

.nz Dispute Resolution Service

DRS Reference: 1250

**Enterprise Holdings, Inc.
Renee Reuter**

v

Cai Dibin

Key words -

Identical or similar trade mark or name

Registered mark - unregistered mark - identical — generic – descriptive

Rights

Generic – descriptive

Unfair registration

Unfair registration – unfair use – likely to confuse, mislead or deceive– unfairly disrupting the business of the complainant – blocking registration –respondent having no connection with name or trade mark

1. Parties

Complainant:

Enterprise Holdings, Inc.
Renee Reuter
600 Corporate Park Dr St. Louis,
Missouri United States

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

Respondent:

Cai Dibin
ZhangMu Tou JinHeGuKeng
Liuxiang 21 hao
DongGuan
China

2. Domain Name/s

enterprise.nz

3. Procedural history

The Complaint was lodged on 01 September 2017 and Domain Name Commission (DNC), notified the Respondent of the validated Complaint on 4/09/2017. The

domain was locked on 4/09/2017, preventing any changes to the record until the conclusion of these proceedings.

The Respondent filed a Response to the Complaint on 12 September 2017 and the DNC so informed the Complainant on 2/10/2017. The Complainant filed a Reply to the Response on 06 October 2017. The DNC informed the parties on 02 November 2017 that informal mediation had failed to achieve a resolution to the dispute.

The Complainant paid Domain Name Commission Limited the appropriate fee on 6/12/2017 for a decision of an Expert, pursuant to Paragraph 9 of the .nz Dispute Resolution Service Policy (“the Policy”).

Sheana Wheeldon, the undersigned, (“the Expert”) confirmed to the DNC on 13 December 2017 that she knew of no reason why she could not properly accept the invitation to act as expert in this case and that she knew of no matters which ought to be drawn to the attention of the parties, which might appear to call into question her independence and/or impartiality.

4. Factual background

The Complainant’s rights

- 4.1 The Complainant is Enterprise Holdings, Inc. It licenses the ENTERPRISE trade mark to Enterprise Rent-A-Car and other operating entities (“Enterprise”). Its vehicle rental business has been operating under the ENTERPRISE trade mark in the United States since 1974. It also operates in Canada, Ireland, Germany, the United Kingdom, New Zealand, Australia and other countries.
- 4.2 The Complainant and its affiliated companies employ more than 74,000 people worldwide and own more than 1.5 million cars and trucks.
- 4.3 The first ENTERPRISE location in New Zealand opened in July 2016 at Queenstown Airport and ENTERPRISE locations have subsequently been opened at Auckland Airport and Wellington Airport.
- 4.4 Enterprise operates an online worldwide car rental site at enterprise.com and a New Zealand specific website at enterpriserentacar.nz.
- 4.5 The Complainant has registered the ENTERPRISE trade mark in many countries including New Zealand where it owns:
 - a. Registration no. 235128 ENTERPRISE in class 39 for “transportation and travel services in this class including rental and leasing of vehicles and reservation services for vehicle rental, and automobile dealership services” dated 15 March 1994.
 - b. Registration no. 611189 ENTERPRISE in class 39 for “vehicle rental and leasing; reservation services for vehicle leasing and rental; provision of tourism information” dated 24 March 2000.
 - c. Registration no. 848262 ENTERPRISE in class 39 covering “vehicle rental and leasing services, and reservation services for the rental and leasing of vehicles” dated 26 August 2011.

