

ADMINISTRATIVE PANEL DECISION

General Motors LLC v. Carol Schadt

Case No. D2012-2106

1. The Parties

The Complainant is General Motors LLC, of Detroit, United States of America (“US”) ; represented by Abelman Frayne & Schwab, US.

The Respondent is Carol Schadt of Lansdale, Pennsylvania, US; *pro se*.

2. The Domain Name and Registrar

The disputed domain name <mygm.com> is registered with Network Solutions, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 23, 2012. On October 23, 2012, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 23, 2012, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on November 12, 2012 which provided the registrant and contact information disclosed by the Registrar and invited the Complainant to submit an amendment to the Complaint. The Complainant filed such an amendment on November 12, 2012. On November 15, 2012, the Center requested verification, of additional information, from the Registrar and on the same date the Registrar subsequently transmitted by email to the Center its verification of that information. Based on that information, the Center sent an email communication to the Complainant on November 15, 2012 inviting the Complainant to submit a further amendment to the Complaint. The Complainant filed a second amendment to the Complaint on November 16, 2012.

The Center verified that the Complaint together with both amendments (henceforth being simply referred to collectively as the “Complaint”) satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform 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 that the proceedings commenced on November 19, 2012. In accordance with the Rules, paragraph 5(a), the due date for Response was December 9, 2012. The Response was filed with the Center on December 2, 2012.

The Center appointed Peter L. Michaelson as the sole panelist in this matter on December 21, 2012. 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

According to the public Whois database appearing in Annex 1 to the Complaint, the disputed domain name was registered to the Respondent on September 25, 1999 and is set to expire on September 25, 2015.

A. The Complainant's GM Marks

The Complainant owns over 600 United States and counterpart foreign trademark registrations for the term "GM", appearing by itself or with additional elements. The Complainant has provided, in Annex 3 to the Complaint, a worldwide listing of those marks, and, in Annex 4 to the Complaint, a representative sampling of the copies of the Certificates of Registration for the trademark GM in both the United States and other countries. Pertinent details of a few of the United States registrations are as follows:

1. GM (block letters)
United States registration no. 283,227
registered: May 9, 1931; filed: November 29, 1930
last renewed: December 18, 2010

This mark is registered for use in connection with: "radio receiving sets and parts thereof", in international class 9. The registration indicates that both first use of the mark in conjunction with these goods and first use in commerce commenced as of November 20, 1929.

2. GM (block letters)
United States registration no. 861,602
registered: December 10, 1968; filed: April 11, 1968
last renewed: March 31, 2008

This mark is registered for use in connection with: "automobiles, motor trucks, truck tractors, buses, and parts thereof", in international class 12. The registration indicates that both first use of the mark in conjunction with these goods and first use in commerce commenced as of September 15, 1933.

3. GM and design
United States registration no. 1,474,088
registered: January 26, 1988; filed: June 1, 1987
renewed: November 7, 2007

This mark is registered for use in connection with: "automobiles, trucks, truck tractors, buses, engines thereof and structural parts thereof", in international class 12. The registration indicates that both first use of the mark in conjunction with these goods and first use in commerce commenced as of September 30, 1966.

B. The Complainant and its actions

The Complainant, General Motors, is an automotive manufacturing company and is among the world's largest automakers. General Motors is the successor in interest to all trademarks and related goodwill formally owned

by General Motors Corporation which was founded in 1908. Today, the Complainant employs over 200,000 people in major regions of the world, and sells and services vehicles in approximately 157 countries. With its global headquarters in Detroit, the Complainant manufactures cars and trucks in over 30 countries. General Motors' largest national market is China, followed by, in order of sales, the United States, Brazil, Germany, the United Kingdom, Canada, and Italy.

In 1908, General Motors Corporation was founded by William "Billy" Durant. Durant called the company General Motors. The core of the company's logo, the block mark with the letters "GM" has remained the same ever since. As a result of long, continuous and extensive use, considerable advertising and promotion of the GM marks, and coupled with the commercial success of the Complainant's automobiles and products over the ensuing years, the Complainant has developed considerable cachet, image and reputation and as such is extremely well-known in the automotive industry and to consumers throughout the world – to the point where the mark GM has undoubtedly acquired substantial fame in the marketplace quite some time ago and which continues to the present.

The Complainant conducts business on the Internet including through its websites at <gm.com> and <gmc.com>. These sites (copies of hard-copy printouts of various pages from those sites are provided in Annex 6 to the Complaint) provide information concerning the Complainant and its products, including, e.g., its corporate profile, its leadership role in the industry, its branded products, its news and events, its dealer information, and its awards & accolades. The Complainant has provided, in Annex 7 to the Complaint, a table of its annular vehicle sales figures for each year from 1998 through 2009.

