

## **ADMINISTRATIVE PANEL DECISION**

Vanguard Trademark Holdings USA LLC v. Ali Arefi

Case No. DIR2024-0001

### **1. The Parties**

The Complainant is Vanguard Trademark Holdings USA LLC, United States of America ("United States"), represented by Saba & Co. Intellectual Property s.a.l. (Offshore) Head Office, Lebanon.

The Respondent is Ali Arefi, Iran (Islamic Republic of).

### **2. The Domain Name and Registrar**

The disputed domain name <alamo.ir> is registered with IRNIC.

### **3. Procedural History**

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the "Center") on January 18, 2024. On the following day, the Center transmitted by email to IRNIC a request for registrar verification in connection with the disputed domain name. On the same day, IRNIC transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details. In response to a request from the Center, IRNIC confirmed the date of creation of the disputed domain name and the date of its registration by the current registrant on January 23, 2024. Hard copies of the Complaint were received by the Center on January 29, 2024.

The Center verified that the Complaint satisfied the formal requirements of the .ir Domain Name Dispute Resolution Policy (the "irDRP"), the Rules for .ir Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for .ir Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on February 1, 2024. In accordance with the Rules, paragraph 5(a), the due date for Response was February 21, 2024. The Response was filed with the Center in English on February 18, 2024.

The Center appointed Matthew Kennedy as the sole panelist in this matter on February 26, 2024. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

#### 4. Factual Background

The Complainant is a car rental agency based in the United States that operates in North America, South America, Europe, Asia, and the Pacific. The Complainant owns multiple trademarks, including the following:

- International trademark registration number 1180169 for ALAMO, registered on September 26, 2013, designating multiple jurisdictions, including Iran;
- International trademark registration number 1189753 for ALAMO and device, registered on September 26, 2013, designating multiple jurisdictions, including Iran;
- Iranian trademark number 336610 for the term ALAMO in Arabic script, registered on August 17, 2019; and
- Iranian trademark number 438036 for the term ALAMO in Arabic and Latin scripts, registered on October 19, 2022.

All the above trademark registrations specify services in class 39 and all are current. The Complainant has also registered the domain name <alamo.com> that it uses in connection with a website where it offers online vehicle rental. The site prominently displays the Complainant's ALAMO and device mark.

The Respondent is a software developer based in Iran.

The disputed domain name was acquired by the Respondent on October 15, 2020. It resolves to a website in Persian that promotes software described as Smart Human Resources Management for Organizations offering smart and powerful control of various resources of companies and organizations in a centralized and comprehensive manner. The site displays the word "Alamo" in the top right hand corner in Latin script without any device. The homepage is linked to a login page for members. It is not possible to view any other part of the site without logging in.<sup>1</sup>

According to evidence presented by the Respondent, certain third parties have registered trademarks in Iran that incorporate the term "Alamo" in Latin or Arabic script. These include Iranian trademark number 250771 for ALAMO in Arabic and Latin scripts, registered on January 21, 2016, specifying goods and services in classes 5 and 35; Iranian trademark number 264331 for ABN ALAMO in a fancy script, registered on August 2, 2016, specifying goods and services in classes 5 and 35; and Iranian trademark number 298281 for ALAMO in Arabic script with a device, registered on August 12, 2017, specifying goods in classes 29 and 30.

The Complainant's representative sent a cease-and-desist letter dated May 15, 2023 to the Respondent's IRNIC-verified email address, seeking a transfer of the disputed domain name. On November 11, 2023, the Complainant obtained confirmation from IRNIC that the Respondent was still the registrant of the disputed domain name. There is no evidence that the Complainant queried or misspelt the Respondent's email address. On January 18, 2024, the Complainant sent a copy of the Complaint to the Respondent's IRNIC-verified email address. On the following day, the Respondent replied using a slightly different email address (with a stop added in the username), in which he disagreed with the Complaint. The Response was filed from the latter email address as well.

IRNIC confirmed that the language of the Registration Agreement for the disputed domain name is English.

