

CANADIAN INTERNET REGISTRATION AUTHORITY

DOMAIN NAME DISPUTE RESOLUTION POLICY

COMPLAINT

Dispute Number: DCA-1505-CIRA
Domain Names: <alamocars.ca>
<alamorentalcars.ca>
<alamorentcars.ca>
<alamorentals.ca>
<nationalrentalcars.ca>
<nationalrentcars.ca>
Complainant: Vanguard Trademark Holdings USA, LLC
Registrant: David Danier
Panel: David Wotherspoon
Service Provider: British Columbia International Commercial Arbitration Centre (BCICIA)

DECISION

A. The Parties

1. The Complainant is Vanguard Trademark Holdings USA, LCC. (the “Complainant.”). The Complainant is represented by David R. Haarz of the law firm Harness, Dickey & Pierce, PLC located in Reston, Virginia.
2. The Registrant is David Danier (the “Registrant”). The Registrant’s address is 511 Elliott Street, Whitehorse, Yukon Territory, Y1A 2A5. Attempts to locate the Registrant at that address have been unsuccessful.

B. The Domain Names and Registrar

3. The Domain Names in issue are: <alamocars.ca> <alamorentalcars.ca> <alamorentcars.ca> <alamorentals.ca> <nationalrentalcars.ca> <nationalrentcars.ca> (collectively the “Domain Names”).
4. The Domain Names were registered on February 15, 2012.
5. The Registrar of the Domain Names is GoDaddy Domains Canada, Inc.

C. Procedural History

6. On May 31, 2013, the Complainant submitted a complaint (the “Complaint”) with respect to the Domain Names to the British Columbia International Commercial Arbitration Centre (“BCICAC”) as service provider pursuant to paragraph 1.5 of the Canadian Internet Registration Authority (“CIRA”) Domain Name Dispute Resolution Policy v. 1.3 (the “Policy”).

7. The Complainant has provided evidence that both it, in this proceeding, and the US District Court of the Eastern District of Virginia, in a separate proceeding, have attempted to provide notice to the Registrant via postal mail to the Registrant's address. Attempts to deliver the Complaint to the Registrant have been unsuccessful. Notices sent via postal mail to the Registrant's address were returned as undeliverable. The Complainant has provided notice to the Panel of the non-delivery as required by paragraph 2.9 of the CIRA Domain Name Dispute Resolution Rules (the "Resolution Rules"). The Panel accepts that the Complainant has used reasonably available means which are likely to give actual notice to the Registrant in accordance with paragraph 2.1 of the Resolution Rules.
8. The Registrant did not submit a Response.
9. As permitted in the absence of a Response, the Complainant elected under Rule 6.5 to convert to a single arbitrator. The BCICAC selected David Wotherspoon as Sole Panelist ("the Panel").
10. On June 21, 2013, the Panel was appointed by the BCICAC. As prescribed by the Policy, the Panel has declared that it can act impartially and independently and that there are no circumstances known to the Panel which would prevent it from so acting.

D. Factual Background

11. The unchallenged factual background as set out in the Complainant's submissions is summarized in the following paragraphs.
12. The Complainant is the owner of four Canadian registered trade-marks as described below ("the Trade-marks"):
 - (a) ALAMO, which was registered as number TMA402024 on August 28, 1992 in association with automotive reservation services and automotive renting and leasing services;
 - (b) ALAMO RENT-A-CAR & Design, which was registered as number TMA403563 on October 9, 1992 in association with automotive reservation services and automotive renting and leasing services;
 - (c) NATIONAL CAR RENTAL, which was registered a number TMA34651 on August 12, 1988 in association with automobile and truck rental and leasing services;
 - (d) NATIONAL, which was registered a number TMA534880 on April 28, 2000 to the Complainant's predecessor in interest in association with automobile and truck rental and leasing services.
13. The Complainant licenses its Trade-Marks to Alamo Rent A Car and other operating entities. The ALAMO RENT-A-CAR & Design Mark has been used in Canada in connection with automotive renting and leasing services since at least as early as 1998.

The Complainant, through its predecessors in interest and current licensee has used the NATIONAL Mark in connection with automotive rental services in Canada since 1950. The NATIONAL CAR RENTAL Mark has been used in Canada in connection with automotive rental services in Canada since July, 1971.

14. The Complainant has also established a presence on the Internet with its websites. The Complainant's licensees operate on-line car rental sites at: alamo.ca (to which alamorentacar.ca also resolves), alamo.com, nationalcar.ca and nationalcarrental.ca.
15. The Registrant registered the Domain Names on February 15, 2012. The Domain Names are used as "parked" webpages which contain advertisements and links to third-party websites, including competitors of the Complainant, under the heading "Sponsored Links".

