



**DOMAIN NAME DISPUTE ADMINISTRATIVE PANEL**

**auDRP\_20\_12**

**Single Panellist Decision**

**General Motors LLC**

**v.**

**Scordo Transport Services Pty Ltd ABN 59 631 629 126**  
(formerly known as International Motor Cars Pty Ltd)

**1. The Parties**

- 1.1 The Complainant is General Motors LLC of 300 Renaissance Centre, Detroit, Michigan 48265-3000 in the United States of America ("the Complainant" or "GM").
- 1.2 The Respondent is Scordo Transport Services Pty Ltd ABN 59 631 629 126 (formerly known as International Motor Cars Pty Ltd) of 41 Enterprise Way, Sunshine West, Victoria, Australia 3020 ("the Respondent").

**2. Domain Name, Registrar and Provider**

- 2.1 The Domain Name upon which complaint is based is [www.cadillacaustralia.com.au](http://www.cadillacaustralia.com.au) ("the Domain Name" or "the Disputed Domain Name").
- 2.2 The Registrar of the Domain Name is Domain Directors Pty Ltd (trading as Instra) ("the Registrar").
- 2.3 The Provider in this Proceeding is Resolution Institute of Level 2, 13-15 Bridge Street, Sydney New South Wales, Australia 2000 ("the Provider" or "Resolution Institute").

**3. Procedural History**

- 3.1 This proceeding relates to the complaint submitted by the Complainant in accordance with the .au Dispute Resolution Policy No. 2016-01, the Rules for .au Dispute Resolution Policy ("the Rules") and the Resolution Institute's Supplemental Rules for .au Domain Name Dispute Resolution Policy ("the Supplemental Rules").
- 3.2 The Complainant lodged a Complaint with the Resolution Institute on 24.09.2020, which Complaint incorporated a schedule of attachments, being:
  - 1. Copies of articles that provide a brief history of the CADILLAC brand



2. Copies of articles that confirm the significant commercial success of the CADILLAC brand
  - 2A. An extract from GM's marketing material from September 2002 celebrating 100 years of the CADILLAC brand
  3. Copies of a Whois extract for the Disputed Domain Name; E-mail from .auDA dated 2.09.2020; and Current extract of the Respondent from the Australian Securities and Investments Commission
  4. Copy of Intra Terms and Conditions
  5. .au Dispute Resolution Policy approved by auDA Board on 13 August 2001
  6. Schedule of GM's Australian trademark registrations – CADILLAC mark
  7. Schedule of GM's worldwide trademark registrations - CADILLAC mark
  8. Schedule of GM's Australian trademark registrations - the Cadillac Logo marks
  9. Schedule of GM's worldwide trademark registrations - the Cadillac Logo marks
  10. Whois extract for the domain name <cadillac.com>
  11. Copies of news articles regarding CADILLAC branded vehicles at international automotive shows, and Australian news articles referring to the same
  - 11A. Extracts from the Cadillac LaSalle Club of Australia's official Australian website at [www.cadillaclasalleclub.com.au](http://www.cadillaclasalleclub.com.au)
  - 11B. Australian visitor statistics for GM's website at [www.cadillac.com](http://www.cadillac.com).
  12. Oki Data Americas, Inc. v ASD Inc. D 2001-0903
  13. Copy of the "About Us" webpage hosted at the Disputed Domain Name
  14. Copies of the webpages from [www.internationalmotorcars.com.au](http://www.internationalmotorcars.com.au) and a WHOIS extract for the domain name <internationalmotorcars.com.au> obtained from AusRegistry on 7 September 2020
  15. Croatia Airlines d.d. v. Modern Empire Internet Ltd., WIPO Case No. D2003-0455
  16. Copy of the "Home" webpage hosted at the Disputed Domain Name
  17. GM Holden Ltd. v. Bradley John Lawless WIPO Case No. DAU2010-0010
  18. Lise Charmel D 2012-874 and Xtralis Technologies v Secusense DNL 2014-0055
  19. Copy of the original letter of complaint
  20. Copies of further correspondence between the representatives
  21. Copies of article "GMSV confirmed, Corvette coming 2021" published at <https://www.caradvice.com.au/874523/gmsv-to-be-announced-today-corvette-coming-2021/>
- 3.3 On 24.09.2020 the Provider notified the Registrar via email of the Domain Name dispute with a request to clarify Respondent details and lock the Domain Name during proceedings.
  - 3.4 On 25.09.20 the Registrar confirmed via email that the Domain Name in dispute had been locked and the Provider notified auDA via email of the Domain Name complaint.
  - 3.5 On 25.09.2020 the Provider notified the Respondent via email of the Domain Name Dispute complaint, with the Registrar and the Complainant copied in.
  - 3.6 The Respondent submitted a response to the Domain Name complaint via email on the due date, being 15.10.2020, with the Provider and the Complainant copied in.
  - 3.7 Resolution Institute appointed Rowena McNally as the sole panellist in the matter on 16.10.2020. The Panellist has confirmed that she has no conflict of interest in relation to the matter. All procedural requirements appear to have been satisfied.
- 4. Factual Background**
- 4.1 The Complainant, General Motors LLC, is a manufacturer of motor vehicles, parts and accessories. GM's motor vehicle range includes luxury motor vehicles sold under the brand