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<sup>1</sup> The Panel recalls its general powers under paragraphs 10 and 12 of the Rules and has visited the website associated with the disputed domain name, which is publicly available, in order to verify the Parties' respective assertions regarding the content of that website. The Panel considers this limited research useful in evaluating the merits of this case and reaching a decision. Given the similarity of the irDRP and the Uniform Domain Name Dispute Resolution Policy ("UDRP") in this respect, the Panel notes that this is consistent with panels' practice under the UDRP. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.8.

## 5. Parties' Contentions

### A. Complainant

The disputed domain name is identical to the Complainant's ALAMO mark.

The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent has no authorization to use the Complainant's ALAMO name and mark. The Respondent is not an authorized distributor of the Complainant. There is no business relationship whatsoever between the Parties.

The disputed domain name was registered and is being used in bad faith. Given that the Complainant had already registered its mark in Iran, it is very likely that the Respondent must have been aware of the Complainant's mark and products at the time of registering the disputed domain name. The disputed domain name blatantly appropriates the Complainant's trademark. Any Internet user familiar with the term "Alamo" would likely, upon encountering the disputed domain name or visiting the associated website, presume an association with the Complainant's business in Iran or, at the very least, believe that it was authorized by the Complainant to local parties in that country. The associated website is operational and promotes software products. The Respondent is using the ALAMO trademark in the disputed domain name and website to capitalize on the recognized status of the ALAMO trademark, thereby misleading the public. This creates the impression that the website is either operated or authorized by the Complainant. The Respondent also failed to respond to the warning letter sent by the Complainant's representative.

### B. Respondent

The Respondent is a software developer who is using ALAMO in relation to computer and scientific services in class 42 whereas the Complainant is a rental car agency that registered ALAMO only in respect of vehicle rental services in class 39. There is no confusing similarity between these products. There is no word or picture about any car, vehicle, rental service, or travel service on the Respondent's website. The website clearly states that it is about software for human resources management. It is not confusingly similar to the Complainant's marks in class 39 and does not redirect to any other website similar to class 39.

The Respondent has rights or legitimate interests in respect of the disputed domain name. There are at least 3 obvious similarities between the Respondent's name and "alamo" and 2 obvious similarities with the Respondent's product: "A" as in Ali, "L" as in Ali, "A" as in Arefi and "MO" as in "management organization". The Respondent is using ALAMO for computer and scientific services in class 42. ALAMO is registered in classes 3, 5, 29, 30, 35, and 39 in Iran. The Respondent is free to register and use it in class 42. The Respondent and his product are commonly known by the disputed domain name in Iran. "Alam" is a common name in Persian, the language of the country where he is doing business. "Alam" has two pronunciations in Persian and two meanings related to the Respondent's product. First, "عالم" (pronounced /'ɑ:læm/) which means "world, universe, cosmos", adding the suffix "o" adds attention, surprise, or interest to it. The Respondent is using ALAMO for his software about human resource management to announce that it will run and work from anywhere. Second, "آلم" (pronounced /'ɑ:lɑ:m/) which means "trouble, pain, hurt", adding the suffix "o" adds attention, surprise, or interest to it. The Respondent is using ALAMO for his software to announce that although human resources management is full of troubles and painful, the Respondent's product makes it easy and without any trouble.

The disputed domain name has not been registered and is not being used in bad faith. The Complainant's prior trademark registration is completely irrelevant because it is only in class 39, whereas "آلامو" (i.e., ALAMO) has been registered in five other classes by Iranian companies without any conflict or misleading. ALAM has two pronunciations and meanings in Persian. As "Alamo" is common in the Persian language, many companies in Iran use it in their businesses. The Respondent is using "عالمو" or "آلامو" (i.e., ALAMO) for software for human resources management. How can a website promoting such software confuse the users of car rental or travel services. The Respondent's website clearly states that it is about software with the name "Smart Human Resources Management for Organizations" and the pictures show it is about human

resources management. The Complainant claims that the Respondent did not respond to a warning letter sent on May 15, 2023 but they asked IRNIC for his email address on November 11, 2023 so perhaps they misspelt his email address. The Respondent replied to the Complainant's letter on January 19, 2024, one day after it received the email. The Respondent is using the disputed domain name for his product and not for the purpose of selling it to a competitor of the Complainant nor to prevent the Complainant from reflecting the mark at all. The Parties are not competitors; their areas of business are completely different. The Respondent never attempted to attract, for commercial gain, Internet users to his website.