E. Eligibility of Complainant

16. The Complainant is an eligible complainant under paragraph 1.4 of the Policy. The Canadian Presence Requirements for Registrants has been satisfied in this case because the Complaint relates to trade-marks registered in the Canadian Intellectual Property Office, which the Complainant is the registered owner.

F. Complainant's submissions

17. The Complainant submits that the Registrant registered the disputed Domain Names in an attempt to attract for commercial gain, Internet users to its websites by creating a likelihood of confusion with the Complainant's Trade-Marks.
18. The Complainant asserts that the Domain Names include either the Complainant's NATIONAL or ALAMO Marks in their entirety and thus meet the standard to be considered confusingly similar.
19. The Complainant further asserts that it had rights to the Marks prior to the registration of the Domain Names, and continues to have rights, under the ALAMO, ALAMO RENT-A-CAR, NATIONAL CAR RENTAL, and NATIONAL Marks, and thus that the Domain Names meet the standard under paragraph 3.1(a) of the Policy.
20. The Complainant further asserts that the Registrant has no legitimate interest in the Domain Names as described in paragraph 3.4 of the Policy. The Complainant adds that the Registrant has no registrations or pending applications for "alamocars", "alamorentalcars", "alamorentals", "alamorentcars", "nationalrentalcars", or "nationalrentcars". In addition, the Complainant has never licensed or authorized the Registrant to use the NATIONAL, NATIONAL CAR RENTAL, ALAMO or ALAMO RENT-A-CAR & Design marks.
21. The Complainant finally asserts that the Domain Names were registered in bad faith, in line with paragraph 3.5(d) of the Policy and submits that the Registrant intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Trade-marks as to the source, sponsorship, affiliation or

endorsement of the Registrant's websites or location of a product or service on the Registrant's websites or location.

22. The Complainant seeks the transfer of the Domain Names from the Registrant to the Complainant.

G. Discussion and Findings

23. In accordance with paragraph 4.1 of the Policy, in order to succeed in the Proceeding, the onus is on the Complainant to prove, on a balance of probabilities, that:

- (a) The Registrant's dot-ca Domain is Confusingly Similar to a Mark in which the Complainant has Rights prior to the date of the registration of the Domain, and continues to have such Rights - paragraph 3.1(a) of the Policy.
- (b) The Registrant has registered the Domain in bad faith, as described in paragraph 3.5 of the Policy.

And the Complainant must provide some evidence that:

- (c) The Registrant has no legitimate interest in the Domain as described in paragraph 3.4 of the Policy;

Confusingly Similar

24. At paragraph 3.2 of the Policy, a "Mark" is defined:

3.2 Mark. A "Mark" is:

...

(c) a trade-mark, including the word elements of a design mark, that is registered in CIPO;

25. Given the evidence presented by the Complainant, the Panel finds that the Complainant has established that NATIONAL, NATIONAL CAR RENTAL, ALAMO or ALAMO RENT-A-CAR & Design are "Marks" under the definition in paragraph 3.2(c) of the Policy.
26. For the purpose of determining whether a domain name is confusingly similar to a Mark, paragraph 1.2 of the Policy indicates that the "dot-ca" suffix of the domain name should not be considered, and thus the addition of "dot-ca" cannot be the differentiating factor between the Domain Names and the Trade Marks.
27. Paragraph 3.3 of the Policy provides that a domain name is "Confusingly Similar" to a Mark if the domain name so nearly resembles the Mark in appearance, sound or the ideas suggested by the Mark, as to be likely to be mistake for the Mark.
28. The Domain Names in this case all include the exact word component of at least one of the Trade Marks. The Domain Names wholly incorporate the Complainant's Trade

Marks, and as such meet the definition of Confusingly Similar as outlined in paragraph 3.3 of the Policy.

29. In addition, in *General Motors LLC v Tony Wilson*, the arbitrator held:

I agree with the Complainant's submission that the addition of the words "certified" and "service" to each of the Domain Names cannot distinguish them from the Complainant's corresponding trade-mark. Each of these terms are merely descriptive terms, especially in the context of motor vehicles and motor vehicle services, and this puts these circumstances squarely on all fours with those considered in the case of *General Motors Acceptance Corporation v. Bob Woods*, CIRA Dispute No. 00051 (2006). In that case the Panel stated that "[t]he addition of descriptive or non-descriptive terms in a domain name will not prevent it from being found confusingly similar with a Complainant's Mark."¹

Similarly, in this case the addition of the term "cars" to the Domain Names or the slight variations to the Trade Marks does not preclude the finding that the Domain Names are Confusingly Similar.

30. The Complainant's registration of the Trade-Marks all pre-date the registration date of the Domain Names on February 2, 2012.
31. The Panel therefore finds that the Complainant has met its burden under paragraph 3.1(a) that the Registrant's Domain Names are confusingly similar to a Mark in which the Complainant had rights prior to the date of registration of the Domain Names.

