



DISPUTE RESOLUTION SERVICE

D00021933

Decision of Independent Expert

Vanguard Trademark Holdings USA LLC

and

Samuel Bessant

1. The Parties:

Lead Complainant: Vanguard Trademark Holdings USA LLC
Enterprise Holdings Inc
600 Corporate Park Drive
St Louis
Missouri
63105
United States of America

Respondent: Samuel Bessant
UNIT 8687
Cardiff
Mid Glamorgan
CF11 1NB
United Kingdom

2. The Domain Name:

alamohire.co.uk

3. Procedural History:

I can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of a such a nature as to call in to question my independence in the eyes of one or both of the parties.

07 October 2019 17:28	Dispute received.
09 October 2019 12:26	Complaint validated.
09 October 2019 12:40	Notification of complaint sent to parties.
28 October 2019 01:30	Response reminder sent.
29 October 2019 10:02	Response received.
29 October 2019 10:03	Notification of response sent to parties.
01 November 2019 01:30	Reply reminder sent.
01 November 2019 14:58	Reply received.
01 November 2019 15:04	Notification of reply sent to parties.
06 November 2019 14:55	Mediator appointed.
06 November 2019 16:40	Mediation started.
26 November 2019 17:20	Mediation failed.
26 November 2019 17:24	Close of mediation documents sent.
06 December 2019 01:30	Complainant full fee reminder sent.
09 December 2019 16:30	Expert decision payment received.

4. Factual Background

Most of this section is based on the Complaint, which was well evidenced. None of the content below is challenged by the Response.

The Complainant is a subsidiary of Enterprise Holdings Inc. (“Enterprise”) which, through a worldwide network, provides vehicle rental, leasing and transportation services under the Alamo Rent-A-Car brand.

The Complainant was acquired by Enterprise in 2007 and is the registrant of UK trademark No. 1278578 ALAMO, registered on December 2, 1998 for renting, leasing and hire services for vehicles in Class 39. The ALAMO mark has been used in the UK since at least February 2003 and is very well known in relation to the hire of vehicles.

The domain name <alamohire.co.uk> was registered on April 16, 2019.

By June 26, 2019 the domain name resolved to a website advertising vehicles for hire (“the Website”). That day the Complainant’s representative telephoned the mobile number shown on the Website, posing as a customer wishing to hire a car for the weekend. She was told by the woman who answered the call that the business had not yet launched as it had no vehicles and would be launching in the next few weeks.

On June 27, 2019, in response to a Data Release Request, Nominet informed the Complainant’s representative that the domain name was registered in the name Jo Featherby, with a postal address in Bristol and an Administrative Contact email address of adolfos_88@hotmail.com (“the Email Address”).

On July 12, 2019 the Complainant’s representative sent a cease and desist letter by email to the Email Address, by mail to Jo Featherby at that postal address and also by mail to Jerri Johnson, named on the Website as the CEO of Alamo Hire, at

the postal address appearing on the Website. Both letters sent by mail were returned as undeliverable.

On July 15, 2019 Mr. Johnson telephoned the Complainant's representative, acknowledged receipt of the cease and desist letter, denied infringement of the Complainant's ALAMO mark and, as noted by the Complainant's representative, said:

"Enterprise should obtain a domain name for every possible iteration of its trade marks to protect it, and it was foolish not to do that, and that his domain name could not possibly cause any damage to the Alamo business"

and made the suggestion:

"the only way to resolve this would be for Enterprise to buy the domain name and pay him some money for his expenses in designing and building the website, which were not insignificant."

Mr. Johnson transferred the call to his secretary. The Complainant's representative said she would seek the Complainant's instructions regarding Mr. Johnson's suggestion. The secretary said the best way to be in contact was through the Email Address.

On July 17, 2019 the domain name was transferred into the name of the Respondent in these proceedings, Samuel Bassant.

On July 18, 2019 Mr. Johnson telephoned the Complainant's representative, reiterated his suggestion and sought a response from the Complainant, without specifying a figure that he would accept.

On July 23, 2019 the Complainant's representative sent an email to the Email Address saying the Complainant declined to buy the domain name.

The Complaint was filed on October 7, 2019, naming Jo Featherby as the Respondent. This was notified to the parties on October 9, 2019.

The Case File contains the following note entitled "Registrant Information" dated November 26, 2019 by Mr. Tim Dalby of Nominet:

"The alamohire.co.uk domain name was registered on 16/04/2019 to "Jo Featherby" with an Administrative Contact email address of adolfos_88@hotmail.com, on 16/04/2019

The registration was transferred to "Samuel Bessant" on 17 July 2019 through the Registrar GoDaddy

On 31 October, the Administrative Contact details were changed , again through GoDaddy, so that we now hold an Administrative Contact of

Gianfranco Alemanno and an Administrative Contact email address of g_alemanno@hotmail.com.

