

DISPUTE RESOLUTION SERVICE

DRS 17902

Decision of Independent Expert

Complainant, Enterprise Holdings, Inc.

and

Leszek Tomczakowski LTD

1. The Parties:

Complainant: Enterprise Holdings, Inc.
600 Corporate Park Dr
St. Louis
Missouri
63105
United States

Respondent: Leszek Tomczakowski LTD
100 Regent Court
Aberdeen
Aberdeenshire
AB24 1ZS
United Kingdom

2. The Disputed Domain Names:

<enterprise-car.co.uk>
<enterprise-car.uk>
<enterprise-carrental.uk>

3. Procedural History:

The Complaint was filed with Nominet on 27 August 2016. Nominet validated the Complaint on 30 August 2016 and notified the Respondent by post and by email, stating that the Response had to be received on or before 20 September 2016. The Response was filed on 20 September 2016. Nominet notified the Response to the parties on the same day. Nominet notified the Complainant that a Reply had to be received on or before 28 September 2016. A Reply was received on 27 September 2016 and the mediator was appointed on the same day.

The Informal Mediation procedure failed to produce an acceptable solution for the parties and so on 3 November 2016 Nominet informed the Complainant that it had until 7 November 2016 to pay the fee for the decision of an Expert pursuant to paragraph 7 of the Nominet Dispute Resolution Service Policy ("the Policy"). On 7 November 2016 the Complainant paid Nominet the required fee.

On 16 November 2016 the undersigned, David Taylor ("the Expert"), confirmed to Nominet that he was independent of each of the parties and that, to the best of his knowledge and belief, there were no facts or circumstances, past or present (or that could arise in the foreseeable future) that needed to be disclosed as they might be of such a nature as to call in to question his independence in the eyes of one or both of the parties.

4. Factual Background

The Complainant, Enterprise Holdings, Inc., is a vehicle rental company operating its business under the ENTERPRISE and ENTERPRISE RENT-A-CAR marks in the United States since 1969 and under the ENTERPRISE CAR HIRE, ENTERPRISE and ENTERPRISE RENT-A-CAR marks in the United Kingdom since 1994. The Complainant has supplied evidence that it owns the following trade mark registrations in connection with car rental services (class 39):

- United Kingdom Registration No. 1541740, for ENTERPRISE registered on 4 October 1996;
- United Kingdom Registration No. 2369976, for ENTERPRISE CAR HIRE, registered on 4 February 2005;
- United Kingdom Registration No. 2507036, for ENTERPRISE RENT-A-CAR registered on 1 May 2009 ;
- European Union Trade mark Registration No. 0036384, for ENTERPRISE, registered on 1 December 1998; and

- European Union Trade mark Registration No. 5323134, for ENTERPRISE RENT-A-CAR, registered on 23 August 2007.

The Complainant operates its business through the website 'www.enterprise.co.uk' (the domain name <enterprise.co.uk> was registered before August 1996), to which the domain names <enterprisecarrental.co.uk>, <enterprisecarrental.uk>, <enterprisecar.co.uk>, and <enterprisecar.uk> resolve.

The Disputed Domain Names were registered by the Respondent on 18 July 2015 and are not resolving.

5. Parties' Contentions

Complaint

The Complainant states that it is one of the largest vehicle rental companies in the world with annual revenues in excess of £15 billion. The Complainant further states that it has operated its car rental business under its ENTERPRISE marks, as outlined above, in the United States since 1969 and in the United Kingdom since 1994. The Complainant explains that its licensee, Enterprise Rent-a-Car UK Ltd., currently has over 300 branches in the United Kingdom and accepts car rental reservations via the website 'enterprise.co.uk'.

The Complainant states that the Disputed Domain Names are highly similar to its ENTERPRISE marks as they fully incorporate the ENTERPRISE trade mark, merely adding "-car" and "-carrental", which merely describe Complainant's business. The Complainant asserts that the addition of any punctuation marks to a domain name is not sufficient in itself to render the Disputed Domain Names distinctive. The suffixes ".uk" and ".co.uk" are discounted for the purposes of the similarity between a domain name and a trade mark in which a complainant has rights.

The Complainant asserts that the Disputed Domain Names, in the hands of the Respondent, are Abusive Registrations.

The Complainant asserts that the Disputed Domain Names were clearly registered with the Complainant in mind. In this regard, the Complainant argues that it is inconceivable that the Respondent was unaware of the existence of the Complainant and its Rights at the time of registration of the Disputed Domain Names as the Complainant was one of the largest car rental companies in the world and its licensee in the UK, Enterprise Rent-a-Car UK Ltd., was one of the largest car hire or rental companies in the UK. Furthermore, the Complainant asserts that there are four ENTERPRISE RENT-A-CAR locations in the Aberdeen area where the Respondent is located. The Complainant thus argues that the Respondent registered the Disputed Domain Names with full knowledge of the existence of the Complainant in a manner which, at the time when the registration took place, took unfair advantage of, or was unfairly detrimental to, the Complainant's Rights.