On September 25, 2012, the Complainant's attorney sent a letter (a copy of which appears in Annex 13 to the Complaint), via email, to the Registrant requesting that the Registrant immediately cease and desist any future use of the mark GM, and that the Registrant transfer the disputed domain name to the Complainant. The Complainant received no response to the letter.

The name currently resolves to an inactive website – as shown by a copy of the home page provided in Annex 14 to the Complaint indicating that the website is "under construction" – and, as indicated by a copy of a printout from <archive.org/web/web.php> in Annex 15 to the Complaint, has apparently been inactive since 2004. Furthermore, according to information provided by this archive site, the disputed domain name was apparently offered for sale from 2001-2004.

5. Parties' Contentions

A. The Complainant

(i) Identical or Confusingly Similar

The Complainant contends that the disputed domain name is confusingly similar to the Complainant's mark GM because the name contains the formative term "GM" to which the word "my" has been prepended. Addition of the word "my", in this context, not only fails to provide any distinctiveness to the disputed domain name that would sufficiently abate confusion of Internet users; it actually exacerbates confusion of those users. Specifically, the word "my", as used here as a prefix, would generally be understood to provide a website through which each of the Complainant's customers could obtain secure online access, through an associated user account, to various personalized services regarding a product it has from the Complainant and/or its relationship with the Complainant. The use of the word "my" followed by a mark, as here, is similarly used by both the Complainant's competitors in its industry as well as numerous entities in other industries (both being evidenced in Annex 10 to the Complaint by copies of printouts from various illustrative websites) and thus carries the same user connotation throughout – and is widely understood in that context throughout the Internet community.

Hence, the Complainant believes that it has satisfied the confusing similarity/identity requirement in paragraph 4(a)(i) of the Policy.

(ii) Rights or Legitimate Interests

The Complainant contends that, for any one of various reasons, the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraph 4(a)(ii) of the Policy.

First, the Respondent has never received any license or consent, express or implied, from the Complainant to use the mark GM in a domain name or in any other manner, nor has the Complainant acquiesced in any way to such use or application of that mark by the Respondent.

Second, the Respondent is not commonly known by the mark GM or the term MYGM. She did not use that mark or any other mark containing the letters "GM" as a trademark, company name, business or trade name. Moreover, the Respondent could never be so commonly known inasmuch as the Complainant has acquired exclusive trademark rights in the term GM, and established its widely-known reputation through that term, many decades before the Respondent registered the name – a reputation of which the Respondent was undoubtedly aware at the time she registered the name. Moreover, the mark GM, being a coined term and particularly in light of its continuous exclusive use by the Complainant for over 95 years – for which the mark has acquired fame, has no meaning other than as an identifier of the Complainant. Hence, any use to which the Respondent would put that mark would very likely create a false impression in the minds of Internet users that the Respondent is somehow associated with the Complainant when, in fact, no such association exists.

Third, the Respondent does not use the disputed domain name in connection with a *bona fide* offering of goods and services, and of particular pertinence, it resolves to a website that is inactive and has been so since 2004.

(iii) Registered and Used in Bad Faith

The Complainant contends that the Respondent has registered and is using the disputed domain name in bad faith pursuant to paragraph 4(a)(iii) of the Policy.

First, given the famous and distinctive nature of the mark GM, the Respondent is likely to have had, at least, constructive, if not actual notice, as to the Complainant's mark at the time she registered the name. This suggests that the Respondent acted with opportunistic bad faith in having registered the name.

Second, inasmuch as the name was offered for sale from 2001-2004 and since then has not resolved to an active website, the Respondent is likely to have registered the name to intentionally trade-off the goodwill and reputation of the Complainant to the Complainant's detriment.

B. The Respondent

The Respondent states that she registered the disputed domain name as a resource site to market general management assessments, data management consulting services and for sales of domain names. She alleges that the nature of the name is generic and relates to general management and data management practices as a business function within an enterprise. She chose the name to cater to general management professionals, much in the same way that <mycfo.com> implies a resource knowledge base for financial professionals and provides financial planning services.

She acknowledged that the name was registered at a time when General Motors was a going concern with her interest in the name continuing even when General Motor's continued existence, due to financial issues, came into serious question several years ago.

She stated that previously, when the name resolved to an operational website, that site had a member only portion for a general management maturity model assessment, a managerial skills assessment tool and

downloadable information on strategic management. She stated that the current design efforts are underway to enhance the prior site by making the models presented on it database driven, more comparative than had previously occurred, statistically driven and integrated with other best practices.