and trademark "CADILLAC", which has been part of the Complainant's portfolio since 1909.

- 4.2 The Complainant has owned registered trademark rights in its CADILLAC mark for approximately 96 years in the USA and 94 years in Australia, evidence of which was included in the Complaint.
- 4.3 The Respondent is operating a business from a facility in Melbourne where it converts second-hand motor vehicles, including Cadillac motor vehicles, to right-hand drive vehicles.
- 4.4 The Disputed Domain Name was registered by the Respondent on 6.04.2020.
- 4.5 On 30.06.2020, the Complainant's solicitors wrote to the Respondent concerning the unauthorised use by the Respondent of the Cadillac Marks and requesting, *inter alia*, that the Respondent cease all unauthorised use of the Cadillac Marks, including trading under the name Cadillac Australia and cease using the Cadillac Marks on the Respondent's social media on Facebook at [www.facebook.com/cadillacau](http://www.facebook.com/cadillacau).
- 4.6 The Respondent's solicitor replied on 4.08.2020 disputing, *inter alia*, that the Respondent was obliged to comply with the Complainant's requests or provide the Complainant's requested undertakings.
- 4.7 On 13.08.20 the Complainant wrote again to the Respondent's solicitor requesting, *inter alia*, that the Respondent reconsider its position. That correspondence indicated that GM did not object to the Respondent dealing in Cadillac vehicles or using the Cadillac word mark in a descriptive sense to inform customers that the Respondent can provide right-hand drive Cadillac vehicles for sale, provided that the Respondent did not make use of the CADILLAC word mark in GM's distinctive stylised font or the CADILLAC emblems, and provided further that the Respondent make "no statements or representation, expressed or implied, that falsely suggest an affiliation with General Motors or its Cadillac motor division". The Complainant again requested undertakings, *inter alia*, that the Respondent cease all unauthorised use of the CADILLAC Marks, including trading under the name Cadillac Australia and cease using the CADILLAC Marks on its social media at [www.facebook.com/cadillacau](http://www.facebook.com/cadillacau).
- 4.8 The Complainant now seeks via the auDRP process that the registration of the Disputed Domain Name be transferred to the Complainant.

## **5. The Complainant's case**

- 5.1 The Complainant's Complaint summarises the history and reputation of the CADILLAC brand. The Complainant says and the Panel accepts that:
  - (a) it 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.
  - (b) One of the Complainant's most popular offerings is its luxury vehicle range sold under the brand and trademark CADILLAC which was established in 1902 and has been part of the Complainant's portfolio since 1909;
  - (c) The CADILLAC trademark is recognised as one of the world's most iconic luxury car brands and is very well known internationally, including in the USA, the United Kingdom, Canada, China and Australia.
  - (d) it continues to produce and sell a range of Sedan and Sports Utility Vehicle models under the CADILLAC brand, with sales showing a 14.7% increase in 2018; and



sales under the CADILLAC brand growing at a cumulative annual growth rate of approximately 14.9%;

- (e) through the Complainant's strategic marketing and promotion, the CADILLAC mark has become a symbol of status and lifestyle "...to everyone, from celebrities and professional athletes to presidents" and
- (f) That at the date of the Complaint, GM's official social media pages for the CADILLAC brand had: 3,924,460 likes and 3,892,316 followers on Facebook; 2,358,033 followers on Instagram; and 693,181 followers on Twitter.