Bad Faith

32. Prior to the amended Policy on August 22, 2011, then paragraph 3.7 of the Policy mandated that a Registrant will be considered to have registered a Domain in bad faith *if and only if* the Panel found that the Registrant's conduct fell within one of the enumerated sub-paragraphs of 3.7.
33. The August 22, 2011 revision of the Policy reduced this burden and provided a non-exhaustive list of circumstances in which bad faith on the part of the Registrant may be found.
34. Paragraph 3.5 of the current Policy now provides that the Registrant has registered a domain name in bad faith if any of the following circumstances, in particular but without limitation, are found by the Panel:
- (a) the Registrant registered the domain name, or acquired the Registration, primarily for the purpose of selling, renting, licensing or otherwise transferring the Registration to the Complainant, or the Complainant's licensor or licensee of the Mark, or to a competitor of the Complainant or the licensee or licensor for

¹ *General Motors LLC v Tony Wilson*, Dispute 00182 (Resolution Canada 21 March 2012) at para 26.

valuable consideration in excess of the Registrant's actual costs in registering the domain name, or acquiring the Registration;

- (b) the Registrant registered the domain name or acquired the Registration in order to prevent the Complainant, or the Complainant's licensor or licensee of the Mark, from registering the Mark as a domain name, provided that the Registrant, alone or in concert with one or more additional persons has engaged in a pattern of registering domain names in order to prevent persons who have Rights in Marks from registering the Marks as domain names;
 - (c) the Registrant registered the domain name or acquired the Registration primarily for the purpose of disrupting the business of the Complainant, or the Complainant's licensor or licensee of the Mark, who is a competitor of the Registrant; or
 - (d) the Registrant has intentionally attempted to attract, for commercial gain, Internet users to the Registrant's website or other on-line location, by creating a likelihood of confusion with the Complainant's Mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website or location or of a product or service on the Registrant's website or location.
35. The Complainant submits that the Registrant's registration supports a finding under paragraph 3.5(c) and (d) because the Domain Names are being used to attract users to its website through confusion with the Complainant's Marks and to reap the benefits of the goodwill attached to the Complainant's Mark's by obtaining advertising revenue by posting links to third party websites and obtaining "click-through" fees when someone "clicks" on the link in the advertisement.
36. The Complainant further argues that the website is disrupting the business of the Complainant by containing a section which is labelled "Related Searches" at the top of the web page. This section contains links to other car rental services which are competitors of the Complainant.
37. In *The Calgary Exhibition & Stampede Limited v Gordon Squires*, the panel held:
- Only in rare cases will there be direct evidence of a registrant's bad faith. In most cases a panel's findings regarding a registrant's purposes in registering a domain name will be based upon common sense inferences from the registrant's conduct and other surrounding circumstances.²
38. Taking the evidence together, the Complainant has established on a balance of probabilities that the Registrant registered the Domain Names for the purpose of disrupting the business of the Complainant.

² *The Calgary Exhibition & Stampede Limited v Gordon Squires*, Dispute 00229 (BCICAC 10-May-2013) at para 35.

39. Accordingly, the Complainant has established on a balance of probabilities, in line with paragraph 3.5 of the Policy, that the Registrant registered the Domain in bad faith.

Legitimate Interest

40. Paragraph 3.4 of the Policy lists 6 non-exhaustive criteria upon which the Panel may find, upon all the evidence, that the Registrant has a legitimate interest in the Domain:
- (a) the domain name was a Mark, the Registrant used the Mark in good faith and the Registrant had Rights in the Mark;
 - (b) the Registrant used the domain name in Canada in good faith in association with any wares, services or business and the domain name was clearly descriptive in Canada in the English or French language of: (i) the character or quality of the wares, services or business; (ii) the conditions of, or the persons employed in, production of the wares, performance of the services or operation of the business; or (iii) the place of origin of the wares, services or business;
 - (c) the Registrant used the domain name in Canada in good faith in association with any wares, services or business and the domain name was understood in Canada to be the generic name thereof in any language;
 - (d) the Registrant used the domain name in Canada in good faith in association with a non-commercial activity including, without limitation, criticism, review or news reporting;
 - (e) the domain name comprised the legal name of the Registrant or was a name, surname or other reference by which the Registrant was commonly identified; or
 - (f) the domain name was the geographical name of the location of the Registrant's non-commercial activity or place of business.
41. Paragraph 4.1 of the Policy places the onus on the Complainant to provide "some evidence" that the Registrant did not have a legitimate interest in the Domain Names. What "some evidence" means is not defined. It is certainly a lower threshold than on a balance of probabilities. In *Spafinder Inc v Ontario Spa Inc.* the arbitrator held:

While this evidence might not have been sufficient to bear the burden required under the first two prongs of the CIRA test, the Panel interprets "some evidence" as being a lower burden for the question of "no legitimate interest"³

42. The onus on a Complainant in this part of the test is to provide "some evidence" of a negative. These criteria could be satisfied by demonstrating that efforts were made to identify some of the factors outlined in the Policy but that nothing was found. A nil result in that case would satisfy the threshold of "some evidence".

