

Decision for dispute CAC-UDRP-100404

Case number	CAC-UDRP-100404
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Time of filing	2012-03-01 13:45:56
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Domain names	paris-pirelli.com
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Case administrator

Name	Tereza Bartošková (Case admin)
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Complainant

Organization	Pirelli & C. S.p.A.
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Complainant representative

Organization	Avvocato Pierfrancesco Carmine Fasano (FASANO-Avvocati)
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Respondent

Organization	Domain Manager PornKingpins
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OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other pending or decided legal proceedings which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

Complainant owns a large number of registered trademarks worldwide comprising the word 'PIRELLI', inter alia the European Community Trademark no. 3218435 "PIRELLI" (word) with application date 19 June 2003.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainant Pirelli & C. S.p.A. (hereinafter referred to as "Pirelli" or the "Company") is a well-known multinational company based in Milan, Italy. The Company, with a revenue of 4.848 billion euros in 2010, is the fifth largest global tyre manufacturer and leader in the high-end segments with high technological content. Today Pirelli has 20 plants in 11 countries throughout the world (Argentina, Brazil, China, Egypt, Germany, United Kingdom, Italy, Romania, Turkey, United States and Venezuela), and a commercial network that covers over 160 countries.

Founded in 1872 and listed on Milan Stock Exchange since 1922, Pirelli is distinguished for its long industrial tradition, which has always been combined with capacity for innovation, product quality and brand strength.

Principal subsidiaries worldwide comprise: Pirelli GmbH (Austria); Pirelli Tyres Belux S.A. (Belgium); Pneus Pirelli S.A.S. (France); Pirelli Deutschland GmbH (Germany); Elastika Pirelli S.A. (Greece); Pirelli Hungary Kft (Hungary); Pirelli Tyres Nederland B.V. (Netherlands); Pirelli Tyre (Europe) S.A. Czech (Czech Republic); Pirelli Polska Sp. Zo.o. (Poland); Pirelli Eco Technology RO SA (Romania); Pirelli Neumaticos S.A. (Spain); Pirelli Tyre Nordic AB (Sweden); Pirelli Tyre (Europe) S.A. (Switzerland); Pirelli Tyre Russia (Russia); Pirelli Tyre (Turkey); Pirelli Tyres Ltd. (UK); Pirelli Tire Inc. (Canada); Pirelli North America LLC (U.S.A.); Pirelli Neumaticos S.A.I.C. (Argentina); Pirelli Pneus S.A. (Brasil); Pirelli Neumaticos Chile Ltda (Chile); Pirelli de Colombia S.A. (Colombia), Pirelli Neumaticos de Mexico S.A. de C.V. (Mexico); Pirelli Venezuela C.A. (Venezuela); Pirelli Tyre (Pty) Ltd. (South Africa); Pirelli Tyres Australia Pty Ltd. (Australia); Pirelli Tyres (NZ) Ltd. (New Zealand); Pirelli K.K. (Japan); Pirelli Tyre Co. Ltd. (China).

Thanks to the success and leading position achieved by Pirelli in relation to all segments in which it operates, Pirelli's marks are well-known worldwide. Its global brand value was estimated by Interbrand in 2010 to be approximately 1.8 billion euros.

The domain name "paris-pirelli.com" was registered on November 28, 2010, i.e. well after Complainant's trademarks.

