Decision for dispute CAC-UDRP-101302

Case number	CAC-UDRP-101302
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Domain names	MY-GTI.COM

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	Volkswagen AG

Complainant representative

Organization	Lubberger Lehment

Respondent

Name	Matthew McDonald

OTHER LEGAL PROCEEDINGS

None

IDENTIFICATION OF RIGHTS

Volkswagen AG is the owner of the “VOLKSWAGEN” trademark, registered extensively, either on its own or in combination with other terms and designs, especially the “VW” logo (e.g. EU trademark No. 000703703, German trademark No. 621252, and the US trademark No. 71665739); details and official printouts of which are set out in and annexed to the Complaint filed by the Complainant.

Volkswagen AG is also the owner of other trademarks such as the international trademark registration “GTI” (No. 717592), the German trademark “GTI” (No. 39406386), and the US trademark registration “GTI” (No. 1540381), with priority from the years 1987, 1995 and 1999. These trademarks claim protection for the following goods in class 12: automobiles and their parts; engines for automobiles. Volkswagen AG has also registered the following word trademarks: “VW” (EU trademark No. 001354216, in classes 4, 7, 9, 12, 14, 16, 18, 25, 28, 35, 36, 37, 38, 39, 40, 41, and 42), “GOLF” (EU trademark No. 000751909, in classes 4, 7, 12, 27, 28, and 37), “GOLF GTI” (EU trademark No. 829749160, in class 12), and “RNS” (EU trademark No. 002893105, in class 9).

FACTUAL BACKGROUND

The Complainant, a German multinational automotive manufacturing company headquartered in Wolfsburg (Germany), is

the holding company of the Volkswagen Group, which was founded 1937. The Volkswagen Group is one of the world's leading automobile manufactures and the largest carmaker in Europe and has been manufacturing cars, vehicles, and vehicle accessories since their founding. The Golf car is Volkswagen's best-selling model and the world's second best-selling car model with more than 29 million built by 2012.

The Respondent, Matthew McDonald, supposedly an Australian citizen, is the owner of the disputed domain <my-gti.com>, registered on August 26, 2008, and is involved in the Volkswagen fan community.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant submits that it owns registered trademark rights as noted above. He alleges that the trademarks "GTI" and "VOLKSWAGEN" are well-known by significant parts of the public and will be associated with the Complainant exclusively. In the process of its market monitoring activities regarding the fight against piracy, counterfeiting and copyright infringements the Complainant recently became aware of the domain "my-gti.com" registered on August 26, 2008 by the Respondent.

The Complainant says that the domain <my-gti.com> is confusingly similar to the trademarks "GTI", as it consists of the trademark "GTI" and the generic term "MY", which is common for advertising to create a special binding between the sign and the consumer (Comerica Bank v. Will Rote, WIPO Case No. D2016-0425; Banque Pictet & Cie SA v. Brian Dyson and David Kalan, WIPO Case No. D2016-1114). In this case, says the Complainant, the mere addition of non-distinctive text elements to the Complainant's trademark constitutes confusing similarity, as set out in paragraph 4 (a) (i) of the Policy (Karen Millen Fashions Limited v. Akili Heidi, WIPO Case No. D2012-1395; Belstaff S.R.L. v. Jason Lau Sharing, WIPO Case No. D2012-0783; Lime Wire LLC v. David Da Silva, WIPO Case No. D2007-1168). And the Complainant to add that the presence of the ".com" generic top-level-domain is negligible (Telecom Personal v. maezero.com, WIPO Case No. D2001-0015; Nokia Corp. v. Private, WIPO Case No. D2000-1271).

The Complainant states that, since registration, the disputed domain name is used for the offer of copyright infringing software updates for the navigation system "RNS" used in the cars of the Complainant, inter alia the "GTI" model. Furthermore, there is an extensive unauthorized use of the registered trademarks "Volkswagen" and "RNS" says the Complainant. Moreover, according to the Complainant the Respondent is not the owner of the "GTI" word trademark and that this trademark precedes the registration of the domain <my-gti.com> by 20 years.

