

.hk Domain Name Dispute Resolution **ARBITRATION PANEL DECISION**

Complainant: Vanguard Trademark Holdings USA LLC

Respondent: Zhao Ke

Case Number: DHK-1400114

Contested Domain Name: **alamocar.hk**

Panel Member: Gabriela Kennedy

1. Parties and Contested Domain Name

The Complainant is Vanguard Trademark Holdings USA LLC.

The Respondent is Zhao Ke.

The contested domain name is alamocar.hk (the "Disputed Domain Name").

2. Procedural History

The Complaint was filed with the Hong Kong International Arbitration Centre ("HKIAC") on November 6, 2014. On the same day, HKIAC transmitted by email to the Hong Kong Domain Name Registration Co. Ltd (the "Registrar") a request for registrar verification in connection with the Disputed Domain Name. Also on November 6, 2014, the Registrar transmitted by email to the HKIAC its verification response confirming that the Respondent is listed as the registrant and providing the registrant contact details.

HKIAC verified that the Complaint satisfied the formal requirements of the Domain Name Dispute Resolution Policy (the "Policy"), the HKIRC Domain Name Dispute Resolution Policy Rules of Procedure (the "Rules"), and the HKIAC Supplemental Rules (the "Supplemental Rules").

In accordance with the paragraphs 2(a) and 4(a) of the Rules, HKIAC formally notified the Respondent of the Complaint, and the proceedings formally commenced on November 27, 2014. The deadline for the Respondent to file a response was December 18, 2014. The Respondent did not submit any response. Accordingly, HKIAC notified the Respondent's default on December 19, 2014.

HKIAC appointed Gabriela Kennedy as the sole panelist in this matter on December 30, 2014. The Panel finds that it was properly constituted.

3. Factual Background

The Complainant

The Complainant (Vanguard Trademark Holdings USA, LLC) is a company incorporated in the State of Delaware, United States of America. The Complainant is the owner of the ALAMO and ALAMO RENT A CAR trade mark registrations, which it licenses to Alamo Rent A Car and other operating entities (“Alamo”). Alamo is a car rental provider which launched in 1974. Alamo operates an online vehicle rental site at alamo.com that offers airport vehicle rentals.

The Respondent

The Respondent (Zhao Ke) is an individual based in Mainland China. The Respondent registered the Disputed Domain Name on March 18, 2013.

4. Parties’ Contentions

The Complainant

The Complainant's contentions can be summarised as follows:

- a) The Complainant has trade mark registrations for ALAMO in Hong Kong, as well as trade mark registrations in the United States of America for ALAMO and ALAMO RENT A CAR. The Complainant relies on these trade mark registrations and its extensive use of its ALAMO and ALAMO RENT A CAR marks to establish its right to stop others from adopting domain names which are confusingly similar to those marks.
- b) The Disputed Domain Name is confusingly similar to the Complainant’s registered ALAMO and ALAMO RENT A CAR marks. The Disputed Domain Name fully incorporates the Complainant’s ALAMO mark, merely adding the descriptive term “car,” which describes the Complainant’s services, and the “.hk” extension. The Disputed Domain Name also incorporates the Complainant’s ALAMO RENT A CAR mark, merely deleting the words “RENT A” and the spaces between the words, before adding the “.hk” extension. The Disputed Domain Name therefore maintains the most prominent and distinct part of the Complainant's trade marks.
- c) The website to which the Disputed Domain Name resolves offers the Disputed Domain Name for sale and contains a link to a webpage where users can make an offer to buy the Disputed Domain Name. The Respondent’s use of the

Disputed Domain Name is, therefore, neither a bona fide offering of goods or services nor a legitimate non-commercial or fair use.

- d) Nothing in the WHOIS record for the Disputed Domain Name, nor the website to which the Disputed Domain Name's resolves indicates that the Respondent is known as, operates a business as, or advertises as "alamo car."
- e) The Complainant has not licensed or otherwise permitted the Respondent to use its ALAMO marks in connection with any goods or services or to apply for any domain name incorporating the ALAMO marks.
- f) The Respondent is clearly not making any legitimate noncommercial or fair use of the Disputed Domain Name. The website to which the Disputed Domain Name resolves is a generic type of parking page used commonly by domain name owners seeking to monetize their domain names through "click-through" fees.
- g) The Respondent is deliberately using a domain name that is confusingly similar to the Complainant's ALAMO and ALAMO RENT A CAR marks to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's ALAMO marks as to the source, sponsorship, affiliation or endorsement of its websites and the services offered at such websites. In fact, the Respondent's website has a link to the Complainant's website under its "Sponsored Listings" (which contains the ® symbol, indicating an existing trade mark registration). Such action both constitutes a lack of legitimate interest in the Disputed Domain Name and evidences bad faith registration and use of the Disputed Domain Name.
- h) The Complainant's earliest Hong Kong trade mark registration for its ALAMO mark was in March 1992, which is 21 years before the Disputed Domain Name was registered in March 2013.

The Respondent

The Respondent did not reply to the Complainant's contentions. Whilst failure to file a Response does not automatically result in a decision in favour of the Complainant, it may result in the Panel drawing appropriate inferences from such default. The Panel may also accept all reasonable and supported allegations and inferences flowing from the Complaint as true (see *Entertainment Shopping AG v. Nischal Soni, Sonik Technologies*, WIPO Case No. D2009-1437 and *Charles Jourdan Holding AG v. AAIM*, WIPO Case No. D2000-0403).