## 6. Discussion and Findings

Paragraph 4(a) of the irDRP provides that the complainant must prove each of the following elements:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- (ii) the respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered or is being used in bad faith.

### A. Identical or Confusingly Similar

Based on the evidence submitted, the Panel finds that the Complainant has rights in the ALAMO mark.

The disputed domain name wholly incorporates the ALAMO mark. Its only additional element is the country-code Top-Level Domain ("ccTLD") extension of Iran (Islamic Republic of), i.e., ".ir". As a standard requirement of domain name registration, this element may be disregarded in the assessment of identity or confusing similarity for the purposes of the irDRP. See, for example, *7-Eleven, Inc. v Seyed Amir Shahab Soleimani*, WIPO Case No. [DIR2020-0010](#). Accordingly, on a side-by-side comparison, the disputed domain name is identical to the Complainant's ALAMO mark.

The Respondent submits that there is no confusing similarity between the Parties' respective products. The Panel recalls that the first element of the irDRP calls for an assessment of identity or confusing similarity between the disputed domain name and the Complainant's mark, not the Parties' respective products or services. This issue may nonetheless be considered relevant to the other elements of the irDRP. See, for example, *Tejarat Khalagh Hadaf (PSJ) v. Zahra Kolivand*, WIPO Case No. [DIR2023-0003](#).

Therefore, the Panel finds that the first element of the irDRP has been satisfied.

### B. Rights or Legitimate Interests

Paragraph 4(c) of the irDRP sets out the following circumstances which, without limitation, if found by the panel, shall demonstrate that the respondent has rights to, or legitimate interests in, a disputed domain name, for the purposes of paragraph 4(a)(ii) of the irDRP:

- (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; or
- (ii) [the respondent] (as an individual, business, or other organization) [has] been commonly known by the [disputed] domain name, even if [the respondent has] acquired no trademark or service mark rights; or
- (iii) [the respondent is] making a legitimate noncommercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

As regards the first and third circumstances set out above, the Complainant has shown that the disputed domain name is identical to its ALAMO trademark. The Panel considers that this creates a risk of implied affiliation with the Complainant. The title of the associated website is also identical to the Complainant's ALAMO trademark, although the software product that it promotes is unrelated to the Complainant's car rental services. The product is promoted for commercial use by organizations. As regards the second circumstance set out above, the Respondent's name is "Ali Arefi", not the disputed domain name, and there is no evidence that the Respondent has been commonly known by the disputed domain name. In view of these circumstances, the Panel considers that the Complainant has made a prima facie case that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Turning to the Respondent, he asserts that "Alamo" is a common business name in Iran. In support, he submits evidence of three trademark registrations owned by third parties; two of these contain the term ALAMO (one of them as part of a different mark "ABN ALAMO") and a third contains the phonetic equivalent of "Alamo" in Arabic script with a device. The Panel considers this evidence insufficient to reach a finding that "Alamo" is a common business name.

The Respondent notes that there are similarities between his personal name and the disputed domain name. While the first syllable of the Respondent's given name and the initial of his family name spell "AL\_A", the similarity ends there, as the final letters supposedly correspond to "management organization". Despite the Respondent's claim that he and his product are commonly known by the disputed domain name in Iran, nothing in the record indicates that the Respondent (either as an individual, organization, or business) has been commonly known as "Alamo" or even "AL\_A".