5.2 In support of the Complaint, the Complainant relies on its prior use and various registrations, including various registered trademark rights which the Complainant says, and the Panel is satisfied, that it owns prior exclusive registered rights to the mark "CADILLAC" in which it has prior and exclusive registered rights in respect of the mark CADILLAC in Australia and worldwide, including:

- (a) US registration no. 0201694 - class 12 for "automobiles" dated 27.06.1924
- (b) Australian registration no. 44109 - class 12 for "automobiles and chassis" dated 2.03.1926;
- (c) Australian registration no. 327827 for the mark CADILLAC which covers "Installation, repair, servicing and maintenance services for land vehicles" in Class 37 dated 01.02.1979; and
- (d) Australian registration no. 1042500 for CADILLAC (word) which covers "motor vehicles" in Class 12 and "retailing services in this class relating to the sale of motor vehicles and parts and accessories for motor vehicles" in Class 35 dated 17.02.2005, collectively referred to as the "Cadillac Marks".

5.3 The Complainant says, and the Panel accepts, that it has owned registered trademark rights in its CADILLAC mark for approximately 96 years in the US and 94 years in Australia, with documentation in the Complaint evidencing GM's ownership of:

- (a) registered rights all over the world in its various Cadillac crest designs, (set out in Annexures 8 and 9 of the Complainant's Complaint and referred to as "Cadillac Logo Marks"), as well as
- (b) various unregistered trademark rights, including rights in the domain name <cadillac.com>, which was created on 20.12.1994.

5.4 The Complainant says, and the Panel is satisfied, that:

- (a) it has acquired a substantial reputation in the CADILLAC Marks and associated Cadillac Logo Marks as a result of its extensive use of the marks worldwide, including in Australia.
- (b) the CADILLAC mark was first used in Australia in the 1920s and vehicles under the CADILLAC mark have been available in Australia since then.
- (c) GM has made an advertising investment in the CADILLAC brand in Australian and internationally of over AUD100 million in 2018-2019, and regularly showcases its CADILLAC branded vehicles at international automotive shows, including in Australia.
- (d) the CADILLAC brand continues to be promoted by the Cadillac LaSalle Club of Australia, which has over 600 members, with Australian consumer interest in the CADILLAC trade mark also reflected in data included in the Complaint for Australian visitors to GM's website hosted at [www.cadillac.com](http://www.cadillac.com).



- (e) as a result of GM's extensive use of the CADILLAC mark, the trademark has acquired a strong reputation and association with GM in Australia.

5.5 The Complainant seeks that the Disputed Domain Name be transferred to the Complainant on the basis that:

- (a) The Disputed Domain Name is identical or confusingly similar to the Cadillac Marks and the domain name <cadillac.com>, which have acquired an extensive reputation in Australia and worldwide; and
- (b) the Respondent does not have legitimate rights or interests in respect of the Disputed Domain Name; and
- (c) the Disputed Domain Name was registered, or has been subsequently used, in bad faith.

## 6. The Respondent's case

6.1 The Respondent says, and the Panel accepts, that it operates a business from its facility in Melbourne at which it converts second-hand motor vehicles to right-hand drive vehicles.

6.2 The Respondent says, and the Panel accepts, that that its business is not just limited to the conversion of Cadillac vehicles and that the geographic location as to where the conversion is done is Melbourne, in Australia.

6.3 The Respondent disputes the Complainant's claim to the Domain Name in respect of which the Respondent claims it has a *bona fide* use.

## 7. Complaint Elements and the Onus of Proof

7.1 Schedule A of the .au Dispute Resolution Policy (auDRP) applies to disputes which meet the requirements set out in paragraph 4(a) of Schedule A of the auDRP. Subparagraph 4(a) requires that any party holding a domain name licence issued in the 2LDs must "...submit to a mandatory administrative proceeding in the event that a third party (complainant) asserts to the applicable Provider, in compliance with the Rules of Procedure that:

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

In an administrative proceeding, the complainant bears the onus of proof."

## 8. Is the Domain Name identical to or confusingly similar to a name, trade name or service mark in which the Complainant has rights?

8.1 The Complainant says that the Domain Name is either identical or confusingly similar to:

- (a) the Cadillac Marks; and/or
- (b) the domain name <cadillac.com>; and/or
- (c) GM's reputational rights in its mark CADILLAC,

all of which, submits the Complainant, and the Panellist accepts, were registered and used prior to the creation of the Disputed Domain Name and in respect of which GM had, at the time of such creation, legal rights and an extensive reputation for the purposes of paragraph



4 of the Policy. The Complainant relies in these respects on material included in the various Appendices to its Complaint.

