

DISPUTE RESOLUTION SERVICE

D00009650

Decision of Independent Expert

Onstar, LLC

and

K Burgess

1. The Parties:

Lead Complainant: Onstar, LLC
c/o One Southampton Row
London
WC1B 5HA
United Kingdom

Respondent: K Burgess
RR3
Williamsburg
Ontario
K0C 2H0
Canada

2. The Domain Name(s):

onstar.co.uk

3. Procedural History:

01 March 2011 17:53 Dispute received
03 March 2011 12:31 Complaint validated
03 March 2011 12:39 Notification of complaint sent to parties
25 March 2011 11:33 No Response Received
25 March 2011 11:33 Notification of no response sent to parties
06 April 2011 02:30 Summary/full fee reminder sent
07 April 2011 11:44 Expert decision payment received

11 April 2011 Notification of appointment of K Gymer as Expert (wef 14 April 2011)

4. Factual Background

The Complainant, Onstar, LLC, is a subsidiary of General Motors and is based in Detroit, Michigan. Its business is focussed on the design, development and production of vehicle-based electronic telecommunications devices incorporating GPS technology and the provision of related support services.

The Complainant's goods and services are offered under the trade mark OnStar (word only) and under word & device marks which comprise the word On and Star together with the device of a star, as well as ON with the device of a star.

The Complainant is proprietor of numerous registered trade marks for marks comprising On and Star, including, in particular, UK Registration No. 2125630 ONSTAR in Classes 9, 37 and 38 (filed on 5th March 1997 and registered on 21st November 1997).

The Complainant operates a website at www.onstar.com, and is also the proprietor of numerous other domain name registrations incorporating "onstar".

The Respondent, K Burgess, has a contact address in Ontario, Canada.

According to the Nominet WHOIS record, the Domain Name "onstar.co.uk" was first registered on 20 November 2005, and the record was last updated on 2 December 2009, although the nature of that update is not indicated.

There is a web site at "onstar.co.uk" which provides "Sponsored Listings", which are generated by Sedo on the Domain Owner's (Respondent's) behalf. Links are included to companies offering products and services in the field of GPS vehicle tracking, satellite navigation, fleet management and vehicle and asset recovery.

5. Parties' Contentions

Complainant:

The Complainant has asserted that:

1. The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name (Policy Paragraph 2a(i)); and
2. The Domain Name, in the hands of the Respondent, is an Abusive Registration (Policy Paragraph 2a(ii)).

The Complainant's case is supported by a number of Exhibits in accompanying Annexes. The following is an abbreviated selection of relevant edited extracts from the Complaint:

What rights are you asserting?

OnStar and the related word and device marks are invented and highly distinctive marks.

The Complainant is proprietor of the following pertinent registered trade marks, amongst others:-

1. United Kingdom Registration No. 2125630 ONSTAR in Classes 9, 37 and 38 (filed on 5th March 1997 and registered on 21st November 1997).
2. United Kingdom Registration No. 2213170 for ONSTAR and Device in Classes 9, 37, 38 and 42 (filed on 3rd November 1999 and registered on 7th April 2000).
3. United Kingdom Registration No. 2241644 ONSTAR (stylized) in Classes 9, 37, 38 and 42, which was filed on 4th August 2000 and registered on 7th February 2001.

The Complainant has also registered its ONSTAR, ONSTAR & Device and ON & Star Device trade marks in many territories around the world. The Annexes to the Complaint include a list of the Complainant's global registrations of its ONSTAR, ONSTAR & Device and ON & Star Device marks, which predate the date that the Respondent registered the onstar.co.uk domain name, and accompanying evidence of registration.

The Complainant operates a website at www.onstar.com.

The Complainant owns a number of other top level and country level domain names incorporating the name Onstar identified in an annex to the Complaint.

The Complainant's business in Canada [where the registrant is purportedly located] uses the onstar.ca domain name registration to re-direct users to the main website at www.onstar.com. The Complainant finds it useful for the provision and marketing of its business in different territories to be able to use the relevant ccTLD, as well as the gTLD onstar.com.