The Complainant notes that he has not authorized the Respondent to use the trademark "GTI" or sell copies of their navigation system software (Compagnie de Saint Gobain v. Com-Union Corp, WIPO Case No. D2000-0020) and therefore has no prior rights in the disputed domain.

Additionally, the Complainant contends that the Respondent was certainly aware of the "GTI" trademarks of the Complainant at the time of registering the domain name at issue (for instance, in 2008, the year of registration, a picture of the Golf GTI was already displayed) as the offer of the Respondent on their website refers from the outset to the products of the Complainant (Volkswagen AG v. Privacy Protection Services, WIPO Case No. D2012-2066). Furthermore, according to the Complainant the registration of a well-known trademark as a domain name is a clear indication of bad faith in itself (The Gap Inc. v. Deng Youqian, WIPO Case No. D2009-0113).

Also, according to the Complainant, the Respondent registered the contested domain primarily for the purpose to attract, for commercial gain, Internet users to the website, by creating a likelihood of confusion with the Complainant's trademark "GTI" as to the source, sponsorship, affiliation, or endorsement of the website and the copyright infringing software on this website, para 4 (b) (iv) of the Policy. Finally, the Complainant notes that the Respondent or the person responsible for the content of the website concealed their identity by using a proxy service which enables holding a domain anonymously which indicates bad faith registration and use of the domain name (Pharmacia & Upjohn AB v. Dario H. Romero, WIPO Case No. D2000-1273).

RESPONDENT:

The Respondent makes the following submissions.

Identical or Confusingly Similar
The Respondent alleges that “GTI” is an acronym that is widely used by many car manufacturers and is not exclusive to Volkswagen.

The Respondent argues that “GTI” is not distinctive in the general public’s eyes and the letters “GTI” are seen as a description of the technical characteristics of the car or engine. He provided details and excerpts of a decision of the General Court of the Court of Justice of the EU (Volkswagen v. OHIM, Case T-63/09) where the Court had to decide about the risk of confusion between the trademarks “GTI” and “SWIFT GTI”.

The Respondent notes that the Wikipedia entry for “GTI” has six listings for automotive use further supporting that “GTI” is a generic term unless used in conjunction with a car model such as “Swift GTI” or “205 GTI”.

Rights or Legitimate Interests

The Respondent claims that he chose the domain <my-gti.com> because he wanted to detail his experience (“MY car”) with the Volkswagen Golf GTI he ordered in January 2008 and was delivered on May 16, 2008. He says that he had always associated the term “GTI” with the French car manufacturer Peugeot, regarded it as a generic name, and denoted a sportier model. After the purchase of the car, the Respondent became heavily involved in both the Volkswagen fan community and in a large number of local meetups, and then decided to setup his own website where he could put information in one place for anyone to access.

The Respondent says that the “about page” on <my-gti.com> has stated since at least 2013: “This site has been set-up primarily to document modifications to my car but also to serve as a reference site, where-ever possible the work has been performed on my car and documented from that. There are often many projects on the go, not all get off the ground or are documented here for cost reasons as getting parts in Australia is very expensive compared to the EU”.

The Respondent contends that there are links on <my-gti.com> to third party websites that host the firmware which are bug fixes and minor upgrades that have been uploaded by members of the Volkswagen fan community due to the reluctance or refusal of the dealers to assist with usability problems with the head units by updating the firmware. He claims that there is nothing sold on the <my-gti.com> domain.

The Respondent finally notes that the Complainant has not provided evidence that the Respondent has derived any revenue from the website.

Registered and Used in Bad Faith

The Respondent says that the use of the trademarks “Volkswagen”, “RNS”, “VW” and “GTI” are used to identify the model of vehicle or the type of accessory that the article on his website pertains to. According to the Respondent, no use is made of Volkswagen logos on the website nor is there any attempt at misleading visitors. He claims that he recently added a disclaimer to the bottom of every page in order to avoid any confusion between the Complainants and his website.

