

ADMINISTRATIVE PANEL DECISION

Hyundai Motor Company, Genesis Motor America LLC v. Michael Ianelli
Case No. D2023-5223

1. The Parties

The Complainant is Hyundai Motor Company, Republic of Korea, and Genesis Motor America LLC, United States of America (“United States”), represented by VLP Law Group LLP, United States

The Respondent is Michael Ianelli, United States.

2. The Domain Name and Registrar

The disputed domain name <genesisofenglewood.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 15, 2023. On December 15, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 15, 2023, 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 (Registration Private, Domains by Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 22, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on December 27, 2023.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), 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 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on January 9, 2024. In accordance with the Rules, paragraph 5, the due date for Response was January 29, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Parties of the Respondent’s default on February 7, 2024.

The Center appointed Ingrīda Kariņa-Bērziņa as the sole panelist in this matter on February 12, 2024. 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

The Complainant Hyundai Motor Company (“Hyundai”), headquartered in South Korea, manufactures and sells vehicles around the world, including those sold under the GENESIS mark. The Complainant Genesis Motor America LLC (“Genesis”) is its wholly owned subsidiary in the United States and operates as its franchisor and licensor.

Hyundai is the proprietor of the following registrations:

- United States Trademark Registration No. 3531628 for GENESIS (word mark), registered on November 11, 2008 for goods in class 12;
- International Trademark Registration No. 939229 for GENESIS (word mark), registered on September 6, 2007 for goods in class 12.

The Complainant has registered numerous domain names reflecting its GENESIS mark, including <genesis.com>. The Complainant has authorized its accredited dealerships to register domain names taking the form of “genesisof” followed by the name of the relevant geographic location, such as <genesisofdenver.com> and <genesisofatlanta.com>. The record contains evidence that the Complainant had established a dealership in Englewood, in the United States.

The disputed domain name was registered on September 2, 2021. It previously resolved to a parking page of the Registrar. At the time of this Decision, it did not resolve to an active website.

The record reflects that the Complainant sent a cease-and-desist notice to the Respondent through the Registrar on November 21, 2023. The record does not reflect a response thereto.

No information is available about the Respondent.

5. Parties’ Contentions

A. Complainant

The Complainant’s contentions may be summarized as follows:

1. Request to consolidate proceedings

The Complainant requests consolidation of the proceedings for the following reasons. Hyundai and Genesis are affiliates within Hyundai Motor Group. Hyundai is the proprietor of the registered GENESIS mark, and Genesis is the franchisor and licensor of such rights in the United States. The two entities have a sufficient common legal nexus in the GENESIS trademark to support the filing of this Complaint on behalf of both entities.

2. Substantive contentions

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends, which is the third-largest global producer of automobiles by volume, that it introduced its Genesis vehicle in 2008. This model has earned numerous awards and is distributed by over 200 dealerships in the United States. The majority of these dealerships make use of the nomenclature “Genesis of [geographic location]”. The disputed domain name incorporates the Complainant’s GENESIS mark in its entirety, followed by the geographic and descriptive term “of englewood.” The Complainant is not related to the Respondent and has not granted it permission to use the GENESIS mark. The Complainant has had rights in the GENESIS mark from the year 2000 in the European Union, and 2008 in the United States. The Complainant’s GENESIS mark has been continuously and extensively used since that time. The construction of the disputed domain name reflects the naming convention used by the Complainant’s authorized dealers and prevents the Complainant from reflecting its trademark in such a domain name. The Complainant claims that the disputed domain name resolved to a website featuring pay-per-click (“PPC”) links to third-party advertising, including links potentially in competition with the Complainant’s business.

B. Respondent

The Respondent did not reply to the Complainant’s contentions.

6. Discussion and Findings

6.1 Preliminary Issue – Consolidation of Proceedings

Pursuant to paragraph 10 of the Rules:

- (a) The Panel shall conduct the administrative proceeding in such manner as it considers appropriate in accordance with the Policy and these Rules.
- (b) In all cases, the Panel shall ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case.

Consolidation of Multiple Complainants

The principles to assess a request to consolidate multiple complainants are set forth in the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ([“WIPO Overview 3.0”](#)), section 4.11.1.

Noting the circumstances of the case, in particular the fact that the Complainant Hyundai is the proprietor of the GENESIS mark and the Complainant Genesis, the wholly owned subsidiary of Hyundai, is the franchisor and licensor of the GENESIS mark in the United States. The disputed domain name reflects the GENESIS mark together with a geographic reference to a location in the United States. The Panel therefore considers that the Complainants have a specific common grievance against the Respondent and the Respondent has engaged in common conduct that has affected the Complainants in a similar fashion. Under the circumstances, the Panel finds it would be equitable and procedurally efficient to permit the consolidation.

The Respondent does not challenge the Complainants’ assertions nor offer any alternative explanation for these circumstances. Accordingly, the Panel accepts the Complainants’ request to consolidate the present proceedings pursuant to the Rules, paragraph 10(e). The Complainants are hereinafter referred to as “Complainant”.

6.2 Substantive Issues

Paragraph 4(a) of the UDRP requires the Complainant to make out all three of the following:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the Respondent has registered and is using the disputed domain name in bad faith.

Under paragraph 15(a) of the Rules, “[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable”.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant’s trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (“[WIPO Overview 3.0](#)”), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the Complainant’s GENESIS mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms (here, “of englewood”) may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant’s prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

In particular, the Panel notes that the disputed domain name reflects the Complainant’s GENESIS mark together with the terms “of englewood,” mirroring the composition of domain names registered by the Complainant’s authorized dealerships. Such a composition carries a risk of implied affiliation with the Complainant and cannot lead to a finding that the Respondent had rights or legitimate interests in the disputed domain name. See [WIPO Overview 3.0](#), section 2.5.1.

The disputed domain name does not resolve to an active website. Consistent with UDRP panels practice, the use of the disputed domain name to resolve to an inactive website does not constitute use in connection with a bona fide offering of goods or services. See [WIPO Overview 3.0](#), section 2.2. The Panel does not

find that the record supports a finding that the Respondent is commonly known by the disputed domain name or is making legitimate noncommercial use of it.

Based on the available record, the Panel finds the second element of the Policy has been established.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Respondent has registered a domain name containing the Complainant's GENESIS mark together with the name of a location in which the Complainant had established a dealership. The Complainant's rights in the GENESIS mark predate the registration of the disputed domain name by more than 15 years. The disputed domain name reflects the composition of domain names used by the Complainant's authorized dealers and therefore prevents the Complainant from registering such a domain name for its Englewood dealership. The Panel finds that the Respondent has thereby disrupted the business of a competitor. WIPO Overview, section 3.1.3. The Panel also finds that, by registering a domain name that reflects the Complainant's established GENESIS mark together with descriptive terms, the Respondent has intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's mark. [WIPO Overview 3.0](#), section 3.1.4.

The Panel notes that the evidence in the record indicated that the disputed domain name had previously resolved to a parking page. However, there is no evidence available to indicate that it was used in connection with PPC links. At time of filing the Complaint, the disputed domain name resolved to a Registrar parked page, which essentially equates to passive holding.

Panels have found that the non-use of a domain name (including a blank page) would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding. Although panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness or reputation of the Complainant's established GENESIS trademark, and the composition of the disputed domain name, and finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

The Panel finds that the Complainant has established the third element of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <genesisofenglewood.com> be transferred to the Complainant.

/Ingrīda Kariņa-Bērziņa/

Ingrīda Kariņa-Bērziņa

Sole Panelist

Date: February 26, 2024