



Alternative Dispute Resolution (ADR)

Decision
02-17-2017

Case number
948

Applicant

Onstar, LLC (3136554)
400 Renaissance Center
Detroit Michigan 48265-4000
USA

Counsel:

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Box 3690
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Sweden

Domain holder

Ernest P.

Matter

Alternative dispute resolution regarding the Domaine Name <**onstar.se**>.

Decision

The Domaine Name <**onstar.se**> shall be transferred to the Applicant.

Background to the dispute

Onstar, LLC (hereinafter the Applicant) is a subsidiary of General Motors LLC. The Applicant provides a range of goods and services to car drivers under the trademark ONSTAR. The Applicant is the holder of *inter alia* the EU trademark ONSTAR (word), No. 006274666, application

filed September 14, 2007 and the national Swedish trade mark ONSTAR (word), No. 331053, application filed Mars 3, 1997.

Ernest P. (hereinafter the Domain holder) is the holder of the Domaine Name <onstar.se> registered on December 16, 2015.

The Applicant has applied to .SE for dispute resolution on September 14, 2016. The Domain holder has desired that the matter be handled by three arbitrators. The Applicant has appointed Peter Hedberg as arbitrator. The Domain holder has appointed Jan Rosén as arbitrator. The .SE has elected Per Carlson as arbitrator and chairman of the panel.

Claims

The Applicant has requested that the Domaine Name <onstar.se> be transferred to the Applicant.

The Domain holder has contested the request.

Facts of the case / Parties' contentions

Grounds

In support of its claim the Applicant has relied on the grounds, that the Domaine Name <onstar.se> is identical to the Applicant's registered trade mark consisting of the word ONSTAR, that the Domaine Name has been registered in bad faith and that the Domain holder has no rights to or justified interest in the Domaine Name.

The Domain holder has not disputed that the Domaine Name <onstar.se> is identical to the trade mark ONSTAR, but has denied that the Domaine Name has been registered in bad faith as well as that the Domain holder has no rights to nor a justified interest in the Domaine Name.

Presentaion of allegations

The Applicant

The trade mark ONSTAR was first put into use in 1996 and today there are nearly 7 million subscribers globally. In early 2015 the Applicant publicly announced that the services provided under the trademark ONSTAR would be launched on the Swedish market in 2016, *inter alia* in the evening paper Expressen on March 4, 2015. Adam Opel AG of Germany is an affiliate of General Motors LLC and ONSTAR services are available for installation in Opel vehicles.

According to a LinkedIn account, the Domain holder worked for "General Motors – OnStar" during a period of close up to three years and up to 2014. Furthermore the Domaine Name was registered shortly after the point in time where the Applicant announced the trademark ONSTAR was to be launched on the Swedish market. These circumstances suggests, in our opinion, that the domain namne was registered in bad faith.

The Domaine Name onstar.se is not actively used and appears to have been parked since the time of registration. The website features a link through which an offer to buy the Domaine Name can be made. Thus, the domain owner does not have any right to or legitimate interest in the Domaine Name.

It is noted that ONSTAR software is installed in motor vehicles and allows the motor vehicle driver to access the service for emergency, security, navigation and vehicle diagnostics. There is also an app that allows the vehicle owners to remotely access certain functions in their vehicles. To permit

an unrelated third party to own onstar.se could not only confuse the public as to the owner of the ONSTAR service, but if there is a vehicle emergency, security or navigation issue and the e-mail is misdirected because of ownership of onstar.se by a third party, then public health and safety could be endangered. In that sense, this is more than an ordinary Domain Name dispute.

The circumstances in this matter suggest that the Domain Name onstar.se was registered in such a way which the .SE general rules intend to prevent.

The Domain Holder

I worked for General Motors as a consultant and I liked the Domain Name <onstar.se>. I would have liked to buy the Domain Name for my daughter, being my "star". And I wanted to give her the Domain Name as a gift to remind her of the fact that she is Swedish and that she has Swedish roots. But to buy the Domain Name while working for General Motors would have been disloyal to the company and therefore "illegal".

When I left General Motors I began to check if the Domain Name was available. I noticed that the registration of the Domain Name had been deactivated and that the Domain Name was available. But I waited six months before I bought the Domain Name, so that the "period of grace" would elapse. Since I waited six months, my acquisition of the Domain Name must be considered to be "legal".

I acquired the Domain Name after it had been available for registration and have paid the annual fees. Any one person is allowed to buy and own a Domain Name that is available and offered by a registrar. There is no substance in the allegation that I bought the Domain Name in bad faith. Therefore the allegation is in the highest degree degrading for me.

Findings of the Arbitrators

In accordance with article 7.2 of the .SE's Terms and Conditions of registration, a Domain Name may be transferred to the party requesting dispute resolution proceedings, if the following three conditions are fulfilled:

1. the Domain Name is identical or similar to a distinguishing product feature, *inter alia* a trade mark, which is legally binding in Sweden and to which the party requesting dispute resolution can prove its rights,
2. the Domain Name has been registered or used in bad faith, and
3. the Domain Holder has no rights or justified interest in the Domain Name.

The Applicant is the holder of trade marks, legally binding in Sweden, consisting of the word ONSTAR. The Domain Name <onstar.se> is identical with the Applicant's trade marks consisting of the word ONSTAR.

From the Domain holder's statement it is clear that he was aware of the fact, that the Applicant used ONSTAR as a trade mark at the point of time of the registration of the Domain Name. Under these circumstances the Domain holder must have understood that the Applicant had an interest in the Domain Name, although the registration of the Domain Name previously had been deactivated. Therefore, the Domain Name must be considered to have been registered in bad faith in the meaning of the .SE's Terms and Conditions of registration.

The Domain holder has not stated any fact that would constitute a right or a justified interest in the Domain Name.

On the basis of the foregoing, the Arbitrators conclude that the Domain Name <**onstar.se**> shall be transferred to the Applicant.

On behalf of IIS

Per Carlson

Arbitrators: Per Carlson (Chairman), Peter Hedberg and Jan Rosén