In its Complaint Complainant refers to the following decisions to support that the Domain Name is confusingly similar to Complainant's 'PIRELLI' trademark(s): NAF/FA128071 (visual-credit-counseling.com – "where the only difference between a mark and a domain name is the presence of a hyphen between the prominent elements of the mark, such is not sufficient to negate the confusingly similarity"); WIPO/D2000-0038 (euro-tunnel.com – finding that euro-tunnel.com is confusingly similar to EUROTUNNEL trademark despite lack of hyphen in the trademark); WIPO/D2000-1409 (Sony Kabashiki Kaisha v. Inja, Kil - finding that "[n]either the addition of an ordinary descriptive word ... nor the suffix ".com" detract from the overall impression of the dominant part of the name in each case, namely the trademark SONY"); NAF/FA141825 (chemyadoo.com and others - "it is also well-established under the Policy that a domain name composed of a trademark coupled with a generic term still is confusingly similar to the trademark"); WIPO/D2002-0367 (experianautomotive.com – finding that addition of the generic term, "automotive", does not distinguish Respondent's domain name from Complainant's mark because the domain contains Complainant's EXPERIAN mark in its entirety); NAF/FA98071 (antibroadcom.com); NAF/FA93670 (marriott-hotel.com); NAF/FA96700 (dewalt-woodworking-tools.com and others - "Respondent's use of nine domain names using the DEWALT mark with a descriptive term are confusingly similar."); NAF/FA124739 (uhaulem4cheap.com and others).

The Complainant further contends that the Respondent has no rights and interests in the Domain Name. Pirelli has no relationship with the Respondent whatsoever. Pirelli has never authorized the Respondent to use the Domain Name "paris-pirelli.com" or any other domain name. Additionally, there is no indication that the Respondent has any legitimate interest in PIRELLI Marks according the searches done on the web sites of the Italian Patent and Trademark Office (UIBM), the EU's Office of Harmonization for the Internal Market (OHIM), WIPO, the United States Patent and Trademark Office (USPTO). There is no evidence that the Respondent's use of "paris-pirelli.com" is either a bona fide offering of goods or services or a legitimate noncommercial or fair use, without intent for commercial gain. Finally, there is no evidence that the Respondent has been commonly known by the domain name "paris-pirelli.com".

The Complainant further contends that the Domain Name has been registered and is being used with a view of commercial gain. Complainant argues that Respondent's bad faith is clearly evident from the fact that it has registered and has been using a domain name confusingly similar to the trademarks, company name, domain names of the Complainant. This, according to Complainant, evidences a clear intent to trade upon the reputation and good will associated with PIRELLI Marks. Respondent has been deliberately using the Domain Name confusingly similar to PIRELLI Marks to attract, for commercial gain, Internet users to its web site, by creating a likelihood of confusion with PIRELLI's marks and products to the source, sponsorship, affiliation or endorsement of its web site 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 PIRELLI Marks, 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).

Therefore, having ascertained 1) the confusing similarity of the Domain Name "paris-pirelli.com" with the rights deriving from the trademarks, company name and domain names in which the Complainant has exclusive rights; 2) the reputation and good will

associated with the Complainant and PIRELLI Marks; 3) the lack of rights and legitimate interests of the Respondent in the disputed Domain Name; 4) the bad faith of the Respondent in the registration and use of the disputed Domain Name, the authorized representative of the Complainant has requested that the domain name “paris-pirelli.com” be cancelled.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown that 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). Apart from the descriptive prefix 'paris-', the Domain Name is identical to Complainant's protected brand name 'PIRELLI'.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown that the Respondent has no rights or legitimate interests in respect of the Domain Name (within the meaning of paragraph 4(a)(ii) of the Policy). The Domain Name is not being used to host any legitimate site, but merely to display pornographic materials.

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown that the Domain Name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy). By using the Domain Name, the Respondent intentionally attempted to attract, for commercial gain, Internet users to a sponsored link web site, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of this web site.

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

The Panel finds that the Domain Name is confusingly similar to Complainant's trademark cited above as the sole difference between the Domain Name and this trademark is the descriptive prefix 'paris-', which is insignificant to the overall impression.

The Panel finds that Complainant successfully submitted prima facie evidence that Respondent has made no use of, or demonstrable preparations to use, neither of the disputed domain name in connection with a bona fide offering of goods or services, nor is making a legitimate non-commercial or fair use of the disputed domain name, nor is commonly known under the disputed domain name. This prima facie evidence was not challenged by Respondent.

In the absence of a Response, the Panel infers that Respondent had Complainant's trademark in mind when registering the Domain Name, which was therefore registered and is being used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **PARIS-PIRELLI.COM:**
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PANELLISTS

Name	Dr. Thomas Schafft
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DATE OF PANEL DECISION	2012-04-15
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