The Respondent claims that there have been over 4800 comments left on the various posts on <my-gti.com> and not one of them has ever mentioned mistaking the site for a Volkswagen AG affiliated website. He added that he is a huge fan of Volkswagen since he became part of the Volkswagen fan community and would not do anything to harm the company. According to the Respondent, the website offers information and help that can only promote the brand.

The Respondent also contends that there is no evidence to support the claim from the Complainant that the domain is used

to divert people from Volkswagen for commercial gain nor is there anything to support the claim that the domain has disrupted the business of the Complainant. Finally, the Respondent notes that the domain name proxy (privacy) registration is offered standard by Google when you register a domain through them, and the contact has always been available from the website contact form or via email.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the Domain Name is identical or confusingly similar to a trademark or service mark in which the complainant has rights (within the meaning of paragraph 4(a)(i)of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has not, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the Domain Name (within the meaning of paragraph 4(a)(ii)of the Policy).

BAD FAITH

The Complainant has not, to the satisfaction of the Panel, shown the Domain Name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

PROCEDURAL FACTORS

The Complainant as well as the Respondent has submitted several supplemental filings within the course of proceedings. Bearing in mind the need for procedural efficiency, and the obligation to treat each party with equality and ensure that each party has a fair opportunity to present its case, the Panel finds submitted supplemental filings admissible for they contain useful explanations. In other words, while rendering its decision the Panel took into consideration the standard documents (i.e. the complaint and the response to the Complaint), as well as all supplemental filings.

The Panel took into consideration the standard documents (Complaint and Answer to the Complaint), as well as all supplemental filing. Altough this is not strictly speaking the normal procedure, the Panel is convinced that such supplemental information brought useful explanation, without harming parties right to a fair and equal treatment.

PRINCIPAL REASONS FOR THE DECISION

IDENTICAL OR CONFUSINGLY SIMILAR - paragraph 4(a)(i) of the Policy

Complainant has clearly established that there are trademarks in which Complainant has rights. The trademarks have been registered and used around the world.

The Panel considers the disputed domain name <my-gti.com> incorporates one the Complainant’s trademarks “GTI” in its entirety and differs only in its inclusion of the descriptive, generic word “my”, a hyphen between “my” and “GTI”, and the non-distinctive generic Top-Level Domain (gTLD) extension ".com”.

The hyphen is a non-distinctive element which serves only to represent the natural space between the two words “my” and “GTI”, which cannot be represented in a domain name except through a device such as a hyphen or an underscore. In the Panel’s view, the additional letters “my” do not detract from the distinctiveness of the “GTI” trademark.

Numerous UDRP decisions have established that adding a generic to a complainant's mark does not influence the confusing similarity between a trademark and a domain name (Comerica Bank v. Will Rote, WIPO Case No. D2016-0425; Banque Pictet & Cie SA v. Brian Dyson and David Kalan, WIPO Case No. D2016-1114).

Finally, the gTLD extension ".com" is not typically to be taken into consideration when examining the identity or confusing similarity between a complainant's trademark and a disputed domain name (Accor v. Noldc Inc., WIPO Case No. D2005-0016). The adjunction of the gTLD ".com" is irrelevant as it is well established that it is insufficient to avoid a finding of confusing similarity (L'Oréal v. Tina Smith, WIPO Case No. D2013-0820; Titoni AG v. Runxin Wang, WIPO Case No. D2008-

0820; and Alstom v. Itete Peru S.A., WIPO Case No. D2009-0877).

