



ADMINISTRATIVE PANEL DECISION

General Motors LLC

v.

GMSV Pty Ltd

auDRP_20_14

<gmsvshop.com.au>

1 The Parties

The Complainant is General Motors LLC of Detroit, Michigan, USA. It is represented in the proceedings by Helen Macpherson and Aparna Watal, lawyers with Baker and McKenzie in Sydney, Australia.

The Respondent is GMSV Pty Ltd, of Broadbeach Waters, Queensland, Australia. It is unrepresented and filed no Response to the Complaint.

2 The Disputed Domain Name and Registrar

The Disputed Domain Name is <gmsvshop.com.au>. The registrar of the Disputed Domain Name is Web Address Registration Pty Ltd.

3 Procedural History

This is an administrative proceeding pursuant to the .au Dispute Resolution Policy originally adopted by auDA on 13 August 2001, and subsequently amended on 1 March 2008 and re-issued on 15 April 2016 (“auDRP” or “Policy”); the auDA Rules for .au Dispute Resolution Policy (“Rules”) and the Resolution Institute Supplemental Rules for .au Domain Name Dispute Resolution Policy (“RI Supplemental Rules”).

A Domain Name Dispute Complaint Form was originally filed with Resolution Institute (**RI**) on 21 October 2020. Later that day RI forwarded a copy of the Complaint to the Registrar and on the following day the Registrar confirmed the registration particulars and confirmed that the Disputed Domain Name had been server locked. auDA and the Respondent were also notified of the Complaint by RI on 22 October.

Under Rule 5(a) a Response was due 20 calendar days after the proceeding commenced. The Rules make no allowance for weekends or public holidays. Under Rule 4(c) the

proceeding is taken to have commenced on the date on which RI completed its responsibilities under Rule 2(a) in forwarding the Complaint to the Respondent. Under Rule 2(g) times are calculated from the date a communication was first made under Rule 2(f). Accordingly, the due date for a Response was 11 November 2020. In fact no Response was received before that day or subsequently.

RI approached the Panel on 11 November 2020 and, following the Panel's Declaration of Independence and Statement of Impartiality, the parties were notified of the Panel's appointment later that day.

All other procedural requirements in relation to the proceedings appear to have been satisfied.

4 Factual Background

The following background facts, taken from the Complaint, remain unchallenged:

The Complainant is a wholly-owned subsidiary of General Motors Company (**GMC**), a well-known motor vehicle manufacturer with its global headquarters in Detroit, Michigan, USA. It is the named proprietor of each of the registered trademarks comprising the portfolio in evidence in this proceeding. GMC is one of the world's oldest and largest manufacturers of motor vehicles, parts and accessories, with over 164,000 employees working in 396 facilities across 6 continents, including in Australia.

The GM trade mark is recognised as one of the world's most iconic car brands and is very well known internationally, including in USA, United Kingdom, New Zealand and Australia. The GM brand has consistently ranked in the top 100 brands globally and has been in the top 40 brands in the Global Fortune 500 rankings for the last 25 years.

GM has had a long-standing presence and reputation in Australia since 1926 with the incorporation of General Motors (Australia) Ltd. In 1931 GMC acquired Holden's Motor Body Builders Ltd and merged it with its local subsidiary to form General Motors-Holden Ltd (**GMH**). Apart from a seven-year flirtation with the name Holden Ltd between 1998 and 2005 the local entity and its associated GMH brand have remained unchanged since that merger.

Amongst the very many registered trademarks held by the Complainant in Australia is one for GM in class 12 granted from 28 March 1956. The Complainant has owned a vast number of registered trademarks in Australia and overseas in many classes for GM over the last 64 years. The Complainant is also the applicant to register the brands GMSV and General Motors Specialty Vehicles in Australia, but those applications have not yet been granted.

In 1987 Holden Special Vehicles (**HSV**) was established to produce niche premium performance luxury cars. HSV built over 7 million vehicles for the Australian and international markets between 1988 and 2010. On 17 February 2020 GMH announced that, notwithstanding its decision to shut down its Australian business unit, HSV would continue to operate under the new brand name General Motors Specialty Vehicles or GMSV. That announcement was reflected in news articles which appeared over the ensuing 2 weeks.

