registered the Domain Name on 8 May 2015, more than seven years after the deemed date of registration of the Complainant’s trade mark.
- 4.5 On 21 August 2015, the Complainant searched the Domain Name and found that the Domain Name resolved to a Sedo Domain Parking webpage with a list of “Related Links”, including “Enterprise Rent a Car”, to other websites. The Sedo webpage contained the following statements:
- (a) **enterpriserentacar.nz**;
 - (b) **BUY THIS DOMAIN** The owner of **enterpriserentacar.nz** is offering it for sale for an asking price of 2000 USD!;
 - (c) This page provided to the domain owner **free** by Sedo’s Domain Parking.
- 4.6 When the Complainant clicked on the “Enterprise Rent a Car” related link, the Complainant was taken to a webpage at Sedo.com which stated:
- (a) Boost your online business **enterpriserentacar.nz** instantly available;
 - (b) **\$2000 Buy Now***;
 - (c) *This domain name (**enterpriserentacar.nz**) without content is available for sale by its owner through Sedo’s Domain Marketplace.
- 4.7 On 21 August 2015, the Complainant’s intellectual property counsel received an email from domainnames.tv@gmail.com as follows:
- “enterpriserentacar.nz” is mine, now I want to [sell] it. According to the preliminary study, I found that the domain is pretty useful for you to explore [the] New Zealand market.
- Please let me know if you are interested.
- Buy Now: www.enterpriserentacar.nz
- 4.8 At the Complainant’s request, the Expert visited the websites at www.enterpriserentacar.nz and www.enterpriserentacar.co.nz. The first is the Sedo Domain Parking webpage described at paragraph 4.5 of this decision. The second took the Expert to the Complainant’s website at www.enterprise.com.
- 4.9 Although the Complainant’s case was advanced on the basis of the Complainant’s trade mark, the Expert notes that the Complainant registered the enterpriserentacar.co.nz domain name on 11 August 2006, 18 months

before the deemed date of registration of the trade mark, and almost nine years before the Respondent's registration of the Domain Name.

- 4.10 The Respondent is not associated with the Complainant in any way and has not sought the Complainant's permission to use its marks.

5. The Complainant's contentions

- 5.1 The Complainant's contentions that the registration of the Domain Name is an Unfair Registration are summarised as follows:

- (a) the Respondent has no Rights or legitimate interests in the Domain Name;
- (b) the Domain Name was registered to take unfair advantage of the Complainant's Rights;
- (c) the Respondent's registration and use of the Domain Name is unfairly detrimental to the Complainant's Rights;
- (d) the Respondent registered the Domain Name primarily for the purpose of selling the Domain Name for valuable consideration in excess of the Respondent's documented out-of-pocket costs;
- (e) 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;
- (f) The Respondent has not used the Domain Name in connection with a genuine offering of goods or services or made legitimate non-commercial or fair use of the Domain Name.

6. The Respondent's contentions

- 6.1 As noted, the Respondent has not filed a Response to the Complaint which answers the Complainant's contentions that the Domain Name registration is an Unfair Registration and which sets out the Respondent's contentions why the registration is not an Unfair Registration.

7. Relevant provisions of Policy and elements required to uphold Complaint

- 7.1 The determination of the Complaint is governed by the Policy. Relevant provisions of the Policy in this case are as follows:

3. Definitions

Rights include, but are not limited to, rights enforceable under New Zealand law. However, a Complainant will be unable to rely on rights in a name or term which is wholly descriptive of the Complainant's business;

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;

Part A – Policy

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

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

4.2 The Complainant is required to prove to the Expert that both elements are present on the balance of probabilities.

...

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;

...

6. How the Respondent may demonstrate in its Response that the Domain Name is not an Unfair Registration

6.1 A non-exhaustive list of factors which may be evidence that the Domain Name is not an Unfair Registration is set out in paragraphs 6.1.1 – 6.1.4:

6.1.1 Before being aware of the Complainant's cause for complaint (not necessarily the Complaint itself), the Respondent has:

- (a) used or made demonstrable preparations to use the Domain Name or a Domain Name which is similar to the Domain Name in connection with a genuine offering of goods or services;
- (b) been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name;
- (c) made legitimate non-commercial or fair use of the Domain Name;

7.2 For an Expert to uphold a Complaint, paragraph 4.2 of the Policy requires the Complainant to prove to the Expert on the balance of probabilities that both the following elements are present:

- (a) the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name;³ and
- (b) the Domain Name, in the hands of the Respondent, is an Unfair Registration.⁴

7.3 The Expert now considers each of the elements in paragraphs 4.1.1 and 4.1.2 of the Policy in respect of the Domain Name.

8. Rights in respect of a name or mark

8.1 It is well-established that the requirement for a Complainant to prove Rights in respect of a name or mark is not a particularly high threshold test.

8.2 In view of the facts set out in part 4 and elsewhere in this decision, the Expert is satisfied on the balance of probabilities that:

- (a) the Complainant has Rights in respect of a relevant name or mark, namely the Complainant's trade mark from 8 February 2008; and
- (b) the Complainant's Rights in paragraph 8.2(a) of this decision were clearly in existence before the registration of the Domain Name on 8 May 2015 and were well-established by that date.

9. Identity or similarity between the relevant name or mark and the Domain Name

9.1 It is well-established that Rights in a name cover all conceivable forms⁵ in which the name might be used.

9.2 The Expert is satisfied on the balance of probabilities that the facts set out in part 4 and elsewhere in this decision demonstrate that, in all their conceivable forms, the Complainant's trade mark is identical or similar to the Domain Name.

³ Paragraph 4.1.1 of the Policy.

⁴ Paragraph 4.1.2 of the Policy.

⁵ Including upper and lower cases and singular and plural.

10. Unfair Registration

10.1 The Expert is satisfied on the balance of probabilities that, in all the circumstances, the Domain Name is an Unfair Registration because the facts set out in part 4 and elsewhere in this decision demonstrate that:

- (a) the Domain Name was registered in a manner which, at the time when the registration took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights (para 3 of the Policy); and/or
- (b) the Domain Name has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights (para 3 of the Policy); and/or
- (c) use of the Domain Name will take unfair advantage of, and be unfairly detrimental to, the Complainant's Rights (para 3 of the Policy); and/or
- (d) the Respondent registered the Domain Name primarily for the purpose of selling the Domain Name for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name (para 5.1.1(a) of the Policy); and/or
- (e) 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 (para 5.1.2 of the Policy); and/or
- (f) the Respondent has not used the Domain Name in connection with a genuine offering of goods or services (para 6.1.1(a) of the Policy); and/or
- (g) the Respondent has not made legitimate non-commercial or fair use of the Domain Name (para 6.1.1(c) of the Policy).

10.2 While it is not necessary for the Expert's decision in this case, the Expert notes that the Complainant referred to the fact that the Respondent in this case was also the Respondent in *Shutterstock, Inc v Bai Xiqing*⁶. The Expert in that case was satisfied that the domain name (shutterstock.co.nz) was an Unfair Registration in the hands of the Respondent and ordered that the domain name be transferred to the Complainant in that case.

⁶ DRS 877, 6 August 2013.

11. Decision

11.1 In view of the findings made in this decision, the Expert directs that the Domain Name enterpriserentacar.nz be transferred to the Complainant.

Place of decision Wellington

Date 20 October 2015

Expert Name Terence Stapleton QC

Signature

A handwritten signature in black ink, appearing to read 'T. Stapleton', written over a light grey rectangular background.