Decision for dispute CAC-UDRP-100392

Case number	CAC-UDRP-100392
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Domain names	pneuspirelli.net

Case administrator

Name	Tereza Bartošková (Case admin)

Complainant

Organization	Pirelli & C. S.p.A.

Complainant representative

Organization	FASANO-Avvocati

Respondent

Organization	Domains By Proxy, LLC

IDENTIFICATION OF RIGHTS

The Complainant is the holder of numerous registrations and/or applications for trademarks, comprising the keyword “pirelli”, including the International trademark registration 820148 for the figurative mark “pirelli’, registered on 16 September 2003 in classes 12, 14, 18 and 25 and the Community trademark registration 003733136 for the word mark “pirelli”, registered on 7 June 2005 in classes 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 34, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44 and 45. The Complainant is also the holder of and actively uses the domain name “pirelli.com”, created on January 11, 1995.

FACTUAL BACKGROUND

The Complainant, Pirelli & C. S.p.A. is a joint stock company incorporated under the laws of Italy. Complainant is the holder of numerous registrations and/or applications for trademarks, comprising the keyword “pirelli”. These trademarks include the International trademark registration 820148 for the figurative mark “pirelli’, registered on 16 September 2003 in classes 12, 14, 18 and 25 and the Community trademark registration 003733136 for the word mark “pirelli”, registered on 7 June 2005 in classes 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 34, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44 and 45.

Complainant uses these trademarks inter alia in relation to its tyre business, for which Complainant and its PIRELLi trademarks are well-known.

Respondent registered the disputed domain name “pneuspirelli.net” on September 15, 2011, using a proxy service. The disputed domain name is currently not being used and has been used to resolve to a website containing information on pneumatics (in Portuguese) and sponsored links to third party websites.

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PARTIES CONTENTIONS

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

Paragraph 15 of the Rules provides that the Panel is to decide the complaint on the basis of the statements and documents submitted in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

The onus is on the Complainant to make out its case and it is apparent, both from the terms of the Policy and the decisions of past UDRP panels, that the Complainant must show that all three elements set out in Paragraph 4 (a) of the Policy have been established before any order can be made to transfer a domain name. As the proceedings are civil, the standard of proof is the balance of probabilities.

Thus for the Complainant to succeed it must prove, within the meaning of Paragraph 4(a) of the Policy and on the balance of probabilities that:

1. The domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
2. The Respondent has no rights or legitimate interests in respect of the domain name; and
3. The domain name has been registered and is being used in bad faith.

The Panel has therefore dealt with each of these requirements in turn.

Confusing similarity of the Domain Name with existing rights
The Complainant must first establish that there is a trademark or service mark in which it has rights. Since Complainant is the holder of the widely and well-known Pirelli trademark, that is used in connection with its tyre business, it is clearly established that there is a trademark in which Complainant has rights.

The Panel considers the disputed domain name <pneuspirelli.net> to be composed of the non-distinctive generic term

“pneus”, which means tyres in French and in Portuguese and a name identical to the Pirelli trademark. The Panel is of the opinion that the mere addition of non-distinctive text to a complainant’s trademark constitutes confusing similarity, as set out in paragraph 4(a)(i) of the Policy (See Lime Wire LLC v. David Da Silva/Contactprivacy.com, WIPO Case N° D2007-1168, where the domain name <downloadlimewirenow.com> was held to be confusingly similar to the LIME WIRE trademark, especially with addition of the word “download” because users typically download complainant’s software; International Business Machines Corporation v. Scott banner, WIPO Case N° D2008-0965, where the domain name <ibmdownload.com> was held to be confusingly similar to the IBM trademark because many Internet users would assume that the Domain Name identifies a website from which they can download software supplied by the Complainant; Nintendo v. Beijin, WIPO Case N° D2001-1070, where the addition of the words ‘mail’, ‘post’, ‘fan’ and ‘top50’ to the word ‘POKÉMON’ in the disputed domain names was held to be of minimal impact on what the visitor of the website focuses on, namely the word ‘POKÉMON’; Nintendo v. Gray West International, WIPO Case N° D2000-1219, where it was held that the addition of the word ‘games’ in the domain name does nothing to reduce its confusing similarity with Nintendo’s POKÉMON marks); Dr. Ing. h.c. F. Porsche AG v. Kentech, Inc. a.k.a. Helios Lab a.k.a. Orion Web a.k.a. Titan Net a.k.a. Panda Ventures a.k.a. Spiral Matrix and Domain Purchase, NOLDC, Inc., WIPO Case No. D2005-0890, where the domain name <Porsche-repair-parts.com> was held to be confusingly similar to the trademark PORSCHE).

The addition of the non-distinctive term “pneus” does nothing to reduce the confusing similarity of the disputed Domain Name with Complainants widely and well-known trademark, especially given the fact that the term “pneus” is directly connected to Complainant’s business. Therefore, the Panel considers the disputed Domain Name to be confusingly similar with Complainants PIRELLI trademark.

Accordingly, the Complainant has made out the first of the three elements that it must establish.

No legitimate rights

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that respondent has no rights or legitimate interests in respect of the domain names.