- 8.2 In response to Complainant's allegations that the Disputed Domain Name is identical or confusingly similar to various marks in which the Complainant has rights and a reputation over, the Respondent asserts that the Complainant has withdrawn from and does not concern itself in the Australian Market and further, says that the Complainant has at no time sought to market or otherwise sell any goods or services to the market using any registered or unregistered trade mark of "Cadillac Australia."
- 8.3 This is disputed by the Complainant which says that GM is continuing to operate under the GM Special Vehicles brand and is also continuing to sell vehicles in Australian under its existing divisional nameplates.
- 8.4 The Respondent says that no damage can be suffered as the Complainant has already "made its margin" in respect of any sale in which the Respondent becomes a successor in title. The Panel notes however that issue in the current circumstances does not relate to whether the Complainant has received consideration in respect of individual Cadillac vehicles that the Respondent or its customers may have purchased over time, but relating to the Respondent's entitlement, or otherwise, to use a name, mark and/or logo which is owned by the Complainant.
- 8.5 While the Respondent notes Annexures 6 and 7 of the Complaint (schedules of the Complainant's Australian and world-wide trade-mark registrations) and does not dispute the existence of the Complainant's trade mark it says, that the Complainant "does not have a registered trade mark bearing the wording of *Cadillac Australia*".
- 8.6 As to this, however, the Complainant submits<sup>1</sup> and the Panel accepts, that the addition of a generic geographical term (such as Australia) to a trademark in a domain name will normally be insufficient to avoid a finding of confusing similarity.
- 8.7 The Respondent says that it is obvious from the "Home" page of the Disputed Domain Name that the Respondent is in the business of:
- (a) purchasing the Complainant's goods or services overseas;
  - (b) importing those goods into Australia; and
  - (c) modifying those goods as an after-market product to any person wishing to own a and/or illegally [*sic*<sup>2</sup>] drive a product of the complainant in Australia.
- 8.8 The Respondent has included a screenshot of the "Home" page of the Disputed Domain Name as supporting its submission that "the issue of a Disputed Domain Name does not of itself render any conduct on behalf of the Respondent as misleading and/or deceptive or otherwise capable of confusing the reasonable person test". The Panel does not accept the Respondent's submission.
- 8.9 The Panel notes that the "Home" page of the Disputed Domain Name which shows various Tabs including "Vehicle Images", "Vehicles for sale", "About us", prominently features a Cadillac and Cadillac logo, above the words: "Sydney – Melbourne" - "*Bringing the luxury*

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<sup>1</sup> The auDRP Overview is a compendium of consensus views of panels on key legal and procedural issues under the auDRP. It has been produced for auDA by [Dr Andrew F Christie](#), Foundation Professor of Intellectual Property at Melbourne Law School. The format is based on the [UDRP Overview](#) produced by WIPO and covers approximately 330 auDRP decisions from 1 August 2002 to 15 July 2014.

<sup>2</sup> legally



*of the Cadillac brand to Australian roads as right hand drive vehicles. Our conversion facility is Australian owned and operated in Melbourne. Cadillac Australia offers you the finest choice of SUV and allows you to customise your order on request.*" The Panel also notes that the Respondent's Home page gives significant prominence to an image of a Cadillac motor vehicle and a large image of a Cadillac crest design which is one of the Cadillac Logo Marks owned by the Complainant.

8.10 The Complainant submits, and the Panel is satisfied, that the CADILLAC trademark is the dominant and distinctive element of the Disputed Domain Name and that the Disputed Domain Name is confusingly similar to the Cadillac Marks and the domain name <cadillac.com>.

8.11 It follows that the Panel finds that the Disputed Domain Name is identical or confusingly similar to a name and marks in which the Complainant has rights.

**9. Does the Respondent have rights or a legitimate interest in respect of the Disputed Domain Name?**

9.1 The Complainant says, and the Panel is satisfied, that the Disputed Domain Name was registered by the Respondent on 6 April 2020, being "*many decades after GM obtained trade mark registrations for the CADILLAC mark in Australia and overseas and developed an extensive reputation in the Cadillac Marks in Australia and worldwide*".

9.2 The Complainant submits that the Respondent has no legitimate rights or interest in respect of the Disputed Domain Name. It says, and the Panel accepts, that mere registration of the Domain Name by the Respondent does not, without more, establish any right or legitimate interest to it.