The Respondent's activities

- 4.6 The Domain Name was registered on 3 March 2017. The Respondent is Cai Dibin of DongGuan in China.
- 4.7 As at 15 August 2017 the Domain Name resolved to a webpage with a list of Related Links consisting of links to websites offering vehicle rental services, including those of the Complainant and its competitors. The links included:
- a. Enterprise Car Rental.
 - b. Enterprise Carshare.
 - c. Car Rental Car Rental.
 - d. Enterprise Auto Sales.
 - e. Enterprise Truck.
 - f. Enterprise Specials.
 - g. Enterprise Car Rental.
 - h. National Enterprise.
 - i. Enterprise com.
 - j. Car Rental Car Rental.
- 4.8 The webpage also included a link saying:
- “Buy this Domain
- The Domain enterprise.nz may be for sale by its owner!”
- 4.9 The Complainant invited the Expert to visit the website at www.enterprise.nz, which she did in December 2017 and again in January 2018. On both occasions this led to the Sedo Domain Parking page referred to earlier.
- 4.10 In December 2017 a similar list of links to that in August 2017 appeared on the website, as did the following link:
- “Buy this Domain
- The owner of enterprise.nz is offering it for sale for an asking price of 6,000 USD!”.
- 4.11 In January 2018 the list of links included “Enterprise Car Rental” as well as unrelated descriptions such as “Refrigerators & Freezers”. Clicking through on “Enterprise Car Rental” led to links to five car rental websites, none of which appeared to be operated by the Complainant. The same offer for sale at a price of US\$6,000 also appeared.

- 4.12 It is evident that the Domain Name is being used in relation to a pay-per-click website that in the Complainant's words "serves merely to drive Internet traffic to websites offering vehicle rental services, including those of the Complainant and its competitors, and makes a generalised offer to sell the domain name".

5. Parties' contentions

Complainant

- 5.1 The Complainant seeks to have the Domain Name transferred to it from the Respondent.
- 5.2 The Complainant asserts registered trade mark rights in the mark ENTERPRISE in New Zealand. It is not clear whether it is also asserting unregistered trade mark rights. There is insufficient information in the Complaint to make an assessment of the Complainant's reputation in New Zealand in the mark ENTERPRISE, whether based on its local activities since July 2016, or its activities elsewhere. Nothing turns on whether the Complainant has unregistered rights in New Zealand and the Expert will say nothing more on that subject.
- 5.3 The main assertions of the Complainant in support of its Complaint are as follows:
- a. The Domain Name is identical to the Complainant's ENTERPRISE trade mark (other than the addition of the .nz country code top-level domain, which is irrelevant).
 - b. The Complainant's first registration of the ENTERPRISE trade mark in New Zealand issued on 17 March 1997, almost 20 years prior to the 3 March 2017 registration of the Domain Name.
 - c. The Respondent has no rights or legitimate interests in the Domain Name.
 - d. In light of the long-standing use and registration of the ENTERPRISE mark by the Complainant, the Respondent cannot have any legitimate rights or interests in connection with the pay-per-click website to which the Domain Name currently resolves.
 - e. The Respondent has registered the Domain Name to take unfair advantage of the goodwill the Complainant has created in its ENTERPRISE trade mark.
 - f. The Respondent's registration and use of the Domain Name is unfairly detrimental to the Complainant's rights.
 - g. Because the Complainant operates in many countries around the world, customers expect it to operate ENTERPRISE vehicle rental websites with many different country-code top level domains, so use and registration by the Respondent of the Domain Name is likely to confuse, mislead, and/or deceive people or businesses into believing that the Domain Name is authorised and operated by Enterprise or that

Enterprise does not offer vehicle rental services to residents of New Zealand.

- h. The Respondent's use of the Domain Name is not a genuine offering of goods or services.
- i. The Respondent's use is not a legitimate non-commercial or fair use of the Domain Name. In fact, Enterprise Rent-A-Car must pay a click through fee if a link to the Enterprise Rent-A-Car website on the enterprise.nz webpage is used. As a result, the Respondent is profiting at the Complainant's licensees' expense based on the misdirection of Internet users to the enterprise.nz webpage.
- j. The Complainant's ENTERPRISE mark is not descriptive or generic for vehicle rental services and the Respondent's use of the Domain Name is not consistent with any fair descriptive or generic use of ENTERPRISE.
- k. On the balance of probabilities, the registration of the Domain Name by the Respondent takes unfair advantage of and is detrimental to the Complainant's long-established rights in its ENTERPRISE trade mark.

Respondent

- 5.4 On the topic of the links to websites offering vehicle rental services, the Respondent states in his Response:

"I just used Sedo's parking service. The complainant mentioned a parking page, and the ad for the parking page was not decided by me. It was decided by Sedo. But if this advertisement has any effect on the complainant, I can cancel it".