³ *Spafinder Inc. v Ontario Spa Inc.* Dispute No 00108 (18 August 2008) at para 43.

43. In its submissions the Complainant asserts that the Registrar does not have a legitimate interest in the Domain Names as the use of the Domain Names does not satisfy any of the criteria set out in Paragraph 3.4. These submissions, which merely assert that there is no legitimate interest, do not satisfy the Complainant's obligation to provide "some evidence".
44. That said, paragraph 3.4 of the Policy indicates that the Panel must base its evaluation on all of the evidence presented, meaning the Complaint must be analyzed in its entirety in assessing whether there is any evidence to demonstrate that the Registrar had a legitimate interest in the Domain Names.
45. In *General Motors LLC v DSI Design*, the Panel held that the assertion that the Registrant had not received authorization to use the Complainants' Trade-Marks was considered to be "some evidence" that the Registrant did not have a legitimate interest under paragraph 3.4(a) of the Policy. At paragraph 39 of their decision the Panel stated:

The Complainant's unchallenged submissions are that:

- the Registrant has not received any license or consent to use the trade-marks BUICK, CADILLAC and CHEVROLET in a domain name or in any other manner from the Complainant;
- the Complainant has not acquiesced in any way to such use of the trade-marks BUICK, CADILLAC and CHEVROLET; and
- at no time did the Registrant have authorization from the Complainant to register any of the Domain Names.

Accordingly, the Complainant has provided some evidence that the Registrant has no legitimate interest under paragraph 3.4(a) of the Policy.⁴

46. Similar assertions have been made by the Complainant in this case. At page 6 of the Complaint the Complainant asserts:

Registrant has no registrations or pending applications for "alamocars", "alamorentalcar", "alamorentals", "alamorentcars", "nationalrentalcars", or "nationalrentcars". Complainant has not licensed or authorized Registrant to use the NATIONAL, NATIONAL CAR RENTAL, ALAMO, or ALAMO RENT A CAR & Design marks.

47. These assertions by the Complainant may be viewed as "some evidence" that the Registrant did not have Rights in the Mark or use the Marks in good faith.

⁴ *General Motors LLC v DSI Design*, Dispute 00231 (Resolution Canada 29 May 13) at paras 39-40.

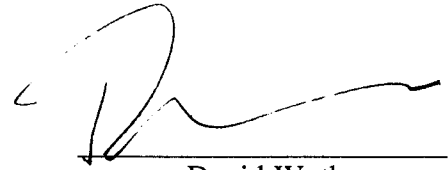
48. A common sense inference and the absence of any evidence to the contrary suggests that there is no basis for a claim of legitimate interest based on the criteria in paragraph 3.4 (b), (c), (d), (e) or (f).
49. The Domain Names are not descriptive of a character, place or condition of the Registrant's wares, services or business, within Canada, as they contain Trade-Marks which are registered to the Complainant and suggest the services and businesses of the Complainants' licensees. Similarly, it cannot be said that the Domain Names containing the Complainants' Trade-Marks are generic names in association with wares, services or a business within Canada. As such there is no evidence to suggest that the Registrant had a legitimate interest as described in paragraph 3.4(b) or (c).
50. The nature of the "parked" webpage, is such that it cannot be considered to be associated with a non-commercial activity such as news reporting or criticism. As such there is no evidence to suggest that the Registrant had a legitimate interest as described in paragraph 3.4(d).
51. Finally, there is no evidence which would suggest that the Domain Names make reference to a name by which the Registrant is commonly identified nor are they referring to the location of the Registrant's business or activity. As such there is no evidence to suggest that the Registrant had a legitimate interest as described in paragraph 3.4(e) or (f). An analysis of the Complaint as a whole and common sense inferences lead to the conclusion that there is some evidence that Registrant does not have a legitimate interest in the Domain Names.
52. Accordingly, the Panel finds that the Complainant has overcome the burden of bringing forward "some evidence" that the Registrant does not have a legitimate interest in the Domain Names.

H. Conclusion and Decision

53. The Panel finds that the Complainant has met the burden under paragraph 4.1 of the Policy.
54. The Panel accordingly finds that the Complainant has established its claim, and is entitled to the order that it seeks.

55. Given the above, the Panel orders that the Registrations for the following Domain Names be transferred to the Complainant:

<alamocars.ca>
<alamorentalcars.ca>
<alamorentals.ca>
<alamorentcars.ca>
<nationalrentalcars.ca>
<nationalrentcars.ca>



David Wotherspoon
Sole Panelist
July 11, 2013