The Respondent also notes that two Persian words can be transcribed as "Alam". However, the transcription "Alam" does not correspond to the disputed domain name and the Respondent's explanation for the addition of the final "o" (to add attention, surprise, or interest) appears contrived. Further, the meanings of the two Persian words are "world, universe, cosmos" and "trouble, pain, hurt", respectively. The Respondent explains that he is using "Alamo" to announce either that his software will run and work from anywhere or that, although human resources management is full of troubles and painful, his product makes it easy and without any trouble, or both. The Panel finds the alleged connections between these words and the Respondent's software to be highly tenuous.

The Panel has visited the Respondent's website associated with the disputed domain name and notes that the title "Alamo" is the only term in Latin script. It is not transcribed in Persian either. The homepage displays some taglines in Persian and links to a members' login page in Persian. The Respondent provides no evidence of the existence of his business, its human resources management software, its membership, or any other page on his website, despite having held the disputed domain name registration for over 3 years.

Accordingly, in view of the above circumstances, the Panel does not consider that the disputed domain name is being used in connection with a bona fide offering of goods or services. Rather, it appears more likely that the Respondent's website was set up to provide a pretext for claiming rights or legitimate interests in respect of the disputed domain name in this proceeding. In summary, the Panel considers that the Respondent has failed to rebut the Complainant's prima facie case.

Therefore, the Panel finds that the second element of the irDRP has been satisfied.

### **C. Registered or Used in Bad Faith**

Paragraph 4(a) of the irDRP contains two disjunctive requirements, which means that the Complainant may satisfy this element by proving either that the disputed domain name was registered in bad faith or that it is being used in bad faith, without necessarily proving both. Paragraph 4(b) of the irDRP provides that certain circumstances shall be evidence of the registration and use of a domain name in bad faith but these circumstances are not exhaustive.

The disputed domain name was acquired by the Respondent in 2020, after the Complainant's earlier trademark registrations, including in Iran, where the Respondent is based. The disputed domain name is identical to the ALAMO trademark, combining it only with the ".ir" ccTLD extension, which is a standard requirement of domain name registration. The Complainant has acquired a considerable reputation in the ALAMO mark in the car rental sector due to extensive and widespread use of it in respect of such services. Although the trademark is a Spanish word meaning "poplar", as well as a geographical term in the United States (that also refers to a battle), the Respondent does not claim to have chosen the disputed domain name based on any of these meanings. The Panel is not aware of any other meaning of the disputed domain name besides a reference to the Complainant and its services. The Respondent provides multiple explanations for the disputed domain name, variously based on an alleged common business name, a partial similarity to his personal name, or a partial similarity to the transcription of two Persian words. However, for the reasons set out in section 6.B above, the Panel does not find any of these explanations plausible. Accordingly, the Panel considers it more likely than not that the Respondent had the Complainant's mark in mind when he acquired the disputed domain name.

The disputed domain name, which is identical to the Complainant's mark, is ostensibly used in connection with the promotion of a software product. Nothing on the Respondent's website has any apparent connection to the disputed domain name, besides the website title. While it is true that the Respondent's software product is unrelated to the services specified in the Complainant's trademark registration, for the reasons given in section 6.B above, the Panel finds it more likely than not that the Respondent's website was set up to provide a pretext for claiming rights or legitimate interests in respect of the disputed domain name in this proceeding. Accordingly, the Panel finds that the Respondent is using the disputed domain name in bad faith.

The Panel also notes that the Respondent suggests that the Complainant's cease-and-desist or warning letter, to which he did not reply, was sent to a misspelt email address. The Respondent also sent his later communications from a near-identical email address, in an apparent effort to lend credence to this suggestion, as described in section 4 above. Yet he received other communications, including the Complaint, when sent to the same IRNIC-verified email address as the cease-and-desist letter. These circumstances appear to be a ruse and are a further indication of bad faith.

Therefore, the Panel finds that the third element of the irDRP has been satisfied.

## **7. Decision**

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

*/Matthew Kennedy/*

**Matthew Kennedy**

Sole Panelist

Date: March 5, 2024