

CANADIAN INTERNET REGISTRATION AUTHORITY

DOMAIN NAME DISPUTE RESOLUTION POLICY

COMPLAINT

Dispute Number: DCA-1555-CIRA
Domain Name: <alamocar.ca>
Complainant: Vanguard Trademark Holdings USA, LLC
Registrant: Essi Molesky
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 Essi Molesky (the “Registrant”). The Registrant’s address is 99 University Avenue, Kingston, Ontario, K7L 3N6.

B. The Domain Name and Registrar

3. The Domain Name at issue is: <alamocar.ca> (the “Domain Name”).
4. The Domain Name was registered on February 10, 2012.
5. The Registrar of the Domain Name is PublicDomainRegistry.com Inc.

C. Procedural History

6. On December 18, 2013, the Complainant submitted a complaint (the “Complaint”) with respect to the Domain Name 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 BCICAC confirmed compliance of the Complaint and the commencement of the dispute resolution process on December 19, 2013.
8. The BCIAC has advised that its attempts to provide notice to the Registrant have been unsuccessful and provided documentation of its delivery attempts, to the address and email provided by the Registrant, by post (returned) and email and that the emails were successfully delivered.

9. The Registrant did not submit a Response.
10. 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”).
11. On January 16, 2014, 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. The Panel was also appointed in DCA-1505-CIRA also involving Vanguard Trademark Holdings USA, LLC and Alamo trade-marks. Given the similarity of the two complaints the form of the analysis is also similar. The analysis and conclusion is has been arrived at afresh.

D. Factual Background

12. The unchallenged factual background as set out in the Complainant’s submissions is summarized in the following paragraphs.
13. The Complainant is the owner of at least two 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; and
 - (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.
14. 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.
15. The Complainant has also established a presence on the Internet with its websites. The Complainant’s licensees operate on-line car rental sites including: alamo.ca, alamocars.ca, and alamo.com.
16. The Registrant registered the Domain Name on February 10, 2012. The Domain Name is used as a “parked” webpage which contain advertisements and links to third-party websites, including competitors of the Complainant, under the heading “Related Links”.

E. Eligibility of Complainant

17. The Complainant is an eligible complainant under paragraph 1.4 of the Policy. The Complaint satisfies the Canadian Presence Requirements for Registrants because it relates to trade-marks registered in the Canadian Intellectual Property Office, which the Complainant is the registered owner, as particularized above.

F. Complainant's submissions

18. The Complainant submits that the Registrant registered the disputed Domain Name in an attempt to attract Internet users to its websites by creating a likelihood of confusion with the Complainant's Trade-Marks for commercial gain.
19. The Complainant asserts that the Domain Name include the Complainant's ALAMO Mark in its entirety and thus meets the standard to be considered confusingly similar.
20. The Complainant further asserts that it had rights to the Marks prior to the registration of the Domain Name, and continues to have rights, under the ALAMO, and ALAMO RENT-A-CAR Marks, and thus the Domain Name meets the standard under paragraph 3.1(a) of the Policy.
21. The Complainant further asserts that the Registrant has no legitimate interest in the Domain Name as described in paragraph 3.4 of the Policy. The Complainant adds that the Registrant has no registrations or pending applications for "alamocar". In addition, the Complainant has never licensed or authorized the Registrant to use the ALAMO or ALAMO RENT-A-CAR & Design marks.
22. Finally, the Complainant asserts that the Domain Name was 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. As such, it seeks the transfer of the Domain Name from the Registrant.

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, as described in 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.

The Complainant must also 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 ALAMO or ALAMO RENT-A-CAR & Design are “Marks” as defined 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 distinguishing factor between the Domain Name 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, that it would be likely mistaken for the Mark.
28. The Domain Name in this case includes the exact word component of at least one of the Trade-Marks. The Domain Name fully incorporates the Complainant’s Trade Marks, and accordingly fits the definition of Confusingly Similar as outlined in paragraph 3.3 of the Policy.
29. In addition, in *General Motors Acceptance Corporation v Bob Woods*, the arbitrator held:

"The fact that the whole of the distinctive element of the GMAC Marks, namely GMAC, is incorporated in the domain name is sufficient to support a finding of confusing similarity"¹.
30. Similarly, in this case, the subtraction of the letter “s” from “cars” to “car” in the Domain Name is merely a slight variation to the Trade-marks and does not preclude the finding that the Domain Name are Confusingly Similar.
31. The Complainant’s registration of the Trade-marks all pre-date the registration date of the Domain Name on February 10, 2012.
32. The Panel therefore finds that the Complainant has met its burden under paragraph 3.1(a) that the Registrant’s Domain Name is confusingly similar to a Mark in which the Complainant had rights prior to the date of registration of the Domain Name.