She also stated that she liked the disputed domain for its brevity and resemblance to a business profession: general management.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Panel finds that the disputed domain name is confusingly similar to the Complainant's GM Marks.

From a simple comparison of the disputed domain name to the Complainant's mark GM, no doubt exists that the disputed domain name is confusingly similar to the Complainant's marks. The primary difference between the disputed domain name and the mark GM is the prepending of the word "my" to form a separate corresponding composite term "mygm" along with, secondarily, appending the gTLD (generic top level domain) ".com" to that term to form the disputed domain name, with the last addition being irrelevant in assessing confusing similarity or identity under paragraph 4(a) of the Policy and thus ignored.

It is now very well-established in UDRP precedent, including numerous decisions previously rendered by this Panel, that a minor variation, such as adding a short letter or number group, or even generic or highly descriptive words, or geographic identifiers, such as a country name, to a mark, is usually insufficient in and of itself, when used in forming a domain name that results from modifying the mark, to confer requisite and sufficient distinctiveness to that name to avoid user confusion. Here, adding such a generic word, that being the word "my", in the manner which the Respondent specifically did, to the mark GM clearly resulted in such a minor variation. See, particularly *National Westminster Bank plc v. Steve Mart*, WIPO Case No. D2012-1711; *Tommy Bahama Group, Inc. v. Berno Group International*, WIPO Case No. D2012-0531; *National Association of Realtors v. Hammerberg & Associates, Inc.*, WIPO Case No. D2012-0075; *Space Needle LLC v. Erik Olson*, WIPO Case No. D2011-0931; *Oakley, Inc. v. Kate Elsberry, Elsberry Castro*, WIPO Case No. D2009-1286; *Clearwire Legacy, LLC v. Leon Ganesh*, WIPO Case No. D2010-0148; *Burberry Limited v. Domain Admin*, WIPO Case No. D2009-0703; *Krispy Kreme Doughnuts, Inc. v. John Sharp*, WIPO Case No. D2009-0099; *MasterCard International Incorporated v. Global Prepaid*, WIPO Case No. D2008-2008; *HRB Innovations Inc., Express Tax Service Inc. v. Calvin Brown*, WIPO Case No. D2008-1072; *Dreamworks Animation, LLC v. Creahq, Mike Furlong*, WIPO Case No. D2008-0505; *Marvel Manufacturing Company Inc. v. Koba Internet Sales, LP*, WIPO Case No. D2008-0265; *MySpace, Inc. v. Edwin De Jesus, EDJ Associates Inc.*, WIPO Case No. D2007-1878; *BlackRock, Inc. v. blackrockfinancialservices.com*, WIPO Case No. D2007-1627; *F. Hoffmann-La Roche AG v. Transliner Consultants*, WIPO Case No. D2007-1359; *National Football League v. Peter Blucher d/b/a BluTech Tickets*, WIPO Case No. D2007-1064; *Toilets.com, Inc. v. Rons Porta Johns*, WIPO Case No. D2007-0952; *Associated Bank Corp. v. Texas International Property Associates*, WIPO Case No. D2007-0334; *Gerber Childrenswear Inc. v. David Webb*, WIPO Case No. D2007-0317; *SPX Corporation v. Hevun Diversified Corporation*, NAF Claim No. FA 791657; *Google Inc. v. Jennifer Burns*, NAF Claim No. FA 726096; *The Cheesecake Factory Inc. and The Cheesecake Factory Assets Co., LLC v. Say Cheesecake*, WIPO Case No. D2005-0766; *Napster, Inc. v. Giovanni Vinscani*, WIPO Case No. D2005-0531; *Caesars Entertainment, Inc. v. Nova Internet Inc.*, WIPO Case No. D2005-0411; *Lockheed Martin Corporation v. The Skunkworx Custom Cycle*, WIPO Case No. D2004-0824; *Lockheed Martin Corporation v. Deborah Teramani*, WIPO Case No. D2004-0836; *National Collegiate Athletic Association v. Dusty Brown*, WIPO Case No. D2004-0491; *Lane-Labs USA, Inc. v. Powell Productions*, NAF Claim No. FA 155896; and particularly *Cable News Network LP, LLP v. Elie Khouri d/b/a Channel News Network et al.*, NAF Claim No. FA 117876.