9.3 The Complainant has referred the Panel to the tests laid down in *Oki Data Americas, Inc. v ASD Inc.*<sup>3</sup> as elements relevant to deciding whether the offerings of a respondent on its website under a domain name incorporating the trademark of a complainant are to be characterised as bona fide:

- (a) the Respondent must actually be offering the goods or services of interest;
- (b) the Respondent must use the site to sell only goods which bear the trademark;
- (c) the site must accurately disclose the registrant's relationship with a trademark owner - it may not, for example, falsely suggest that it is the trademark owner, or that the site is the official site, if in fact it is only one of many sales agents;
- (d) the Respondent must not try to corner the market in all domains, thus depriving the trademark owner of reflecting its own name in a domain name.

9.4 The Complainant says that the Respondent fails to meet criteria (b) and (c) because:

- (a) Although the "Home" webpage associated with the Disputed Domain Name suggests that the Respondent's business is "bringing luxury of the Cadillac brand to Australian roads as right hand drive vehicles", its business is not limited in this way. The Complainant refers the Panel to the "About Us" webpage hosted at the Disputed Domain Name, as confirming that the business converts vehicles from "other brands beyond just Cadillac" and "[the] business is here to sell the cars that you see in our stock or even to facilitate a custom order that you may have in mind".
- (b) The contact number and email address provided on the website hosted at the Disputed Domain Name diverts to another business hosted at a secondary domain

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<sup>3</sup> *Oki Data Americas, Inc. v ASD Inc. D 2001-0903*



name, <internationalmotorcars.com.au>, which is owned by the Respondent. This secondary domain name offers other non-GM brands for sale such as Dodge, Ferrari and Lamborghini, which the Complainant says are in direct competition with GM's Cadillac cars.

- 9.5 The Complainant submits that the Respondent is also utilising the Disputed Domain Name to draw business away from authorised representatives of GM and for sale of vehicles that are not necessarily those of GM but compete directly with it.
- 9.6 The Complainant says that to its knowledge (and no dispute to this assertion is raised by the Respondent), the Respondent:
- (a) has never been licensed or otherwise permitted by GM to use the CADILLAC trademark or to apply for or use any domain name incorporating that name or mark;
  - (b) has never been an authorised representative or distributor of GM's vehicles or parts;
  - (c) is not and has never been known by the Disputed Domain Name;
  - (d) has no connection with authorised CADILLAC distributors for the sale of CADILLAC brand vehicles or parts for those vehicles;
  - (e) has not acquired any registered trademark rights in the CADILLAC name or mark nor does it have any reputation in Australia or elsewhere in respect of this name or mark.
  - (f) Notwithstanding that the Respondent has no affiliation or endorsement from GM, there is no disclaimer or any suggestion to clarify the nature of the Respondent's relationship with GM. On the contrary, submits the Complainant, the use of GM's CADILLAC mark in the Disputed Domain Name together with the Cadillac Logo Marks on the website associated with the Disputed Domain Name would likely mislead consumers into believing that the Respondent's website is the official website, or it otherwise has GM's endorsement or affiliation when that is not the case.
- 9.7 The Complainant submits that the Disputed Domain Name <cadillacaustralia.com.au>
- (a) is not a domain name that the Respondent would choose unless seeking to suggest an association with GM;
  - (b) would suggest to a consumer that the Respondent is an authorised supplier of GM;
  - (c) has the effect, given the Respondent's business sells brands including those in direct competition with GM's CADILLAC brand, of disrupting GM's business because it takes advantage of GM's reputation in its mark to redirect customers to potentially competing goods to GM.
- 9.8 The Complainant says that the Respondent is at liberty to use the word "Cadillac" in the text of its website as a *bona fide* description of vehicles that are sold, or parts of vehicles which are sold but submits, and the Panel accepts, that there is no legitimate reason for the Respondent to incorporate GM's trade mark CADILLAC in the domain name address for the business.
- 9.9 The Complainant also submits that the Disputed Domain Name does not meet the eligibility requirements set out in auDA Policy '2012-04 – Domain Name Eligibility and Allocation Policy Rules for the Open 2LDs', namely:
- (a) The Disputed Domain Name is not an exact match, abbreviation or acronym of the Respondent's name<sup>4</sup>

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<sup>4</sup> Section 2(a) of Schedule C to the Policy