5. Findings

According to Paragraph 4(a) of the Policy, the Complainant has the burden of proving that:

- (i) the Disputed Domain is identical or confusingly similar to a trade mark or service mark in Hong Kong in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the Disputed Domain; and
- (iii) the Disputed Domain has been registered and is being used in bad faith.

(1) Identical/confusing similarity

The Panel accepts that the Complainant has rights in the ALAMO marks, based on its trade mark registrations in Hong Kong.

The Disputed Domain Name incorporates the Complainant's ALAMO trade mark in its entirety, save that it has added the descriptive word "car" and the ".hk" extension. It is well established that where the distinctive and prominent element of a disputed domain name is the complainant's mark, and the only addition is a generic term that adds no distinctive quality, then such a generic term does not negate the confusing similarity between the disputed domain name and the mark (see *Goyard St-Honoré v Ye Shi*, WIPO Case No. D2012-1178; *Monsoon Accesorize Limited v Zhang Qianqian*, *Fundacion Private Whois*, D2012-1689; *Diageo Ireland v. Guinnessclaim*, WIPO Case No. D2009-0679; *The Coca-Cola Company v. Whois Privacy Service*, WIPO Case No. D2010-0088). In this case, the generic word "car" does nothing to distinguish the Disputed Domain Name from the Complainant's ALAMO trade mark. In fact, the Panel finds that the use of the word "car" in the Disputed Domain Name serves only to increase the confusing similarity between the Disputed Domain Name and the Complainant's registered mark, since it is descriptive of the services provided by the Complainant under that mark.

It is also well-established that in making an enquiry as to whether or not a trade mark is identical or confusingly similar to a domain name, the domain extension, in this case “.hk”, should be disregarded (*Rohde & Schwarz GmbH & Co. KG v. Pertshire Marketing, Ltd*, WIPO Case No. D2006-0762).

The Panel accordingly finds that the Disputed Domain Name is confusingly similar to the Complainant's registered marks, and that paragraph 4(a)(i) of the Policy is satisfied.

(2) Rights or Legitimate Interests of Respondent

Pursuant to paragraph 4(d) of the Policy, the Respondent may establish rights or legitimate interests in the Disputed Domain Name by demonstrating any of the following:

- (i) before any notice to the Respondent of the dispute, the Respondent's use of, or demonstrable preparations to use, the Disputed Domain Name or a name corresponding to the Disputed Domain Name in connection with a bona fide offering of goods or services in Hong Kong;
- (ii) the Respondent has been commonly known by the Disputed Domain Name, even if the Registrant has acquired no trade mark or service mark rights in Hong Kong;
- (iii) the Respondent has trademark or service mark rights that are identical to the Disputed Domain Name; or
- (iv) the Respondent is making a legitimate non-commercial or fair use of the Disputed Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue.

The Panel accepts that the Respondent is not a licensee nor is it associated with the Complainant in any way that could give rise to any licence, permission or other right by which the Respondent could own or legitimately use the Complainant's ALAMO marks. The Panel further accepts that the Respondent has not provided any evidence to demonstrate rights to the Disputed Domain Name anywhere in the world or any evidence that it has become commonly known by the Disputed Domain Name.

The website to which the Disputed Domain Name resolves is a parking page that provides sponsored links and includes a message stating that the Disputed Domain Name is for sale. The Panel therefore finds that the Respondent has not been using the Disputed Domain Name in connection with a *bona fide* offering of goods or services, or for a legitimate non-commercial or fair use.

The Panel finds that the Respondent has no rights or legitimate interests in the Disputed Domain Name and that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

(3) Bad faith

It is well-established that registration of a domain name that is confusingly similar to a well-known trade mark by any entity that does not have a relationship to that mark can amount to sufficient evidence of bad faith registration and use (*Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co.*, WIPO Case No. D2000-0163). Given that the ALAMO mark was first registered in Hong Kong in 1992 and relates to a brand recognised all over the world, including in Asia, the Respondent is highly likely to have been aware of the reputation and business activities of the Complainant at the time the Disputed Domain Name was registered and thereafter. ALAMO is a distinctive term, and no explanation has been provided by the Respondent as to how the Respondent came up with the confusingly similar Disputed Domain Name. Given the distinctiveness of the term, it cannot be a

coincidence that the Disputed Domain Name incorporates the word "car" and the related searches and sponsored links that appear on the website to which the Disputed Domain Name resolves relate only to car rentals, the Complainant's line of business. Further, the website to which the Disputed Domain Name resolves also includes a link to the Complainant's website. The Panel finds that in the absence of any evidence to the contrary, the Respondent must have registered the Disputed Domain Name with the Complainant's mark in mind, in order to misdirect Internet users who are searching for the Complainant to the Respondent's parking page. Using a domain name to intentionally attract Internet users to a website for commercial gain, in an effort to trade on the Complainant's goodwill, is evidence of bad faith registration and use under the Policy (*Adobe Systems Incorporated v Domain OZ*, WIPO Case No. D2000-0057).

Lastly, the sponsored links on the Respondent's website appear to direct users to competitors of the Complainant. This acts as further evidence of bad faith use on the part of the Respondent (see *Villeroy & Boch AG v. Whois Data Shield/Hong Kong Names LLC*, WIPO Case No. D2008-1300 and *Nikon, Inc. and Nikon Corporation v. Technilab, Inc.*, WIPO Case No. D2000-1774).

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(iii) of the Policy.

6. Conclusions

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <alamocar.hk> be transferred to the Complainant.

Gabriela Kennedy, Sole Panelist

Dated 21 January 2015