The Complainant has around two million customers in the US and has a substantial and developing business in Canada and China, and is looking to expand the geographical scope of its products and services. In conducting a check of registered domain names it became aware of the unauthorised registration by an unrelated third party of the domain name onstar.co.uk.

Why is the domain name an Abusive Registration?

In the hands of the Respondent, the domain name onstar.co.uk is abusive because:-

- i. it 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; and

ii. has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights

In particular,

- a) it amounts to a blocking registration against a name or mark in which the Complainant has Rights, and
- b) it has been registered for the purpose of unfairly disrupting the business of the Complainant

These claims are explained in more detail below.

The domain name onstar.co.uk is (excluding the suffix “.co”, and the ccTLD suffix “.uk”) identical with the Complainant's United Kingdom registered trade mark ONSTAR and is very similar to the Complainant's OnStar (stylised) and ON & Star Device marks.

As set out above, the Complainant's earliest registered rights in the United Kingdom in the ONSTAR trade mark date back to 5th March 1997, more than eight years prior to the date that the Respondent, K Burgess, registered the onstar.co.uk domain name (20th November 2005). The Complainant established its other UK trade mark rights between around five and six years prior to the Respondent's registration of the onstar.co.uk domain name.

The registration of the onstar.co.uk domain name is abusive because it is opportunistic and because it hinders the Complainant's development of a website dedicated to its planned UK business, because the domain name corresponding to the most obvious and desirable website to support such a business (www.onstar.co.uk) has been unfairly registered by the Respondent in breach of the Complainant's trade mark rights.

The registration of the domain name onstar.co.uk in the hands of the Respondent is abusive because the domain name points to a parking page from which the Respondent presumably earns click-per-view revenue. A print-out from the webpage linked to by the onstar.co.uk domain name is annexed to the Complaint. The webpage contains links to companies offering products and services in the field of GPS vehicle tracking, satellite navigation, fleet management and vehicle and asset recovery. In the circumstances, this is abusive because the ONSTAR name is highly distinctive of the Complainant's services in these fields and because the Complainant has established an international business under the ONSTAR trade mark in products and services connected with the matters linked to on the Respondent's webpage. The Respondent is using the international business and reputation established by the Complainant to generate revenue for itself, to promote the products and services of competitors of the Complainant, and to deprive the Complainant of its exclusive rights in its registered UK trade marks.

The domain name onstar.co.uk implies, and potential customers would initially infer, that any website hosted at the subject domain name is an official website of the Complainant or is officially authorised by the Complainant. The Respondent is not associated or affiliated with the Complainant and the Complainant has not authorised the Respondent to register or use the subject domain name.

Consequently, the Complainant is unable to control the content of the website or the products and services advertised through it. The Complainant's reputation and business is therefore detrimentally affected by the Respondent's registration and use of the subject domain name.

The Respondent has provided an incomplete name and incomplete contact details, since the Domain Name has been registered with no email address, fax or phone number.

The registration of the domain name onstar.co.uk in the hands of the Respondent is further abusive because it amounts to an infringement of the Complainant's rights in its registered trade marks. The definition of "abusive registration" under the Nominet DRS must include a domain name whose registration amounts to an infringement of a registered trade mark.

In addition, in the case of *British Telecommunications plc and Others v One in a Million and Others*, [1998] EWCA Civ 1272, the Court of Appeal held that registration of the domain name marksandspencer.com by the Respondent which was unconnected with Marks & Spencer plc amounted both to passing off and registered trade mark infringement. In giving the judgement of the court, Lord Justice Aldous stated as follows:-

"I am of the view that threats to infringe have been established. The appellants seek to sell the domain names which are confusingly similar to registered trade marks. The domain names indicate origin. That is the purpose for which they were registered. Further they will be used in relation to the services provided by the registrant who trades in domain names.

Mr Wilson also submitted that it had not been established that the contemplated use would take unfair advantage of, or was detrimental to the distinctive character or reputation of the respondents' trade marks. He is wrong. The domain names were registered to take advantage of the distinctive character and reputation of the marks. That is unfair and detrimental."