Gianfranco Alemanno has been in contact with Nominet and claims to be the 'owner' of the domain name, but he is not the Registrant, and so we are unable to act on his authority.

Gianfranco Alemanno has advised the DRS Admin team that "Samuel Bessant" is an alias of a third party web designer - who may otherwise be called Eric, but who has not engaged in the DRS process."

The domain name is presently inactive.

5. Parties' Contentions

The Complainant (in summary)

The Complainant has valuable registered and unregistered (common law) rights in the word mark ALAMO. The domain name is closely and confusingly similar to its ALAMO trademark in that, leaving aside the top level domain element (.co.uk), it includes the full word mark ALAMO together with the word 'hire' which is the predominant focus of the Complainant's business.

The Respondent's registration of the domain name is an abusive registration.

The Respondent has no legitimate reason for registering the domain name as it does not have any relevant rights in ALAMO nor did it previously trade in vehicle rental services prior to registering the domain name and creating the Website; the Respondent is not affiliated with the Complainant in any way and never has been; the Respondent is not using the domain name for legitimate non-commercial or 'fair use' purposes and it is therefore implied that the domain name was registered for the purposes of selling, renting or otherwise transferring the domain name to the Complainant and/or as a blocking registration and/or to unfairly disrupt the Complainant's business; the Respondent is taking unfair advantage of the Complainant's rights and reputation it has built in its ALAMO brand and car rental business; the word ALAMO is not generic or a descriptive term and the Respondent would have no reason to select this name for its vehicle rental business.

The use of the domain name is detrimental to the Complainant's business. Customers or potential customers searching for the Complainant's business might inadvertently land on the Website and may be initially confused into believing they have arrived at the genuine Alamo website or a website that is affiliated with or endorsed by the Complainant.

The Respondent

The Response, in full, is as follows:

"Hello

A while ago now, I accepted and passed on payment to a web designer on the Fiver website for £99. Based on the condition the web designer would create a website for a potential client. The website domain name alamohire.co.uk ownership was transferred to myself (in my GoDaddy account) willingly from the client on the understanding that for us to offer such a low website build cost at £99, the client agreed to host their website with me along with the website designer from the Fiver website for a minimum term of two years. We accepted the transferral of the ownership from the client to me as an agreement to this.

However, a few months in something strange happened and it disappeared from my Godaddy dashboard! I used to have control along with ownership over this domain name (alamohire.co.uk) as I requested this to change the DNS server settings and comply with our two-year hosting agreement. We also host through Cloudflare for security, so as I am sure you are aware DNS access and ownership are also a must for security purposes.

For some strange reason, it disappeared... (Hence no supporting documents in my response aside from the original website backup files, I will not just upload them at this stage for anyone to acquire due to the poor way Godaddy has handled this matter thus far)

So in complete shock, I called Godaddy customer services. However, when I contacted GoDaddy by a telephone call to explain this, they were very dismissive and would not tell me where it was or anything further "Pending further investigation" were their exact words and the only response I received from them.

I can imagine you know more about this domain name at this point than I do?

To this day I have all my other domain names in my dashboard in Godaddy (even some showing up on the Nominet website such as northwalescarboncleaning.co.uk) but alamohire.co.uk has disappeared completely from my dashboard in Godaddy?

I would also like to add that when google.de was renewed by a third party, google had to buy that domain name from the new owner. I advise anyone in similar situations in order to protect their brand they should consider buying all available domain names. This I am fully open to, in order to cover costs concerned as explained above. This is also why I think the complaint should not succeed aside from the option explained above.

Kind Regards

Samuel Bessant"

The Complainant's Reply

At the time of submitting the Complaint, the Complainant understood that the registrant of the domain name was Ms Jo Featherby which was obtained through a Data Release Request.

However the Response has been submitted by Mr Samuel Bessant who states that he is the registrant of the domain name, which he acquired "a while ago". The Complainant therefore submits that the Expert should disregard the Response. If he/she is not minded to do so, the Complainant makes the following observations.

Mr Bessant's Response claims that the domain name was transferred to him in respect of a website creation that a "web designer" was planning to create for a "potential client". No evidence is submitted to support the contention that Mr Bessant runs such a business. Neither the client nor the web designer is identified and Mr Bessant does not elucidate on what his relationship is with either individual or with the domain name. It is not clear to the Complainant who is the genuine owner of the domain name, be it Mr Johnson, Ms Featherby, Mr Bessant or another unknown individual with whom the Complainant's lawyer spoke during July 2019. This all appears to be highly suspicious and the Complainant raises serious concerns over the identity of the registrant and that the domain name appears to have been transferred to prevent the Complainant from obtaining it.