Moreover, by including the generic word "my" with the Complainant's mark GM to form the disputed domain name, the potential for user confusion is likely to be exacerbated, not reduced. Given current widespread e-commerce conventions and naming patterns in use on the Internet, it is beyond question that an Internet

user, who happens to be a customer of the Complainant or is otherwise sufficiently interested in the Complainant's products and services and seeks to establish an online relationship and/or account with the Complainant through which that user can securely access information regarding the Complainant's products and/or its relationship with the Complainant or even securely interact with the Complainant in some fashion, would very likely contemplate doing so through a web site that acts as a portal in affording secure access to a personal web page and is addressed by a "my-trademark" domain name, specifically here being constituted by the word "my" followed by the Complainant's mark GM to which the common gTLD ".com" has been added to form <mygm.com> – which is the exact domain name at issue in this dispute. The user would then insert that domain name into his/her browser with a reasonable expectation that doing so would direct that browser to the Complainant's portal website or such a site authorized by the Complainant from which that user could securely access his/her account with the Complainant and there through access the desired information or otherwise interact with the Complainant. However, here the Respondent, not the Complainant, registered that domain name. The result is that the user's action would cause that person not to be taken to the Complainant's portal, but rather, and without that user realizing the diversion, to the Respondent's site instead. Thus, the user would very likely be deceived into thinking that the Respondent's site – though it is now merely a parked page indicating that the site remains under construction – is affiliated with, authorized by or related in some fashion to the Complainant when, in fact, it was not. Hence, the term "my" in the disputed domain name only heightens the likelihood of the Respondent causing user deception and ensuing confusion to the Respondent's ultimate benefit and the detriment of the Complainant. See *Tommy Bahama, Nat'l Assn. of Realtors, Space Needle, Burberry, Krispy Kreme, Dreamworks and MySpace*, all cited *supra*.

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's GM Marks as to cause confusion. Hence, the Complainant has satisfied its burden under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Based on the evidence of record here, the Panel finds that no basis exists which would appear to legitimize a claim by the Respondent to the disputed domain name under paragraph 4(c) of the Policy.

The Complainant has never authorized the Respondent to utilize any of the GM marks nor does the Complainant apparently have any relationship or association whatsoever with the Respondent. As such, any use to which the Respondent were to put the Complainant's mark GM or one confusingly similar thereto in connection with the identical or even similar goods and services to those currently provided by the Complainant, in circumstances as are present here, may violate the exclusive trademark rights now residing with the Complainant. See, e.g., *National Westminster, Amy Stran v. EzDomainSearch.com, Juan Curtis*, WIPO Case No. D2011-1710; *Tommy Bahama, Space Needle, Oakley, Burberry, HRB Innovations Inc., Dreamworks, MySpace, Blackrock, F. Hoffmann-La Roche AG, National Football League, Toilets.com, Inc., and Associated Bank*, all cited *supra*; also *Starline Publications, Inc. v. Unity*, WIPO Case No. D2008-1823; *GoDaddy.com, Inc., v. GoDaddysDomain.com, Clark Signs, Graham Clark*, WIPO Case No. D2007-0303; *Citgo Petroleum Corporation v. Richard Antinore*, WIPO Case No. D2006-1576; *New Destiny Internet Group, LLC and Xplor Media, Inc. v. SouthNetworks*, WIPO Case No. D2005-0884; *The Cheesecake Factory Inc., Napster and Caesars Entertainment, Inc., supra; Pelmorex Communications Inc. v. weathernetwork*, WIPO Case No. D2004-0898; *Sybase, Inc. v. Analytical Systems*, WIPO Case No. D2004-0360; *Caesars World, Inc. and Park Place Entertainment Corporation v. Japan Nippon*, WIPO Case No. D2003-0615; *Leiner Health Services Corp. v. ESJ Nutritional Products*, NAF Claim No. FA 173362; *MPL Communications, Limited et al v. 1WebAddress.com*, NAF Claim No. FA 97092; *Treeforms, Inc. v. Cayne Industrial Sales, Corp.*, NAF Claim No. FA 95856; and *America Online, Inc. v. Xianfeng Fu*, WIPO Case No. D2000-1374. Consequently, in this Panel's view, the Respondent could not legitimately acquire any public association between herself and the mark GM or even any mark similar thereto, at least for the goods and services provided by the Complainant under its marks.

Further, there is absolutely no evidence of record that the Respondent has ever been commonly known by the disputed domain name or more generally the mark GM. Nor could the Respondent likely ever become

commonly known by either the disputed domain name or the mark without infringing on the exclusive trademark rights of the Complainant. This is so in light of the Complainant's exclusive trademark rights which date back to approximately 1908 – at least some ninety years prior to when the Respondent registered the disputed domain name, and the widespread and substantial reputation, notoriety and fame which the Complainant has gained in its GM marks ever since. See, e.g. *National Westminster, Tommy Bahama, Amy Stran, Space Needle, Oakley, Burberry, Starline Publications, HRB Innovations Inc., MySpace and Treeforms, Inc.*, all cited *supra*. Hence, the Respondent does not fall within paragraph 4(c)(ii) of the Policy.