In the case of *Tesco Stores Ltd v Elogicom Ltd and Robert Ray* [2006] EWHC 403 (Ch) in relation to the first defendant's registration of a number of domain name containing the name "tesco", the High Court stated that the defendant:

"...was seeking to benefit from use of domain names which incorporated the word "tesco" 'fishing' for persons browsing the internet who might be searching for goods or services provided by Tesco and, being unsure of the precise address for a Tesco website, might by guesswork enter in the address bars on their computers names closely associated with Tesco in the hope that those addresses would take them to the Tesco website they were searching for. To the extent that Elogicom could capture some internet traffic represented by consumers who entered the "tesco" related domain names it had registered, and direct that traffic to Tesco websites under the auspices of the TradeDoubler affiliate system, it sought to be able to reap commissions for itself from Tesco. I consider that the only material reason why a consumer in the United Kingdom browsing the internet might use

one of the domain names registered by Elogicom would be because of the impact of the well-known Tesco brand name and their desire to seek access to a Tesco website.”

In the present case, the Respondent has also registered, without permission, a domain name incorporating the Complainant’s distinctive registered trade mark with the intention of directing internet users to websites for profit. Whilst in the Elogicom case the defendant directed users to the Complainant’s website in exchange for a commission, in the present case the Respondent would appear to be directing internet users to third parties’ websites for profit. Nonetheless, the principle is the same, namely that unauthorised use of a domain name corresponding to or incorporating a registered trade mark by a party unconnected with the trade mark owner is done with the result that the use of the domain name creates a likelihood of confusion on the part of the public and takes unfair advantage of and is detrimental to the distinctive character and reputation of the Complainant’s trade mark.

The registration and the use of the subject domain name by the Respondent in the present case amounts to an infringement of the rights of the Complainant in its registered trade marks.

The respondent has not been commonly known by the name onstar and is not legitimately connected with a mark which is identical or similar to onstar or onstar.co.uk

The respondent has not made legitimate non-commercial or fair use of the Domain Name.

The Domain Name is not generic or descriptive and the Respondent is not making fair use of it.

The Complainant has not entered into any agreement of any form with the Respondent permitting the Respondent to register and use the domain name.

Finally, we draw the Panelist’s attention to the following decided case, which is pertinent to this case.

The Complainant has recently brought successful proceedings in Switzerland against the registration of the domain name onstar.ch by HELP Searchengines AG of Zurich, utilising WIPO’s ccTLD dispute resolution procedure.

Further details of this procedure can be found at:

<http://www.wipo.int/amc/en/domains/cctld/> and
https://www.nic.ch/reg/cm/wcm-page/index.html?res=/reg/guest/disputes/rules_v1.jsp&plain&lid=en

According to the above-mentioned websites and links therefrom, in Switzerland the Claimant has to prove the following matters:

1. That it has a Right in a distinctive sign under the law of Switzerland or Liechtenstein
2. The registration and/or use of the Domain Name[s] at issue infringes Claimant's Right in a distinctive sign under the law of Switzerland or Liechtenstein

These requirements are not broader than the requirement to succeed in a Complaint before Nominet.

The above-mentioned Complaint brought by Onstar, LLC in Switzerland succeeded.

A copy of the decision in German, along with a rough and unofficial translation into English is annexed to the Complaint. It is worth noting that the Respondent in this case also appeared to link the domain name to a website providing links to car-related products and services offered by third parties.

How would you like this complaint to be resolved?

Transfer

Respondent:

No Response was received from the Respondent.

6. Discussions and Findings

General

Paragraph 2 of the Policy requires that, for the Complainant to succeed, it must prove to the Expert, on the balance of probabilities, both that it has Rights in respect of a name or mark which is identical or similar to the Domain Name; and that the Domain Name, in the hands of the Respondent, is an Abusive Registration as defined in Paragraph 1 of the Policy.

Complainant's Rights

The Complainant in this case has asserted that it has Rights in the ONSTAR trademark and that this mark is identical to the Domain Name, and that the Domain Name is also at least similar to other On+Star marks for which the Complainant has registrations.

In the Expert's view, there can be no argument that the Complainant has demonstrated rights in a name or mark identical to the Domain Name at issue, pursuant to Paragraph 2.a.i of the Policy, so this requirement is duly met.