The registrant of a domain name is bound by the Nominet Terms and Conditions of Domain Name Registration (the "Terms and Conditions") of which paragraph 6 requires the registrant to provide a promise and indemnity not to "infringe the intellectual property rights (for example, trade marks) of anyone else" and not to "use the domain name for any unlawful purpose".

It is clear from paragraph 6 that the registrant has a responsibility for the domain name not to infringe third party rights, whether he originally bought the domain name or it was transferred to him latterly. The Complainant asserts that the Respondent is in breach of this paragraph.

The Complainant's position is that Mr Bessant does not fully explain how or why he became the registrant of the domain name, and pertinently, he does not demonstrate a legitimate reason pursuant to paragraph 8 of the Nominet Dispute Resolution Service Policy (the "Policy") as to why the domain name is not an abusive registration nor has he provided any alternative evidence of this.

Specifically, the Respondent has not provided any reason why he should own and/or use a domain name containing the brand name ALAMO which is used in relation to the hire of vehicles. He also has not provided anything to support his explanation regarding the alleged "website creation" he was involved in or why he was transferred the domain name, and accepted the transfer, presumably knowing that ALAMO was an international vehicle hire company which would be protected by trade mark registrations.

Further, pursuant to paragraph 8.1.2 of the Policy, the domain name is not generic or descriptive and the Respondent cannot rely on this paragraph to resist transfer of the domain name to the Complainant. It is the Complainant's position that the Respondent has not rebutted the presumption of the domain name being an abusive registration and there is no good or genuine reason why the Respondent should retain this domain name.

In the final paragraph of the Response Mr Bessant comments that Google was once required to buy google.de from a third party to protect its brand and appears to suggest that the Complainant should do the same and purchase the domain name from him. This statement appears to reveal his true position concerning the domain name and that he is seeking to profit from owning the domain name, despite being unable to demonstrate any legitimate reason as to how he has come to own it.

In conclusion, the Complainant's position is that the Respondent does not fully explain how or why he became the registrant of the domain name, he is in breach of the Terms and Conditions in respect of his ownership of the domain name and he does not demonstrate a legitimate reason pursuant to paragraph 8 of the Policy as to why the domain name is not an abusive registration. The Respondent's true identity remains a mystery and this further highlights the suspicious behaviour of the individual(s) behind the domain name.

6. Discussions and Findings

The Expert is disposed to take into account the Response and the Complainant's Reply.

To succeed under the Policy, the Complainant must prove on the balance of probabilities both that it has Rights in respect of a name or mark that is identical or similar to the domain name and that the domain name is an Abusive Registration in the hands of the Respondent.

Identity/similarity

The Expert finds the domain name <alamohire.co.uk> to be similar to the Complainant's registered UK trademark No. 1278578 ALAMO, registered on December 2, 1998 for renting, leasing and hire services for vehicles in Class 39. The addition of the word "hire" to the ALAMO mark does nothing to detract from the distinctiveness of the Complainant's ALAMO mark, which is well-known in the field of vehicle hire. See DRS 06973 veluxblind.co.uk: "The Domain Name consists of the Complainant's distinctive trademark and the descriptive word "blind", which does nothing to distinguish the Domain Name from the mark, since the mark is associated in the public mind with the Complainant's blinds."

Abusive registration

Abusive Registration is defined in the Policy, paragraph 1 as 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) is being or has been used in a manner which took unfair advantage of or has been unfairly detrimental to the Complainant's Rights.

The domain name <alamohire.co.uk> was registered on April 16, 2019 in the name Jo Featherby. It is clear from the Factual Background set out above that by June 26, 2019 the domain name in the hands of Jo Featherby was an Abusive Registration because it resolved to the Website advertising vehicles for hire and was thus being used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights in the ALAMO trademark.

However, as at the date of the filing of the Complaint, the domain name was registered in the name Samuel Bessant. The true identity of the registrant is uncertain, given the claim made to Nominet by the newly appointed Administrative Contact, Gianfranco Alemanno to be the 'owner' of the domain name, and his assertion that "Samuel Bessant" is an alias of a third-party web designer, who may otherwise be called Eric.

Despite this uncertainty, since the Response was filed in the name of Samuel Bassant, the Expert chooses to proceed on the basis that, whoever Samuel Bassant may be, he is to be taken to be the Respondent for the purposes of this proceeding.

The circumstances pertaining to the transfer of the domain name registration into the name of Samuel Bassant lead the Expert to conclude, on the balance of probabilities, that the transfer was made in an attempt to escape the consequences of the domain name being an Abusive Registration in the name of Jo Featherby and that Samuel Bassant, whether a real or fictitious person, is effectively under the control of Jerri Johnson, the person named on the Website as the CEO of Alamo Hire.