- (b) It is also not otherwise closely and substantially connected to the Respondent. That is, technically, the Disputed Domain Name, Cadillac Australia, is not a product the Respondent manufactures, a service that it provides, an event that it organises or sponsors, an activity that it facilitates, teaches or trains or a venue that it operates or a profession that it or its employees practise<sup>5</sup> [see section 2(b) of Schedule C to the Policy].
- (c) In addition, the Domain Name does not satisfy the requirements for domain monetisation because the Domain Name incorporates the mark CADILLAC, which was a registered trademark in Australia that was in existence at the time the Domain Name was registered<sup>6</sup>
- 9.10 The Complainant says, and the Panel is satisfied, that it has never licensed or otherwise permitted the Respondent to apply for or use any domain name incorporating the Cadillac Marks.
- 9.11 The Complainant says, and the Panel accepts, that as these facts reveal a *prima facie* case that the Respondent lacks rights or legitimate interest in the Disputed Domain Name the burden of proof shifts to the Respondent to demonstrate rights or a legitimate interest in the Disputed Domain Name.
- 9.12 As to this, the Respondent says that while it sells and converts vehicles other than Cadillacs, its business of converting second-hand Cadillac vehicles gives it a legitimate interest to use the Disputed Domain Name.
- 9.13 The Respondent says that “as the Disputed Domain Name makes reference to the type of vehicle that the Respondent is converting and selling to consumers as well as providing the geographic location as to where the conversion is done, being Australia, the Respondent fails to see how it is not afforded any interest over using the Disputed Domain Name”.
- 9.14 As to meeting the first criteria in the *Oki Data* decision, which was not pressed by the Complainant, the Respondent says that it meets this criteria because it offers the goods in question, being Cadillac vehicles and while it does sell and convert vehicles other than Cadillacs, its business of converting second hand Cadillac vehicles gives it a legitimate interest to use the Disputed Domain Name.
- 9.15 As to the second criteria in the *Oki Data* decision, the Respondent submits that even though the “About Us” page on the Disputed Domain Name says that the Respondent’s “*Melbourne workshop is where the work is completed along with other brands beyond just Cadillac*”, the the Disputed Domain Name is only used to sell Cadillac Vehicles because the email to which the “Contact” tab on the website page diverts “bares the address of [admin@internationalmotorcars.com.au](mailto:admin@internationalmotorcars.com.au)” which email address does not refer to “Cadillac”. The Panel finds this submission unconvincing.
- 9.16 As to meeting the third criteria in the *Oki Data* decision, the Respondent says that it has not used the Disputed Domain Name as a platform to falsely suggest that it is the trade mark owner, or that the Disputed Domain Name is the official site of Cadillac or General Motors or to suggest that it is affiliated with the Complainant. The Panel does not accept this submission.
- 9.17 The Panel finds that the Respondent did not accurately disclose its relationship with the Complainant, as the trade mark owner, and moreover, that the Respondent’s adoption of the

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<sup>5</sup> Section 2(b) of Schedule C to the Policy.

<sup>6</sup> Section 3 of Schedule C to the Policy.



GM's CADILLAC mark in the Disputed Domain Name together with the Cadillac Logo Marks on the website associated with the Disputed Domain Name were likely, and were intended to mislead consumers into believing that the Respondent's website was affiliated with the Complainant when that is not the case.

- 9.18 As to the fourth criteria in the *Oki Data* decision, which was not pressed by the Complainant, the Respondent says that it is not seeking to corner the market in all domains as the Respondent's conversion business is "only dealing in second hand vehicles, being vehicles which the Complainant has already sold, and already made their margin on".
- 9.19 Having regard to the evidence and submissions of the Complainant and the Respondent, my findings in relation to para. 4(a)(ii) are as follows:
- (a) The mere registration of the Domain name by the Respondent does not, without more, establish any right or legitimate interest to it.
  - (b) Having regard to the elements set out in *Oki Data Americas, Inc. v ASD Inc.*<sup>7</sup> as elements relevant in determining whether the offerings of a respondent on its website under a domain name incorporating the trade mark of a complainant to be characterised as *bona fide*, the Panel finds that:
    - (i) the Respondent has used the site to sell goods other than those bearing the CADILLAC trade mark; and
    - (ii) having regard to adoption of the GM's CADILLAC mark in the Disputed Domain Name together with the Cadillac Logo Marks on the website, the Respondent has falsely implied or suggested that it is the trade mark owner, or that the site is affiliated or associated with the trade mark owner.
  - (c) Given that the facts and evidence demonstrated a *prima facie* case that the Respondent lacks rights or legitimate interest in the Disputed Domain Name the burden of proof shifts to the Respondent to demonstrate rights or a legitimate interest in the Disputed Domain Name and The Panel finds that the Respondent has failed to discharge this burden.
- 9.20 The Complainant submits, and the Panel accepts, that
- (a) the Respondent is not an authorised distributor or reseller of GM's goods,
  - (b) the Respondent's business offers goods other than CADILLAC, including from the Complainant's competitors;
  - (c) the Respondent has incorporated and used the Complainant's CADILLAC mark and badge prominently on its home page to suggest a relationship with GM that it does not have, and
  - (d) the Respondent's registration and use of the Disputed Domain Name lacks *bona fides*.
- 9.21 It follows that the Panel finds that the Respondent does not have rights or a legitimate interest in respect of the Disputed Domain Name.