The Panel therefore concludes that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

RIGHTS OR LEGITIMATE INTERESTS - paragraph 4(a)(ii) of the Policy

On the one hand, the Panel finds from the facts put forward that:

- The Complainant has clearly established that the Respondent is not in any way affiliated with the Complainant or otherwise authorized or licensed to use the “GTI” trademark or register the disputed domain name containing the Complainant’s trademark;

- The Panel accepts that the Complainant registered and began using the “GTI” trademark well before the disputed domain name was registered;

- Respondent is indeed not authorized to promote or sell copies, of any kind, of Volkswagen navigation system software;

- Respondent has incorporated a picture of the Golf “GTI” into his website, with Complainant’s branded products. This is based on the screenshots provided by the Complainant of the Respondent Website, and the Panel’s review of the Complainant’s website at “my-gti.com” (in accordance with the Panel’s powers granted under paragraph 10(a) of the Rules).

- Respondent chose the domain name <my-gti.com> after the purchase of his Volkswagen Golf GTI and once he was heavily involved in both the Volkswagen fan community and in a large number of local meetups;

On the other hand, the Panel finds from the facts put forward that:

- Respondent just wanted to detail his experience with his Volkswagen Golf GTI;

- The website contains links to third party websites that publish information and/or host the firmware. However, the Respondent does not generate any income via these websites and appears to have no commercial intentions;

- The site is actually in use, clearly distinctive from any official site of the Complainant (cfr. the disclaimer at the bottom of every pages), and the activities carried out at the Respondent’s website appear to be essentially noncommercial in nature (no advertisements on the website);

Put in short, the site of the Respondent is a mix of many different things: a fan site, a criticism site, a review site, an informative site.

Whether such site(s) can generate rights or legitimate interest is largely discussed.

In relation with fan site, most Panels will grant it a legitimate interest if it can demonstrate that it is active and non-commercial use. Sometime, Panels even accept that a degree of incidental commercial activity may be permissible in certain circumstances (e.g., where such activity is of an ancillary or limited nature or bears some relationship to the site's subject) [See <http://www.wipo.int/ >]. Other Panels will consider per default that such site does not have rights or legitimate interests in expressing its view, even if positive, on an individual or entity by using an identical or confusingly similar domain name, if it is intentionally misrepresenting itself as being (or as in some way associated with) that individual or entity, or seeks to derive commercial advantage from its registration and use.

It appears that from a UDRP perspective, the important criteria are:

(i) is the site active?

(ii) is it noncommercial?
(iii) is it misrepresenting itself?
(iv) is it taking or seeking commercial advantage?

Respondent's site is clearly active.

There is no conclusive element proving that there is a commercial use. No sponsored link was found; there is no publicity; there is nothing sold. It is true that the site provides information that could have an impact on the commercial activity of the Complainant (information on spare parts, information on the software present in the car, general information on technical aspects of the cars, etc.) but it does not amount to a commercial use.

In the Panel's view, it is not sufficiently established, in the limited framework of a UDRP procedure, that the Respondent is intentionally misrepresenting itself as being (or is in some way associated with) the Complainant, or seeks to derive commercial advantage from its registration and use. The explanation provided by the Respondent are coherent and it appears, from the information available to the Panel that the promotor of the site has acted coherently with the purpose he claims that he followed.

Accordingly, the Panel concludes that the Complainant has not satisfied the requirements of paragraph 4(a)(ii) of the Policy.

REGISTERED AND USED IN BAD FAITH - paragraph 4(a)(iii) of the Policy

The Complainant contends that the Respondent registered and has been using the disputed domain name in bad faith. In particular, the Complainant invokes paragraph 4(b)(iv) of the Policy, under which a panel may find both registration and use in bad faith if there is evidence that by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation or endorsement of the respondent's website or of a product or service on it.

The Complainant contends that the Respondent registered the domain name with knowledge of the Complainant's well-known trademark and with a view to attracting Internet users to its website by way of the Complainant's trademark. The Complainant then goes on to allege that the Respondent's purpose in attracting Internet users to its website was commercial.

The Panel accepts that the Respondent likely knew of the Complainant and the Complainant's "GTI" trademark registrations (in the United States of America, Europe, and elsewhere throughout the world) at the time it registered the disputed domain name; it is highly implausible that the Respondent was ignorant of the Complainant's brand when it registered the disputed domain name.