The facts on which the Expert bases this conclusion are as follows:

- (a) on July 15, 2019, Jerri Johnson, in responding to the Complainant's cease and desist letter
 - (i) described the domain name as "his domain name";
 - (ii) suggested that the Complainant "should obtain a domain name for every possible iteration of its trade marks to protect it, and it was foolish not to do that"; and
 - (iii) suggested that "the only way to resolve this would be for Enterprise to buy the domain name and pay him some money for his expenses in designing and building the website, which were not insignificant";

- (b) these suggestions were repeated in substance by Samuel Bassant in the Response, set out above;
- (c) the domain name was transferred into the name of Samuel Bassant two days later, on July 17, 2019;
- (d) on July 18, 2019, the day after this transfer, Jerri Johnson sought a response to his suggestion that the Complainant buy the domain name;
- (e) if the transfer had been genuine and not a contrivance to escape an adverse finding in this proceeding, Jerri Johnson, who claimed to be the owner of the domain name before the transfer, could not have been in a position to sell the domain name to the Complainant or anyone else;
- (f) the Response in the name of Samuel Bassant, set out in full above, provides support for the conclusion that control of the domain name remains undisturbed despite the change in the name of the registrant, in that:
 - (i) such a conclusion is consistent with the explanation in the Response that the domain name was transferred to Samuel Bassant on the understanding that the transferor agreed to host its website with Samuel Bassant and a website designer for a minimum term of two years;
 - (ii) the new contact person for the domain name since October 31, 2019, Gianfranco Alemanno, claims to be the 'owner' of the domain name and says that "Samuel Bessant" is an alias of a third-party;
 - (iii) Gianfranco Alemanno's comments to Nominet that anyone in similar situations "in order to protect their brand...should consider buying all available domain names" and "This I am fully open to, in order to cover costs concerned as explained above" mirror the suggestions made by Jerri Johnson on July 15, 2019 to the Complainant's representative.

If however the transfer of the domain name to Samuel Bassant was genuine and, since then, it has not been used, for the following reasons the Expert concludes, on the balance of probability, that the domain name is an Abusive Registration in the hands of the Respondent, Samuel Bassant.

Citing the Court of Appeal decision in *BT v One In A Million* [1999] 1 WLR 903, the Dispute Resolution Service – Experts' Overview Version 3 at paragraph 3.3 notes that:

"the English Courts have clearly held that mere registration of a domain name can constitute unfair use of a domain name for the purposes of passing off and trade mark infringement, even if nothing more is done with

the domain name. The prevailing approach under the DRS is consistent with this.

Commonly, Internet users will visit web sites either by way of search engines or by guessing the relevant URL. If the domain name in dispute is identical to the name of the Complainant and that name cannot sensibly refer to anyone else, there is bound to be a severe risk that a search engine, which is being asked for the Complainant, will produce high up on its list the URL for the web site connected to the domain name in issue. Similarly, there is bound to be a severe risk that an Internet user guessing the URL for the Complainant's web site will use the domain name for that purpose.

In such cases, the speculative visitor to the registrant's web site will be visiting it in the hope and expectation that the web site is a web site "operated or authorised by, or otherwise connected with the Complainant." This is what is known as 'initial interest confusion' and the overwhelming majority of Experts view it as a possible basis for a finding of Abusive Registration, the vice being that even if it is immediately apparent to the visitor to the web site that the site is not in any way connected with the Complainant, the visitor has been deceived."

Apart from the inconsequential ccTLD ".co.uk", the domain name comprises the Complainant's well-known ALAMO trademark and the word "hire", which describes the Complainant's business. Internet users are likely to be confused by the mere registration of the domain name into wondering whether it belongs to or is otherwise associated with the Complainant in the manner described above in the Overview, whether or not the domain name resolves to a website.

Further, the Policy, paragraph 5.1 provides that a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration includes:

- 5.1.2 Circumstances indicating that the Respondent is ... threatening to use the Domain Name in a way which ... is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant.

Based on the domain name's similarity to the Complainant's ALAMO mark and the widespread public recognition of that mark in connection with the hire of vehicles, Samuel Bassant's stated plan to host a website for the domain name together with the transferor and the website designer constitutes such a threat.

The claim that the domain name mysteriously disappeared from the Respondent's dashboard in GoDaddy is irrelevant to the issues to be decided in this proceeding.

Hence the Expert concludes that the domain name was registered or otherwise acquired by Samuel Bassant on July 17, 2019 in a manner which, at the time when the registration or acquisition took place, took unfair advantage of the Complainant's Rights.

7. Decision

For the reasons set out above, I determine that the Domain Name <**alamohire.co.uk**> be transferred to the Complainant.

Signed Alan Limbury Dated: January 3, 2020