Abusive Registration

The Complainant also has to show that the Domain Name is an Abusive Registration. Paragraph 1 of the Policy defines “Abusive Registration” 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) has been used in a manner, which took unfair advantage of or was unfairly detrimental to the Complainant’s Rights.

A non-exhaustive list of factors which may be evidence that a Domain Name is an Abusive Registration are set out in Paragraph 3a of the Policy.

From the Complainant’s submissions and supporting evidence, the following examples appear to be potentially applicable in this case:

3a. A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration is as follows:

i. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

...

B. as a blocking registration against a name or mark in which the Complainant has rights; or

C. for the purpose of unfairly disrupting the business of the Complainant;

ii. 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 factors listed in Paragraph 3 of the Policy are only intended to be exemplary and indicative. They are not definitive. It is Paragraph 1 of the Policy, which provides the applicable definition as indicated above.

In this case, the Expert notes that it has taken over 5 years from the date of first registration of the Domain Name in November 2005 before the Complainant has brought this Complaint. Such unexplained delay might give rise to questions as to why the Complainant has been prepared to tolerate the existence of this registration if it were abusive. In DRS08347 (5alive.co.uk), for example, the Expert took the view that a delay of 6 years (in that case) made it difficult to accept that the registration at issue really took unfair advantage of or was detrimental to the Complainant’s rights. However, the evidence in that case also suggested that the claimed rights were perhaps not as strong or exclusive as asserted, and there were

other unchallenged and apparently legitimate users of “5alive” in various domain names.

In the present case, the unchallenged evidence is that ONSTAR is, as claimed, an inventive and highly distinctive mark, uniquely associated with the Complainant. Consequently, despite the delay, and as the Respondent has offered no alternative explanation, the Expert has little doubt that the registration of the Domain Name “onstar.co.uk” was most likely made intentionally for the opportunistic and parasitic purpose of seeking to exploit the Complainant’s goodwill and reputation for the Respondent’s benefit. Even if there were doubts about the original motive for registration, the present use is manifestly directed at such unfair exploitation of the Complainant’s rights.

The Expert does not consider there is any mitigation in the fact that the page of Sedo-generated “Sponsored Links” carries the indistinct rider (here presented in the same font colour):

“This page provided to the domain owner free by Sedo's [Domain Parking](#). Disclaimer: Domain owner and Sedo maintain no relationship with third party advertisers. Reference to any specific service or trade mark is not controlled by Sedo or domain owner and does not constitute or imply its association, endorsement or recommendation”

In the Expert’s opinion such a purported Disclaimer asserting essentially that everything is all done automatically and that the domain owner supposedly has no control, is a specious defence. As stated under Paragraph 4e of the Policy, whilst “...Sale of traffic (i.e. connecting domain names to parking pages and earning click-per-view revenue) is not of itself objectionable under the Policy, [...] the Expert will take into account:

- i. the nature of the Domain Name;
- ii. the nature of the advertising links on any parking page associated with the Domain Name; and
- iii. that the use of the Domain Name is ultimately the Respondent’s responsibility.

In the absence of any evidence to the contrary, as noted above, the Expert considers it most likely that the Respondent registered the Domain Name in full knowledge of the Complainant’s longstanding prior rights, and this would be sufficient in itself for a finding that the registration was abusive. Additionally, and irrespective of the fact that Sedo may act on his behalf as an automated agent, the evidence shows that the Domain Name is being used to enable the Respondent to trade off the Complainant’s name and goodwill, and the Respondent cannot be ultimately responsible for such use.

The use that is being made of the Domain Name, whether automated or not, is plainly taking unfair advantage of the Complainant’s earlier rights, to the unauthorised benefit of the Respondent.

Accordingly, the Expert concludes that the Domain Name in the hands of the Respondent is an Abusive Registration, pursuant to Paragraph 2.a.ii of the Policy.

7. Decision

Having concluded that the Complainant does have Rights in respect of a name or mark, which is identical or similar to the Domain Name, and that the Domain Name, in the hands of the Respondent, is an Abusive Registration, the Expert determines that the Domain Name onstar.co.uk should be transferred to the Complainant.

Signed Keith Gymer

Dated: 6 May 2011