The Respondent claims to be a fan community and a website where information about Volkswagen could be found and shared.

The Panel is of the view that the Respondent's site is not a mere fan site; it is a bit of many different things: a fan site, a criticism site, a review site, an informative site.

Regardless the genuine nature of the site (which is a complex question that goes far beyond the limited power of a UDRP Panel), all sites of this kind have something in common: they inevitably place themselves in relation to "something or someone else". It can be an artist (most fan sites), a person, a product or a trademark (most criticism sites), etc. If bad faith was demonstrated by the mere fact that such sites are in the same zone of influence of that "something or someone else", there wouldn't be any site of this kind any more. There must be something more; the Panel needs to make a balance; it must take into consideration the context and all the facts of the case.

This Panel would have no difficulty in concluding that the disputed domain name was registered and is being used in bad

faith within the meaning of paragraph 4(b)(iv) of the Policy if there was anything conclusive before the Panel to suggest that the Respondent's purpose was indeed commercial.

In this case, there is nothing before the Panel to demonstrate any commercial purpose on the part of the Respondent.

The Respondent is neither selling any spare parts and/or accessories for the products of the Complainant nor benefiting from any advertisements or/and sign of any commercial endeavour. It is true that the Respondent's site provides information that could have an impact on the commercial activity of the Complainant. It is also true that the legality of such activity can, in certain circumstances and depending on the applicable law, be questionable (the legal framework on spare parts for example). And it is still true that the legality of the offer has a great impact of the alleged good/bad faith. However, the Panel would like to emphasize that the burden of proof rests with the Complainant. It is not purpose of the administrative proceedings to determine whether actions of the Respondent are to be considered legal within all jurisdictions. In other words, it is not the role of the Panel to undertake such complex research. As a matter of fact, pursuant to paragraph 10(a) of the Rules a Panel may undertake only limited factual research into matters of public record if it deems this necessary to reach the right decision (see Sensis Pty Ltd., Telstra Corporation Limited v. Yellow Page Marketing B.V., WIPO Case No. D2011-0057 and Latchways PLC v. Martin Peoples, WIPO Case No. D2010-1255). In that regard, the Complainant failed to submit any evidence that the Respondent actions are illegal. Therefore, the Panel finds on the balance of probabilities that the Respondent has not registered or used disputed domain name in bad faith.

The consensus on proxies is that although use of a privacy or proxy registration service is not in and of itself an indication of bad faith, the manner in which such service is used can in certain circumstances constitute a factor indicating bad faith. In this case, the Panel finds it unproved that the Respondent' use of a proxy registration service is an indication of bad faith. The Panel notices for instance that the contact has been available from the website contact form or via email. The Panel also notes that the Respondent has reacted in this procedure and filed an Answer to the Complaint, showing by his attitude that the use of a proxy can have another reason that hiding himself or making it more difficult for a Complainant to defend its rights.

In the absence of any conclusive evidence of a commercial intent behind the Respondent's registration and use of the domain name, it seems probable to the Panel that the Respondent is using the domain name for its claimed purpose.

The Panel is, so far, unable to conclude that the domain name was registered and is being used in bad faith within the meaning of paragraph 4(a)(iii) or otherwise of the Policy.

If new evidence subsequently comes to light to suggest that the Respondent's intent behind registration of the domain name was not as the Respondent claims, it may be that a re-filed complaint will be accepted.

As a general remark, the Panel is of the opinion that this case raises complex questions. Such questions can have a tremendous impact on the case. However, such questions are too complex to be treated in the limited framework of a UDRP procedure. In complex cases like this one, where the solution needs a thorough assessment of (notably) trademark law, a court case could be a better option.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **MY-GTI.COM**: Remaining with the Respondent

PANELLISTS

Name	**Mr. Etienne Wéry**

DATE OF PANEL DECISION 2016-11-02