- 5.5 He also asserts that the Domain Name "is an ordinary word. It's not like Google, Yahoo, Twitter, the domain name that only they can hold. So there is no malicious registration behaviour".
- 5.6 He says he has not attempted to sell the Domain Name to the Complainant, nor used the Complainant's company name to re-sell the Domain Name.

Complainant's Reply

- 5.7 The Complainant with its Reply provided a copy of Sedo's promotion of its domain parking service. This includes this statement:

"Advertisements which thematically correspond to the domain name will be displayed on your domain. You will earn money whenever a visitor clicks on the advertising links".

- 5.8 The Complainant notes that it was the Respondent who set up the use of Sedo's parking service "to earn money with thematically matched advertising links featured on [his] domain". It says he "clearly knew that, or should have at least checked to determine whether, such thematically matched advertising links relate to Enterprise Rent-A-Car and car hire services".

- 5.9 It submits that if the use of the Domain Name is taking unfair advantage of the Complainant's Rights, and the fact the Respondent does not directly control the selection of content or links does not change the fact it is an Unfair Registration. It says a registrant cannot deny ultimate responsibility for the diversion of custom to a competitor even if the selection of advertisements on display at the pay-per-click landing site is chosen by some independent organisation or algorithm.
- 5.10 By way of reply to the Respondent's assertion that the Domain Name is an "ordinary word", the Complainant points to paragraph 6.1.2 of the Policy. This provides that a Domain Name corresponding to a generic or descriptive word must be used in a way consistent with its generic or descriptive nature.
- 5.11 The Complainant goes on to note that the Respondent is using the Domain Name in connection with a webpage, not related to enterprises, but consisting almost exclusively of links to the Complainant's licensee and other entities offering car hire services. These are precisely the services for which the Complainant has registered the mark ENTERPRISE.

6. Discussion and findings

Relevant Provisions of the Policy

- 6.1 The Complainant is required to prove that it has met the requirements in paragraph 4 of the Policy namely 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.
- 6.2 Paragraph 4.2 requires the Complainant to prove to the Expert that both elements are present on the balance of probabilities.
- 6.3 The Policy provides that 'Unfair Registration' means a Domain Name which either:
- a. 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
 - b. 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.
- 6.4 Paragraph 5.1 of the Policy sets out a non-exhaustive series of factors which may be evidence that a Domain Name is an Unfair Registration. They include the following:
- 5.1.1 Circumstances indicating that 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; or

- 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;

6.5 Paragraph 6.1 of the Policy sets out a non-exhaustive series of factors which may be evidence that a Domain Name is not an Unfair Registration. They include the following:

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;

6.1.2 The Domain Name is generic or descriptive and the Respondent is making fair use of it in a way which is consistent with its generic or descriptive character.

Application of the Policy in this case

6.6 The first question is whether the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name. Rights must be enforceable under New Zealand law and may be registered or unregistered.

Complainant's rights

6.7 The Expert finds that the Complainant has rights in respect of the trade mark ENTERPRISE in New Zealand by virtue of its trade mark registrations referred to above.

6.8 The Domain Name is enterprise.nz which is effectively identical to the Complainant's trade mark ENTERPRISE.

Is the Domain Name, in the hands of the Respondent, an Unfair Registration?

6.9 Under paragraph 4.1.2 of the Policy the Complainant must show, on the balance of probabilities, that the Domain Name is an Unfair Registration in the hands of the Respondent.

- 6.10 The Respondent having registered the domain on 3 March 2017, the Expert can consider both arms of the definition of Unfair Registration above.