Additionally, the Respondent's website has been inactive since 2004 – a time period now stretching at least 8 years which, by its length, negates any credible belief that the Respondent has made any reasonable and demonstrable preparations to use the name in the manner she intends. In fact, other than a statement of her intentions, she proffers no specific evidence delineating any such preparations. Hence, it is reasonable for the Panel to infer that the Respondent's actions have not progressed any farther to fruition than simply being statements of intentions. Intentions, devoid of actual implementational efforts, fall short of satisfying the requirements of paragraph 4(c)(i) of the Policy.

Lastly, there are no facts of record that appear to qualify the Respondent's actions as satisfying paragraph 4(c)(iii) of the Policy.

As such, based on the evidence before the Panel, the Respondent does not fall within any of paragraphs 4(c)(i)-(iii) of the Policy.

Accordingly, the Panel concludes that the Respondent has no rights or legitimate interests in the disputed domain name within paragraph 4(a)(ii) and 4(c) of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that the Respondent's actions, with respect to the disputed domain name, constitute bad faith registration and use.

The Respondent acknowledged that she was well aware of the Complainant, General Motors, when she registered the name. Given the widespread recognition and reputation of the Complainant and the fame and substantial notoriety of its mark GM, the Panel infers, from a lack of any evidence to the contrary, that the Respondent was equally aware of the Complainant's mark GM. Yet, in spite of that knowledge, she intentionally registered the disputed domain name.

Further, the evidence of record indicates that since sometime during 2004, a period extending to at least eight years, the Respondent has not used the disputed domain name to resolve to an operational website, hence passively holding the name throughout that period. Though, as noted above, the Respondent stated that she intends to use the name for a website that provides a resource for general management and for selling domain names, the record is devoid of any specific efforts she made to implement such a site in furtherance of her intentions: intentions that have not been and may never become reality. The Panel looks at past and present, but not possible future use to determine the legitimacy of the Respondent's actions. From that perspective, the Respondent simply passively held the disputed domain name since at least 2004, if not earlier.

Consequently, under the facts here, the Panel views the Respondent's prior knowledge of the Complainant and its mark which was followed by passive holding of the name thereafter as constituting bad faith use and registration. See, e.g., *National Football League and Cheesecake Factory*, both cited *supra*; also *Intelligent Medical Objects, Inc. v. Domains by Proxy, Inc. / Atif Zafar*, WIPO Case No. D2009-1342; *Bayer Aktiengesellschaft v. H. Monssen*, WIPO Case No. D2003-0275; *Lake at Las Vegas Joint Venture v. Principal Equiti, Inc.*, WIPO Case No. D2002-0758; *America Online, Inc. v. Curtis Woods*, WIPO Case No. D2001-0555; *Awesome Kids LLC and/or Awesome Kids L.L.C. v. Selavy Communications*, WIPO Case No. D2001-0210; *402 Shoes, Inc. dba Trashy Lingerie v. Jack Weinstock and Whispers Lingerie*, WIPO Case No. D2000-1223; *Liberty Public Limited Company v. Thomas Guarrera*, NAF Claim No. FA 95103; *V&S Vin*

& Sprit Aktiebolag v. Gunnar Hedenlans Peev, NAF Claim No. FA 95078; *Revlon Consumer Products Corporation v. Yoram Yosef aka Joe Goldman*, WIPO Case No. D2000-0468; *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003; and *Mary-Lynn Mondich and American Vintage Wine Biscuits, Inc. v. Shane Brown d/b/a Big Daddy's Antiques*, WIPO Case No. D2000-0004.

Hence, the Panel concludes that the Respondent violated the general bad faith provision of paragraphs 4(a)(iii) and 4(b) of the Policy.

Thus, the Panel concludes that the Complainant has provided sufficient proof of its allegations, with respect to the disputed domain name, to establish a case under paragraph 4(a) of the Policy upon which the relief it now seeks can be granted.

7. Decision

Accordingly, under paragraphs 4(i) of the Policy and 15 of the Rules, the Panel grants the relief sought by the Complainant. The disputed domain name <mygm.com> is ordered to be transferred to the Complainant.

Peter L. Michaelson

Sole Panelist

Dated: December 24, 2012