On 18 August 2017 GM Holden Pty Ltd first registered the domain name <gmsv.com.au>. The Domain Name redirects to gmspecialtyvehicles.com. Since

18 August 2020, over 23,000 visitors from Australia have accessed the Complainant's website at www.gmspecialtyvehicles.com.

The Disputed Domain Name was created on 14 May 2020.

5 Parties' Contentions

Complainant

The Complainant asks for registration of the Disputed Domain Name to be transferred to it on the basis that:

- (a) The Disputed Domain Name is identical or confusingly similar to "various names and marks in which the Complainant has prior [*sic*] exclusive rights and reputation"; and
- (b) the Respondent does not have legitimate rights or interests [*sic*] in respect of the Disputed Domain Name; and
- (c) the Disputed Domain Name was registered, or has been subsequently used, in bad faith.

In relation to the first limb of the Policy the Complainant relies on its Australian domain name <gmsv.com.au>, its "unregistered rights" in the GMSV brand or its registered GM trademarks and its unregistered (common law) rights in GM. It submits that, given the long-standing use of HSV in Australia, "SV" when used with GM will be understood as a reference to GM Specialty Vehicles.

In relation to the second limb of the Policy the Complainant notes that the Disputed Domain Name was registered on 14 May 2020, many decades after the Complainant obtained trademark registrations for the GM Mark in Australia and overseas. Furthermore, this was after the Complainant obtained exclusive rights in the domain name www.gmsv.com.au in 2017, announced the launch of the GMSV Brand in February 2020 and commenced use of the GMSV Brand in Australia shortly thereafter. The Complainant also relies upon the UDRP decision of *Oki Data America's Inc v ASD Inc* (D2001-0903) which was one of the earliest cases dealing with the rights of a reseller to a domain name embodying the brand of products being resold. By reference to the website to which the Disputed Domain Name resolves, the Complainant notes that the Respondent is selling merchandise including premium car care products as well as apparel, headwear and mugs all promoted as "OFFICIAL LICENCED [*sic*] MERCHANDISE" together with a stylised version of the GMSV Brand in the following form (including the trademark acknowledgement):



The Complainant goes on to note that the Respondent has never been licensed or otherwise permitted by the Complainant to use any of its trademarks or to apply for or use

any domain name incorporating those names or marks. It has never been an authorised representative or distributor of GM vehicles or parts and has never been known by the Disputed Domain Name. Nor does the Respondent have any connection with authorised GM distributors for the sale of any GM or GMSV branded vehicles, parts, car care products, accessories or apparel.

The Disputed Domain Name is misleading with respect to the Respondent's business and there is no disclaimer or any statement to clarify the lack of any relationship between the Respondent and the Complainant or GMC.

On the question of registration or use in bad faith the Complainant notes that the Respondent was incorporated on 13 May 2020 and registered the Disputed Domain Name the following day. The Complainant also suggests that trademark applications for GMSV were filed in May 2020 by Laser Cleaning Machines Australia Pty Ltd said to be a related entity of the Respondent. When considered in the context of the Complainant's public announcements in relation to its proposed use of the GMSV Brand in February 2020, the Respondent's actions suggest that the Respondent intentionally chose to register and use the Complainant's mark in the Disputed Domain Name to disrupt or take advantage of the Complainant's reputation in that brand and plans for launching and promoting the GMSV Brand. Pursuant to paragraph 4(b) of the Policy the Complainant submits that the Respondent's actions are deemed to be evidence of bad faith registration and use of the Disputed Domain Name.

In addition, the Complainant provides evidence of written complaints it has made to the Respondent with respect to its conduct and the Respondent's failure to respond.

Respondent's Response

The Respondent failed to file any Response.

6 Discussion and Findings

Paragraph 4(a) of the auDRP requires the Complainant to prove that:

- (i) the Disputed Domain Name is identical or confusingly similar to a name, trade mark or service mark in which it 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 *or* subsequently used in bad faith.

The onus of proof is on the Complainant in relation to all three of these elements.

The Panel has to decide the case based on the evidence before it, and the Complainant must prove all of the elements of the Policy.

Identical or confusingly similar to a name or trademark in which the Complainant has rights

The evidence supplied by the Complainant is extensive but heavily focused on its long history and ownership of both registered and common law trademarks associated with the GM brand. To succeed under the first limb of the Policy the Complainant need only show

that the Disputed Domain Name is identical or confusingly similar to a name, trademark or service mark in which it has rights. For this purpose was sufficient for it to show that it is the applicant for Australian trademarks that include GMSV.