The Complainant further asserts that, although the Disputed Domain Names are not active, they have been used in a manner which takes unfair advantage of or is unfairly detrimental to the Complainant's rights. The Complainant argues that because of their similarity to the Complainant's mark and its other domain names, the Disputed Domain Names are likely to be associated with the Complainant. The Complainant states that visitors to the websites at the Disputed Domain Names may well consider that the Complainant's official webpage is no longer in operation. The Complainant argues that the Disputed Domain Names causes initial interest confusion amongst internet users as to the identity of the person or entity behind the Disputed Domain Names. The Complainant relies on *BT v. One in A Million* [1999] 1 WLR 903 and argues 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, and that the DRS Policy is consistent with this approach.

The Complainant also asserts that the Disputed Domain Names are being used for the purpose of disrupting its business as the fact that the Disputed Domain Names are inactive may lead a reasonable person to believe that the Complainant does not have an active UK website.

The Complainant further argues that there is no other explanation as to why the Respondent selected the Disputed Domain Names other than to cause initial interest confusion with the purpose of profiting from the Complainant's Rights, whether by selling the Disputed Domain Names or placing advertisements on the associated websites. The Complainant asserts that the Disputed Domain Names are intended to catch members of the public who know of the Complainant but are unsure of the Complainant's address for its UK website.

The Complainant also asserts that there is a threat that the Respondent will use the Disputed Domain Names for email purposes.

Finally, the Complainant asserts that there is no good faith explanation for the Respondent's registration and use of the Disputed Domain Names. The Complainant states that there is nothing to suggest that the Respondent is operating a business or is otherwise known as "Enterprise Car" or "Enterprise Car Rental" and there is no evidence to suggest that there is any legitimate basis for the Respondent's registration and use of the Disputed Domain Names, as they are not currently used for a genuine offering of goods or services, there is no evidence that the Respondent is commonly known by the Disputed Domain Names and there is no evidence to suggest any other legitimate non-commercial or fair use by the Respondent for the Disputed Domain Names.

Response

The Respondent responded that he was not using nor intended to use the Disputed Domain Names "in any areas restricted or patented by the Complainant" and that he

"was thinking [of] using these domains for children toys website but for now I just want [to] hold [them]."

The Respondent refuses to transfer the Disputed Domain Names to the Complainant or any other entity. The Respondent argues that it does not make sense that the Complainant should obtain the transfer of any domain name including the words "enterprise" and/or "car" and believes that this cannot be judged by Nominet.

Reply

The Complainant points out that the Respondent has failed to contradict the assertion that the Disputed Domain Names were registered with the Complainant in mind (especially in view of the proximity of the Respondent's location to the Complainant's business), and that any use of the Disputed Domain Names by the Respondent will be abusive and unfairly detrimental to the Complainant's trademarks rights. Specifically, the Complainant argues that the Respondent has failed to:

- provide a reasonable explanation for the Respondent's choice for the Disputed Domain Names;
- deny knowledge of the existence of the Complainant and its facility near the Respondent's location at the time of registration of the Disputed Domain Names;
- explain how the Disputed Domain Names could possibly relate to children's toys; or
- provide any credible evidence of the Respondent's ability to manufacture or distribute children's toys or any expertise regarding children's toys that might be used in connection with a web site for children's toys.

6. Discussions and Findings

General

Under paragraph 2 of the DRS Policy, for the Expert to order a transfer of the Disputed Domain Names, the Complainant is required to demonstrate, on the balance of probabilities, both of the following elements:

"(i) The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and

(ii) The Domain Name, in the hands of the Respondent, is an Abusive Registration."

Complainant's Rights

The Policy defines "Rights" as "*rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning*".

The Complainant asserts Rights in the Disputed Domain Name based on the Complainant's registered trade mark rights in the terms ENTERPRISE CAR HIRE, ENTERPRISE and ENTERPRISE RENT-A-CAR in connection with car rental services. The Complainant has supplied evidence of its registered trade mark rights by providing the Expert copies of its UK and EU trade mark registrations and so the Expert is satisfied that the Complainant has Rights which are enforceable under English law in respect of the terms ENTERPRISE CAR HIRE, ENTERPRISE and ENTERPRISE RENT-A-CAR.

The Policy also requires the Expert to examine whether the name or mark in which the Complainant has Rights is identical or similar to the Disputed Domain Names. The Disputed Domain Names identically reproduce the Complainant's ENTERPRISE trade mark with the mere addition of the terms "-car" and "-carrental" (separated by a hyphen), which are descriptive of the goods and services for which the Complainant's trade marks have been registered. The Expert finds that the addition of such terms does not detract from the trade mark in the Disputed Domain Names but rather increases the similarity with the Complainant's ENTERPRISE marks given that the Complainant is in the car rental business.

