Decision for dispute CAC-UDRP-100387

Case number	CAC-UDRP-100387
Time of filing	2012-02-15 10:48:19
Domain names	pirelli-scorpion-zero.com, pirelli-scorpion-zero-asimmetrico.com

Case administrator

Name	Tereza Bartošková (Case admin)

Complainant

Organization	Pirelli & C. S.p.A.

Complainant representative

Organization	FASANO-Avvocati

Respondent

Name	Kirill Samokhin

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings.

IDENTIFICATION OF RIGHTS

The Complainant - a well known Italian tyre manufacturer - is the registered owner of a large number of trademarks in Italy, in the EU, in the United States and in many other countries all over the world consisting of or including the expression <PIRELLI>. Among those trademarks are at least 18 Italian trademarks with international registration and 20 Community trademarks.

The Complainant has also registered at least 174 domain names incorporating the expression <PIRELLI> under nearly all known top-level domains.

FACTUAL BACKGROUND

The Complainant contends its company is the fifth largest global tyre maker by sales with 20 plants in 11 countries throughout the world (Argentina, Brazil, China, Egypt, Germany, United Kingdom, Italy, Romania, Turkey, United States and Venezuela). Furthermore the Complainant asserts doing business in 160 countries worldwide.

The trademarks <PIRELLI> owned by the Complainant shall not only be registered and used in commerce in a great majority of countries in the world, but shall also be well-known in the sense of article 6bis of the Paris Union Convention.

The Complainant asserts that among its numerous tyre ranges the Complainant also commercializes a product line called <Scorpion> especially developed for SUV's and crossover vehicles. A tyre type named <Scorpion Zero> shall have a high performance on roads with optimal safety in off road conditions. While the <Scorpion Zero> shall have a symmetric tread pattern for powerful SUVs the tyre type <Scorpion Zero Asimmetrico>, with an asymmetric tread pattern, shall ensure sporting performance and safety in light off-road conditions. The Complainant contends that the <Scorpion Zero Asimmetrico> has won awards in tests organised by the most authoritative magazines in the sector, combining features of roadholding and even tread wear, leading to improved mileage capability. The Complainant explains that the word "asimmetrico" means "asymmetric" in Italian.

The Complainant asserts that the disputed domain names are identical or confusing similar to the trademarks and that the Respondent has no rights or legitimate interests in respect of the domain names. Furthermore the Respondent has registered the domain names in bad faith because the Respondent must have known the Complainant as one of the leading tyre makers with numerous branches and must have known the international reputation of the Complainant as well as the tyre typ named <Scorpion Zero> at the time of the registration of the domain names <pirelli-scorpion-zero-asimmetrico> and <pirelli-scorpion-zero> under the top-level domain (dot)com.

The Complainants asserts that entering <pirelli-scorpion-zero.com> and <pirelli-scorpion-zero-asimmetrico.com> in the address bar of an internet browser on January 25, 2012 the answer was resolved to websites containing links offering the purchase of tyres as well as the description of the products of the Complainant (Scorpion Zero and Scorpion Zero Asimmetrico) and that upon receipt of a cease and desist letter the Respondent removed the content previously found on the websites.

PARTIES CONTENTIONS

The written notice of the Complaint and technical information how to access to the UDRP on-line platform together with the full login for the Respondent was sent to the Respondent but neither the written notice of the Complaint nor the advice of delivery thereof was returned to the Czech Arbitration Court. The Czech Arbitration Court is therefore unaware if the written notice was received by the Respondent or not.

But as far as the e-mail notice of the Complaint is concerned, the Czech Arbitration Court received a confirmation that the e-mail sent to the e-mail address <siberian50@gmail.com> submitted by the Respondent on registration of the disputed domain names was relayed. Only the e-mail notices sent to <postmaster@ pirelli-scorpion-zero-asimmetrico.com> and <postmaster@pirelli-scorpion-zero.com> were returned back undelivered as the e-mail addresses had permanent fatal errors.

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

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, 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, 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 Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be

inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

According to paragraph 4(a) of the Policy the Complainant must prove for the requested transfer of the disputed domain names <pirelli-scorpion-zero> and <pirelli-scorpion-zero-asimmetrico> under the top-level domain (dot)com that
(i) the domain names are 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 with respect to the domain names; and
(iii) the domain names has been registered and is being used in bad faith.

Without a doubt the Complain complies with all these requirements:

1.
The Domain names are at least confusingly similar to a trademark of the Complainant

The top-level domain “(dot)com” has to be disregarded when comparing trademarks and domain names, due to its importance, acknowledged by the market, as an essential component of domain names.

The Complainant is the proprietor of trademark rights in respect of the expression <PIRELLI>. Apart from the descriptive terms <scorpion>, <zero> and <asimmetrico> the disputed domain names are identical with the trademark rights while it is a worldwide standard that the mere addition of descriptive terms does not eliminates confusing similarity that is otherwise present.

For these reasons the domain names <pirelli-scorpion-zero> and <pirelli-scorpion-zero-asimmetrico> and the trademarks <pirelli> are at least confusingly similar and the Panel considers that the condition set out by paragraph 4(a)(i) of the Policy has been met by the Complainant.

2.
The Respondent has no rights or legitimate interests in the domain names

Paragraph 4(c) of the Policy sets out examples of what a respondent may demonstrate to show that it has rights or legitimate interests in respect of a domain name:

"Any of the following circumstances, in particular, but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented shall demonstrate your rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
(iI) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
(iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue."

As a general point a Respondent who does not respond to a complaint is unlike to prepare oneself for a bona fide offering of goods or services under the domain names or to prepare a legitimate noncommercial or fair use of the domain names without intent for commercial gain to misleadingly divert consumers or to tarnish the trademarks at issue.

Accordingly, on the evidence available to it, the Panel considers that the condition set out by paragraph 4(a)(ii) of the Policy have been met by the Complainant.

3.

The Respondent has registered and used the domain names in bad faith

Paragraph 4(b) of the Policy enumerates four circumstances that, if found by the Panel to be present, shall be evidence of the registration and use of domain names in bad faith. These circumstances are non-inclusive, why several other indicators can establish bad faith:

"(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location."

In this case it is obvious to the Panel that the Respondent has never used the domain names nor intended to use the domain names in a legitimate way. The Panel also cannot imagine how the Respondent could use the domain names with the descriptive terms <scorpion>, <zero> and <asimmetrico> and the trademark <pirelli> in a legitimate way. That there is no legitimate way to use the domain names was also obvious to the Respondent for which reason he removed the content previous found on the websites after the receipt of a cease and desist letter from the Complainant.

Considering all circumstances the Panel finds that the condition set out by paragraph 4(b) of the Policy have been met by the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **PIRELLI-SCORPION-ZERO.COM**: Transferred
2. **PIRELLI-SCORPION-ZERO-ASIMMETRICO.COM**: Transferred

PANELLISTS

Name	**Prof. Dr. Lambert Grosskopf, LL.M.Eur.**

DATE OF PANEL DECISION 2012-03-18

Publish the Decision