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<sup>7</sup> *Oki Data Americas, Inc. v ASD Inc. D 2001-0903*



- 9.22 The Complainant is required to satisfy each of the elements of para. 4(a) so the Panel must now consider the third element of para. 4(a).
- 10. Has the Disputed Domain Name has been registered or subsequently used in bad faith**
- 10.1 Paragraph 4(b) of the Policy provides a non-exhaustive list of matters which, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.
- 10.2 The Complainant submits that the Panellist should have regard to the following subparagraphs of para 4(b), namely:
- (iii) [the Respondent has] registered the domain name primarily for the purpose of disrupting the business or activities of another person; or
  - (iv) by using the domain name, [the Respondent has] have intentionally attempted to attract, for commercial gain, Internet users to a website or other online location, by creating a likelihood of confusion with the complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of that website or location or of a product or service on that website or location."
- 10.3 The Complainant says, and the Panel accepts, that the nature of the Respondent's business, which offers CADILLAC branded vehicles, amongst other brands of vehicles for sale, indicates that the Respondent intentionally chose to register and use GM's CADILLAC trade mark in the Disputed Domain Name.
- 10.4 The Complainant submits, and the Panel accepts, that the Disputed Domain Name <cadillacaustralia.com.au> :
- (a) is not a domain name that the Respondent would choose unless seeking to suggest an association with GM;
  - (b) would suggest to a consumer that the Respondent is an authorised supplier of GM;
  - (c) has the effect, given the Respondent's business sells brands including those in direct competition with GM's CADILLAC brand, of disrupting GM's business because it takes advantage of GM's reputation in its mark to redirect customers to potentially competing goods to GM.
- 10.5 The Complainant says, and the Panel is satisfied, that it has never licensed or otherwise permitted the Respondent to apply for or use any domain name incorporating the Cadillac Marks.
- 10.6 The Complainant submits, and the Panel accepts, that the Respondent chose and is using the Disputed Domain Name to attract, for commercial gain, internet users to its web site, by creating a likelihood of confusion with GM's mark as to the sponsorship, affiliation, or endorsement of its website or of a product or service on its website. In this respect the Claimant points to the "Home" webpage hosted at the Disputed Domain Name which not only uses the CADILLAC word mark but also uses GM's registered Cadillac Logo Marks.
- 10.7 The Complainant submits, and the Panel accepts, that the use of the Disputed Domain Name together with prominent displays of GM's Cadillac Marks and Cadillac Logo Marks is likely to mislead or deceive consumers into believing that the Respondent has an association or affiliation with GM, when that is not the case.