Had it been necessary for the Panel to decide, the Panel would not have been inclined to find that the Disputed Domain Name was similar to any of the Complainant's trademarks other than the GMSV brand. Furthermore, as part of the evidence provided to the Panel, the Complainant included an article noting that the Walkinshaw group is an unrelated entity to the Complainant or GMC and that its HSV business was a well-established business partner of GMH in Australia. That same article foreshadowed that it would be the Walkinshaw group that transitioned from HSV to GMSV as its house brand. The Panel is therefore unable to conclude that GMSV is a name belonging to any entity in the GMC corporate group. Whether Walkinshaw is licensed by the Complainant is unknown but leaving such matters unaddressed in a complaint is unsafe.

In previous cases this Panel has pointed out problems that can arise when corporate groups hold trademark registrations in the name of nontrading entities in the group and seek to rely on common law trademarks that can only arise from conduct of operating entities. In these proceedings the Complainant has used GM as a collective pronoun for both itself and GMC, which elides the difference between them, especially in relation to common law trademark rights which are dependent on goodwill associated with an operating entity.

For present purposes it is sufficient for the Panel to indicate that it is comfortably satisfied that the Complainant has rights in the GMSV Brand based on its trademark applications. Ignoring the "shop" suffix and the ".com.au" second level domain, the Disputed Domain Name would be identical to the Complainant's GMSV Brand. In the Panel's view the addition of "shop" reinforces rather than detracts from the likelihood of confusion. Accordingly the Panel finds that the Disputed Domain Name is confusingly similar to the GMSV Brand in which the Complainant has rights.

No Right or Legitimate Interest in respect of the Disputed Domain Name

The Complainant wrongly referred to the second limb of the Policy as requiring it to show that the Respondent had "no legitimate right or interest" in respect of the Disputed Domain Name. Despite wrongly quoting the second limb of the Policy the Complainant made submissions which the Panel is able to utilise in relation to the correct language of the Policy.

The absence of any Response is problematical for the Respondent in cases such as this because it would take very little to establish some legitimate interest in the four letters GMSV, yet the Respondent has made no attempt to do so. The Panel does note with some bemusement in this regard that the Australian Business Register records the Respondent as trading under the name Genuine Muscle Special Vehicles. Absent any explanation from the Respondent the Panel infers that the registration of such a business name was an entirely disingenuous activity on the part of the Respondent intended to cloak the Disputed Domain Name with some semblance of legitimacy. That it has failed to do.

The Panel accepts the Complainant's assurance that it has not conferred any rights on the Respondent that could justify the Respondent's use of the Disputed Domain Name and formally finds that the Respondent has no right or legitimate interest in respect of the Disputed Domain Name.

Registered or subsequently used in bad faith

Paragraph 4(a)(iii) of the auDRP requires the Complainant to demonstrate that the Disputed Domain Name was registered *or* subsequently used in bad faith.

The absence of a Response makes it difficult for the Panel to draw any inference favourable to the Respondent. Not only is the timing of the Respondent's registration of the Disputed Domain Name highly suggestive of opportunistic conduct referable to the Complainant's public announcements of its intention to use the GMSV Brand in Australia, its flagrantly false representations of authority to sell merchandise bearing the GMSV Brand and logo is simply illegal. That is more than adequate to support the Panel's finding that the Disputed Domain Name was both registered and is being used in bad faith by the Respondent.

7 Eligibility to hold the Disputed Domain Name

The Complainant has made out to the Panel's comfortable satisfaction all of the three grounds on which it needed to succeed. However, according to paragraph 6.1(b) of the chapeau to the Policy, the Registrar also needs to be satisfied before actioning a transfer order that the Complainant is eligible to hold the transferred domain name. The Complaint does not address this important requirement. In the Panel's view the Complainant is so eligible as applicant for the registration of the GMSV Brand as a trademark in Australia.

8 Order

For the foregoing reasons the Panel orders pursuant to Paragraphs 4(i) of the Policy and 15 of the Rules, that the domain name <**gmsvshop.com.au**> be transferred to the Complainant and that the Registry lock on that domain name be removed.

Dated this 25th day of November 2020

 **Argy**

Philip N Argy
Panellist