It is established case law that it is sufficient for the Complainant to make a prima facie showing that Respondent has no right or legitimate interest in the Domain Name in order to shift the burden of proof to the Respondent. (See: Champion Innovations, Ltd. V. Udo Dussling (45FHH), WIPO case No. D2005-1094 (championinnovation.com); Croatia Airlines d.d. v. Modern Empire Internet Ltd., WIPO case No. D2003-0455 (croatiaairlines.com); Belupo d.d. v. WACHEM d.o.o., WIPO case No. 2004-0110 (belupo.com).)

The Panel notes that Respondent has not been commonly known by the domain name and that the Respondent has not acquired trademark or service mark rights. Respondent’s use and registration of the disputed domain name was not authorized by Complainant. There are no indications that a connection between Complainant and Respondent existed.

Moreover, the Panel is of the opinion that Respondent is not making a legitimate non-commercial or fair use of the Domain Name. In fact, Repondent has been using the domain name to sponsored links. This indicates that Respondent has been using Complainant’s well-known trademark for commercial gain. Such use is not a bona fide use. See e.g., NAF/FA190644 (nicklausgolf.com - “Respondent’s use of a domain name confusingly similar to Complainant’s mark(s) to divert Internet users to websites unrelated to Complainant’s business does not represent a bona fide offering of goods or services under Policy 4(c)(i) or a legitimate non commercial or fair use under Policy 4(c)(iii)”); NAF/FA93554 (bigdog.com – finding no legitimate use when respondent was diverting consumers to its own web site by using complainant’s trademark(s)); WIPO/D2000-1204 (msnbc.org – finding no rights or legitimate interest in the famous MSNBC mark where respondent attempted to profit using complainant’s mark by redirecting Internet traffic to its own website); NAF/FA96356 (broadcom2000.com - finding no rights or legitimate interests because the respondent is not commonly known by the disputed domain name or using the domain name in connection with a legitimate or fair use); NAF/FA96209 (galluppll.com - finding that the respondent does not have rights in a domain name when the respondent is not known by the mark); NAF/FA740335 (cigaraficionada.com - finding that the respondent was not commonly known by the “cigaraficionada.com”

domain name); NAF/FA881234 (stlawu.com - concluding that the respondent has no rights or legitimate interests in a disputed domain name where there is no evidence in the record indicating that the respondent is commonly known by the disputed domain name); WIPO/D2000-0020 (saint-gobain.net – finding no rights or legitimate interest where the respondent was not commonly known by the mark and never applied for a license or permission from the complainant to use the trademarked name); WIPO/D2000-0403 (charlesjourdan.com – finding no rights or legitimate interests where (1) the respondent is not a licensee of the complainant; (2) the complainant's prior rights in the domain name precede the respondent's registration; (3) the respondent is not commonly known by the domain name in question).

In lack of any Response from the Respondent, or any other information indicating the contrary, the Panel therefore concludes that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

Bad faith

The disputed domain name has been registered and is being used in bad faith considering, from one side, that the "true" registrant hid behind a privacy shield. Domains By Proxy is a privacy or proxy registration service operated by Domains By Proxy, LLC, an affiliate of the registrar GoDaddy.com, LLC. According to the Panel, the manner in which such a service is used may constitute a factor indicating bad faith. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, paragraph 3.9.

Furthermore, a review of the web site to which "pneuspirelli.net" resolves makes it clear that the domain name has been registered and was being used by Respondent with a view of commercial gain.

The registration and the use in bad faith of the domain name "pneuspirelli.net" is clearly evident from the fact that the domain name is confusingly similar to the PIRELLI trademark of the Complainant. This evidences a clear intent to trade upon the reputation and good will associated with PIRELLI marks. The domain name "pneuspirelli.net", confusingly similar to PIRELLI Marks, is deliberately used to attract, for commercial gain, Internet users to the web site(s) it resolves, by creating a likelihood of confusion with PIRELLI's marks and products to the source, sponsorship, affiliation or endorsement of such domain name or of a product or service on such web site.

Taking into account the vast and widespread advertising campaigns carried out by PIRELLI for the promotion of products and services covered by its brands, it is unlikely that the registration of the domain name in question may be attributed to mere chance and not, as is, with a full awareness and intent to exploit the reputation and good will of the Complainant and PIRELLI Marks. See decision CAC Case N. 05367 (Giorgio Armani s.p.a. v. Antares S.p.A., Germano Armani).

It is clear that the Respondents had relevant notice about the existence of PIRELLI Marks, since: a) they registered a domain name corresponding with the dominant part of PIRELLI Marks, adding a word ("pneus") meaning tyres in different languages (French, Portuguese), which coincide with the core business of the Complainant; and b) the web site to which the domain name resolves is related to tyres containing also a photo of a tyre on which the wording "pirelli" as well as the Complainant well known logo can be clearly recognised.

In the light of the foregoing, it is considered that the registration of the domain name "pneuspirelli.net" has been carried out with the purpose of exploiting PIRELLI's reputation and good will and drawing on such domain name users for commercial gain. See decisions of the Czech Arbitration Court: Case N. 04316 (Prada SA v. Maurizio Lussetti); Case N. 05650 (Salumificio Fratelli Beretta S.p.A. v. Nico Maria Cavallo), Case N. 05572 (KG Industries LLC v. KG Industries, Gary Powell KG Industries); Case N. 05572 (Zott GmbH & Co. KG v. Victor Somov).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **PNEUSPIRELLI.NET**: Transferred

PANELLISTS

Name	**Flip Petillion**

DATE OF PANEL DECISION 2012-03-30

Publish the Decision