Bad Faith

33. The August 22, 2011 revision of the Policy 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:

¹ *General Motors Acceptance Corporation v. Bob Woods*, (January, 2006), B.C.I.C.A.C., CIRA Dispute No. 00051, page 5.

- (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 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.
34. The Complainant submits that the Registrant's registration supports a finding under paragraph 3.5(c) and (d) because the Domain Name is being used to attract users to its website through confusion with the Complainant's Marks. Moreover, the confusion is aimed at attracting traffic to its site and obtaining advertising revenue by posting links to third party websites and obtaining "click-through" fees when someone "clicks" on the link in the advertisement.
35. The Complainant further argues that the website is disrupting the business of the Complainant by containing a section which is labelled "Related Links" at the top of the web page. This section contains links to other car rental services which are competitors of the Complainant.
36. 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

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

37. Considering the evidence together, the Complainant has established on a balance of probabilities that the Registrant registered the Domain Name for the purpose of disrupting the business of the Complainant, and that, pursuant to paragraph 3.5 of the Policy, that the Registrant registered the Domain in bad faith.

Legitimate Interest

38. Paragraph 3.4 of the Policy lists six 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.
39. 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 Name. Although "some evidence" 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
40. 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

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

identify some of the factors outlined in the Policy but that nothing was found. A nil result in that case would meet the threshold of “some evidence”.

41. In its submissions the Complainant asserts that the Registrar does not have a legitimate interest in the Domain Name as the use of the Domain Name does not satisfy any of the criteria set out in Paragraph 3.4.
42. Pursuant to paragraph 3.4, 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 Registrant had a legitimate interest in the Domain Name.
43. 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

44. Similar assertions have been made by the Complainant in this case. At pages 5-6 of the Complaint the Complainant asserts:

Complainant has not licensed or authorized Essi Molesky to use “Alamocar” or “Alamo car” and Complainant has no relationship whatsoever with Essi Molesky...

...Neither Registrant nor anyone else has a trade-mark registration or pending application for “Alamocar” or “Alamo Car” in Canada...

...there are no trade-mark registrations or pending applications in Canada owned by anyone with the surname “Molesky”...

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

...A Google search of “Essi Molesky” only returns two references, both to the fact that “Essi Molesky” is listed in the WHOIS records for nordea.ca...

...A Google search for “‘Alamo Car’ in Canada” returns no references to “Essi Molesky”...

...the “99 University Avenue, Kingston ON K7L 3N6” address used by “Essi Molesky” is the address for Queen’s University in Kingston where there clearly is nothing named “Alamocar” or “Alamo Car”.

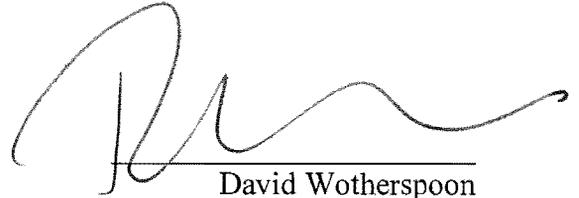
45. These assertions by the Complainant may be viewed as “some evidence” that the Registrant did not have Rights in the Mark or use the Marks in good faith.
46. A common sense inference and the absence of any evidence to the contrary suggests that there is no basis for a claim of legitimate interest based on the criteria in paragraph 3.4 (a), (b), (c), (d), (e) or (f).
47. The Domain Name is 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 Name containing the Complainants’ Trade-Marks is a generic name 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).
48. The nature of the “parked” webpage, which is designed to attract advertising revenue, 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).
49. Finally, there is no evidence which would suggest that the Domain Name makes 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. Accordingly, 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 Name.
50. Accordingly, the Panel finds that the Complainant has overcome the burden of presenting “some evidence” that the Registrant does not have a legitimate interest in the Domain Name.

H. Conclusion and Decision

51. The Panel finds that the Complainant has met the burden under paragraph 4.1 of the Policy.

52. The Panel accordingly finds that the Complainant has established its claim, and is entitled to the order that it seeks.
53. Given the above, the Panel orders that the Registrations for the following Domain Name be transferred to the Complainant:

<alamocar.ca>

A handwritten signature in black ink, appearing to read 'David Wotherspoon', written over a horizontal line.

David Wotherspoon
Sole Panelist
January 27, 2014