- 10.8 The Complainant refers the Panel to *GM Holden Ltd. v. Bradley John Lawless*<sup>8</sup> and says that the Respondent's failure to clarify that it is in no way associated with GM supports a finding that the Disputed Domain Name was registered and used in bad faith.
- 10.9 The Complainant says further that as a result of GM's reputation in the Cadillac Marks:
- (a) the use of the Disputed Domain Name in relation to vehicles and related services is likely to amount to misleading and deceptive conduct in contravention of the Australian Consumer Law; and
  - (b) The use of the Disputed Domain Name could also amount to trade mark infringement, noting that the risk of trade mark infringement and/or breach of the Australian Consumer Law, would prevent the Respondent from using the Domain Name in connection with any *bona fide* sale of relevant goods and/or services.
- 10.10 The Panel accepts the Complainant's submissions that the Respondent is not an authorised distributor or reseller of GM's goods; that the Respondent's business offers goods from GM's competitors, has incorporated the Complainant's CADILLAC mark and badge prominently on its home page to indicate a relationship with CM that the Respondent does not have.
- 10.11 The Complainant submits that the Respondent registered and has been using the Disputed Domain Name in bad faith because the Disputed Domain Name does not meet the eligibility requirements set out in auDA Policy '2012-04 – Domain Name Eligibility and Allocation Policy Rules for the Open 2LDs', namely:
- (a) The Disputed Domain Name is not an exact match, abbreviation or acronym of the Respondent's name<sup>9</sup>
  - (b) It is also not otherwise closely and substantially connected to the Respondent. That is, technically, the Disputed Domain Name, Cadillac Australia, is not a product the Respondent manufactures, a service that it provides, an event that it organises or sponsors, an activity that it facilitates, teaches or trains or a venue that it operates or a profession that it or its employees practise<sup>10</sup>.
  - (c) In addition, the Panel finds that the Domain Name does not satisfy the requirements for domain monetisation because the Domain Name incorporates the mark CADILLAC, which was a registered trade mark in Australia that was in existence at the time the Domain Name was registered<sup>11</sup>.
- 10.12 In response to the Complainant's asserted bases and submissions that the Respondent registered or has subsequently been using the Disputed Domain Name in bad faith, the Respondent relies on its previous submissions in response to para 4(a)(ii) of Schedule A of the auDRP, and says by virtue of these submissions that it has established a *bona fide* use of the Disputed Domain name.
- 10.13 The Panel has already found with respect to para 4(a)(ii) that the Respondent's registration and use of the Disputed Domain Name lacks *bona fides* and that the Respondent does not have rights or a legitimate interest in respect of the Disputed Domain Name.

<sup>8</sup> GM Holden Ltd. v. Bradley John Lawless WIPO Case No. DAU2010-0010

<sup>9</sup> Section 2(a) of Schedule C to the Policy

<sup>10</sup> Section 2(b) of Schedule C to the Policy.

<sup>11</sup> Section 3 of Schedule C to the Policy.



10.14 Based on the material in the Complaint and having regard to the submissions of the Complainant and the Respondent, the Panel finds that the Disputed Domain Name has been registered and used in bad faith, based on the following findings:

- (a) The Panel finds that the Disputed Domain Name does not meet the eligibility requirements set out in auDA Policy '2012-04 – Domain Name Eligibility and Allocation Policy Rules for the Open 2LDs' because the Disputed Domain Name is not an exact match, abbreviation or acronym of the Respondent's name<sup>12</sup>; is not otherwise closely and substantially connected to the Respondent and does not satisfy the requirements for domain monetisation because the Domain Name incorporates the mark CADILLAC, which was a registered trade mark in Australia that was in existence at the time the Domain Name was registered<sup>13</sup>.
- (b) The Panel finds the Disputed Domain Name has been used to attract, for commercial gain, internet users to its web site, by creating a likelihood of confusion with the Complainant's mark as to the sponsorship, affiliation, or endorsement of its website or of a product or service on its website, noting that the "Home" webpage hosted at the Disputed Domain Name only uses the CADILLAC word mark but also prominently uses the Complainant's registered Cadillac Logo Marks.
- (c) There is no question, and the Respondent does not assert that it was not aware at the time the Disputed Domain Name was registered that the Complainant had rights in the CADILLAC name. The Respondent also continued to use the Disputed Domain Name and to prominently display the Complainant's registered Cadillac Logo Marks notwithstanding the letter from the Complainant objecting to the unauthorised use of the Cadillac Marks and requesting that the Respondent desist from trading under the name Cadillac Australia and cease its unauthorised use of the Cadillac Marks.

## 11. Decision

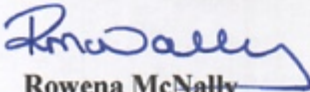
11. The Panel concludes for the reasons stated:

- (a) That the Disputed Domain Name is identical with or confusingly similar to a name, trademark, or service mark in which the Complainant has rights;
- (b) That the Respondent has no rights or legitimate interest in the Disputed Domain Name; and
- (c) That the Respondent registered and used the Disputed Domain Name in bad faith.

## 12. Relief: Transfer of the Disputed Domain Name

12. The Panel orders that the Domain Name <www.cadillacaustralia.com.au> be transferred to the Complainant.

Date: 30 October 2020

  
**Rowena McNally**  
Sole Panellist

<sup>12</sup> Section 2(a) of Schedule C to the Policy

<sup>13</sup> Section 3 of Schedule C to the Policy.