Respondent is using Domain Name in a way likely to confuse, mislead or deceive people (paragraph 5.1.2)

- 6.11 The Expert finds that in the New Zealand context members of the public are likely to expect a website at enterprise.nz to be associated with the Complainant. Members of the public (whether in New Zealand or overseas) looking for the Complainant's New Zealand website may attempt to reach it by typing in the Domain Name. Alternatively the webpage associated with the Domain Name is likely to appear in results generated by search engines. Along with the name of the webpage, the links appearing on it reinforce the impression that it is associated with the ENTERPRISE vehicle rental business.
- 6.12 The Expert has considered the Respondent's statement to the effect that if the advertisements generated by the Sedo parking service have an effect on the Complainant, he can cancel it. However this has no impact on the Complaint since the Complainant is entitled to rely on the circumstances prior to its filing. Further, in making a decision it is not appropriate to take into account indications by the Respondent as to possible future changes in the use being made of the Domain Name.
- 6.13 In light of the actual use that has been made of the Domain Name the Expert finds that the Respondent is using it in a way likely to confuse, mislead or deceive people and so falls within paragraph 5.1.2 of the Policy.

Respondent acquired and/or is using the Domain Name primarily for the purposes of selling it, or as a blocking registration, or for the purpose of unfairly disrupting the business of the Complainant (paragraph 5.1.1)

- 6.14 The Respondent appears to have been continuously offering the Domain Name for sale since at least August 2017. The price now being asked is USD\$6,000. This is well in excess of the usual cost of registering a Domain Name.
- 6.15 From the facts it is not difficult for the Expert to infer that the Respondent is using the Domain Name as a blocking registration against the Complainant.
- 6.16 The links appearing on the webpage associated with the Domain Name include links to competitors of the Complainant. It is likely that this is unfairly disrupting the business of the Complainant by diverting trade.
- 6.17 Where the links on the webpage associated with the Domain Name are to websites associated with Enterprise Rent-A-Car it must pay a click through fee if such a link is used. This also unfairly disrupts the business of the Complainant.
- 6.18 In light of the above the Expert finds that the Respondent acquired the Domain Name, and is using it, primarily for the purpose of selling it to the Complainant or a competitor, and/or as a blocking registration, and/or for the purpose of unfairly disrupting the business of the Complainant, and this takes unfair advantage of and is unfairly detrimental to the Complainant's Rights. and so falls within paragraph 5.1.1 of the Policy

Factors evidencing Domain Name not Unfair Registration

- 6.19 The Respondent has not used the Domain Name in connection with a genuine offering of goods or services (paragraph 6.1.1(a) of the Policy).
- 6.20 Neither has he made legitimate non-commercial or fair use of the Domain Name (paragraph 6.1.1(c) of the Policy).
- 6.21 The Expert agrees with the Complainant that the Respondent is not using the Domain Name in a way that is consistent with any generic or descriptive character of the word “enterprise”. “Enterprise” may be descriptive for certain services relating to enterprises. However the Respondent is using it in relation to car hire services. Therefore 6.1.2 of the Policy has no application.

Relevance of Sedo parking service selecting links displayed on website

- 6.22 The Expert accepts the Complainant’s submission that the Respondent cannot deny ultimate responsibility for the results of the way the Domain Name is being used, even if the Sedo parking service rather than he himself is selecting the advertisements on display at the pay-per-click landing site. In WIPO Cases under the Uniform Domain Name Dispute Resolution Policy (“UDRP”) it is now settled that with respect to “automatically” generated pay-per-click links, a party cannot disclaim responsibility for content appearing on the website associated with its domain name.
- 6.23 The Enterprise Rent-A-Car business is a substantial one globally which suggests the Respondent would have been aware of it when he registered the Domain Name. Further, he acquired the Domain Name around eight months after the first Enterprise location in New Zealand opened. At that time it was likely members of the public would associate a website under the name enterprise.nz with the Complainant’s ENTERPRISE business. Both these factors are likely to have influenced the type of “thematically matched” advertising links the Sedo parking service would select, and the resulting revenue to the Respondent when people clicked on those links.
- 6.24 Taking all of the above into account, the Expert is satisfied that the Complainant has shown, on the balance of probabilities, that the Respondent’s Domain Name is an Unfair Registration.

7. Decision

- 7.1 In view of the findings made above the Expert directs that the Domain Name enterprise.nz be transferred to the Complainant.

Place of decision: Auckland

Date: 12 January 2018

Expert Name: Sheana Wheeldon

Signature:

A handwritten signature in blue ink, appearing to read "Shawn M." followed by a long horizontal flourish.