It is well-established that the ".uk" and ".co.uk" suffix may be disregarded for the purpose of assessing identity or similarity between a trade mark and a disputed domain name, as it is a functional element, and so the Expert finds that the Complainant's trade mark and the Disputed Domain Names are similar.

The Expert therefore finds that the Complainant has Rights in respect of a mark which is similar to the Disputed Domain Names, in accordance with paragraph 2(a)(i) of the Policy.

Abusive Registration

Moving on to paragraph 2(a)(ii) of the Policy, "Abusive Registration" is defined in paragraph 1 of the Policy to mean 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) has been used in a manner, which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights."

As to (i) above, the Expert is convinced that the Respondent registered the Disputed Domain Names with the Complainant's trade mark in mind. See DRS 4331

(<verbatim.co.uk>)(finding that some knowledge of the complainant or its name/brand is a pre-requisite for a successful complaint under the DRS Policy).

First, the nature of the Disputed Domain Names themselves, which identically reproduce the Complainant's trade mark with the addition of terms that are descriptive of the goods and services for which the Complainant's trade marks have been registered, strongly suggests that the Respondent had knowledge of the Complainant's Rights at the time of registration of the Disputed Domain Names. The Respondent appears to argue that the Disputed Domain Names consist of generic terms and that therefore it does not make sense that a domain name composed of the terms "enterprise" and/or "car" would refer to the Complainant. The Expert is not persuaded by the Respondent's argument. Whilst the terms "enterprise" and "cars" by themselves may be generic, together they have no other meaning except in relation to the Complainant. It is therefore clear that the Respondent was targeting the Complainant at the time of registration of the Disputed Domain Names.

Second, the Complainant has put forward evidence that it conducts its business in the area where the Respondent is located, and the Respondent has not denied knowledge of the Complainant or its Rights at the time of registration of the Disputed Domain Names.

Third, the Respondent claimed that he was not using, nor intended to use, the Disputed Domain Names "in any areas restricted or patented by the Complainant" and asserted without support that he was thinking of using the Disputed Domain Names for "children toys website but for now I just want [to] hold [them]." The Expert is not persuaded by the Respondent's explanation for registering the Disputed Domain Names. The Respondent has not only failed to provide any evidence to support its claim, the Expert finds that the Respondent's explanation is simply not credible and that it is merely an attempt to seek to justify the Respondent's choice of the Disputed Domain Names. The Expert therefore finds that the Respondent had knowledge of the Complainant's Rights at the time of registration of the Disputed Domain Names and that, given the nature of the Disputed Domain Names themselves, it is reasonable to infer that the Respondent registered them seeking to somehow take advantage of the Complainant's Rights as the Disputed Domain Names have no other meaning except in relation to the Complainant.

As to (ii) above, the Disputed Domain Names are not resolving. Paragraph 3(a)(ii) of the Policy expressly provides that evidence of a threatened use may constitute evidence of an abusive use: "*circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or 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*". The Expert therefore finds that, given the nature of the Disputed Domain Names (which can have no other meaning except in relation to the Complainant), the Respondent's non-use of the Disputed Domain Names constitutes a threat hanging over the head of the Complainant that amounts to Abusive Registration within the meaning of the Policy, as internet users will likely be misled into thinking that the Disputed Domain

Names are registered to, operated or authorised by the Complainant, when in fact they are not. See paragraphs 1.3 and 3.3 of the Experts' Overview and DRS0658 (<chivasbrothers.co.uk>).

Finally, paragraph 4 of the Policy provides a non-exhaustive list of circumstances which may be evidence that the Disputed Domain Names are not an Abusive Registration. None of those circumstances would seem to assist the Respondent. As discussed above, the Respondent has failed to explain how the Disputed Domain Names could possibly relate to children's toys and provide evidence to support its claim for its intended use of the Disputed Domain Names and so the Expert is not convinced by the Respondent's explanation. The Respondent also appears to suggest that it is entitled to retain the Disputed Domain Names as long as it is not using them. However, as discussed above, the passive holding of a domain name may constitute Abusive Registration under the Policy particularly where, as in the present case, the complainant's trade mark is well-known (see paragraph 1.3 of the Experts' Overview).

In conclusion, the Expert has considered the admissibility, relevance, materiality and weight of the evidence as a whole and is satisfied that the Complainant has succeeded in proving, on the balance of probabilities, that the Disputed Domain Names are an Abusive Registration in accordance with paragraph 2(a)(ii) of the Policy.

7. Decision

The Expert finds that the Complainant has Rights in trade marks which are similar to the Disputed Domain Names, and that the Disputed Domain Names, in the hands of the Respondent, are an Abusive Registration. The Disputed Domain Names should therefore be transferred to the Complainant.

Signed: David Taylor

Dated: 12 December 2016