Decision for dispute CAC-UDRP-100425

Case number	CAC-UDRP-100425
Time of filing	2012-04-02 12:56:55
Domain names	PIRELLIREIMMOBILIARE.COM

Case administrator

Name	Tereza Bartošková (Case admin)

Complainant

Organization	Pirelli & C. S.p.A.

Complainant representative

Organization	FASANO-Avvocati

Respondent

Name	Giuseppe Corapi

OTHER LEGAL PROCEEDINGS

No other legal proceedings concerning the disputed domain name are currently pending.

IDENTIFICATION OF RIGHTS

Complainant has proved to own the following trademarks:

1. Community-registered trademark n°006083158 - word: PIRELLI RE
Application date: July 9, 2007
Registration date: June 6, 2008

2. Community-registered trademark n°003218476 - PIRELLI RE

Application date: June 19, 2003
Registration date: August 4, 2004

3. Italy-registered trademark n°0001276670-PIRELLI RE

Application date: July 5, 2007
Registration date: April 23, 2010

4. International Trademark-registered International trademark n°946106 –PIRELLI RE

Registration date: July 21, 2007

5. Community trademark-registered Community trademark 006754154- PIRELLI RE

Application date: March 14, 2008
Registration date: January 14, 2009

6. Italia-registered trademark 0001281571- PIRELLI RE

Application date: December 5, 2007
Registration date: May 10, 2010

Besides, the Complainant also owns the following domain names containing either the denomination PIRELLI or PIRELLI RE:

<pirelli.com>;<pirellire.com>;<pirellire.net>;<pirellire.org>;

The bulk of these domain names are connected to the official web site of the Complainant. The domain names which contain the sign PIRELLI RE redirects towards the new official website of the rebranded Company PRELIOS namely www.prelios.com.

FACTUAL BACKGROUND

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

The Complainant – Pirelli at a glance

Pirelli & C. S.p.A. (hereinafter referred to as “Pirelli” or the “Company”) is a well-known company founded in 1872 and based in Milan, Italy (ANNEX 1 – “Brochure Pirelli”). For more than a century it has developed as a truly international enterprise, deeply rooted in the different markets. In its strategy to the top of the range, the Pirelli has focused its activities in a selected number of high margin businesses of high margin profit, with segmentation towards high range products. Pirelli has always been combined with capacity for innovation, product quality and brand strength. Pirelli is synonymous with quality and the ultimate in performance. And it is in the high tech and superior performance segment of the high-end market that Pirelli has, over the years, built its leadership.
The Company’s core business is identified as Pirelli Tyre, the fifth largest global tyre manufacturar with 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.
Over the years, further to its core business, Pirelli has created new businesses in other segments, thanks to its continual focus on research and innovation in products and services: Pirelli Ambiente S.p.A., engaged in the renewable energy sector; Pirelli & C. Eco Technology S.p.A., dedicated to developing technologies to control pollutant emissions; Pirelli Labs, a centre of technological excellence and engine of innovation and Pirelli Real Estate S.p.A. (shortly Pirelli RE) leader in the real estate sector in Italy and in the rest of Europe, with operations in Italy, Germany and Poland.
Pirelli RE, listed on the Milan Stock Exchange since 2002, is a fund and asset manager that enhances and manages real estate portfolios on behalf of third party investors through a distinctive pattern based on the integration of specialized services (agency and property management) functional to its management activities (fund and asset management).
The total assets under management by Pirelli RE is approximately 13,6 billion Euros, with a property portfolio worth 12,3 billion Euros and the residual amount (approximately 1,3 billion Euros) in non-performing loans (management and out of court recovery of bad debts for banks and investors).

The Complainant’s protected rights

Trademarks:

Pirelli is owner of numerous registrations and/or applications for trademarks, comprising the keyword “PIRELLI”, as per the trademark list hereto enclosed (ANNEX 2 - “Trademark list”). In this dispute, among such trademarks, the Complainant relies on the following marks:

Trademark Country Owner Application no. Application date Registration no. Registration date Class
PIRELLI RE (word) EU Pirelli & C. S.p.A. 006083158 09/07/2007 006083158 06/06/2008 35, 36
PIRELLI RE (word) Italy Pirelli & C. S.p.A. MI2007C007195 05/07/2007 1276670 23/04/2010 35, 36
PIRELLI RE (device) EU Pirelli & C. S.p.A. 003218476 19/06/2003 003218476 04/08/2004 35, 36
PIRELLI RE (device) WIPO (designated China, Croatia, Russia, Turkey) Pirelli & C. S.p.A. 11639 D/2007 27/07/2007 946106 27/07/2007 35, 36
PIRELLI RE (device) EU Pirelli & C. S.p.A. 006754154 14/03/2008 006754154 14/01/2009 35, 36
PIRELLI RE (device) Italy Pirelli & C. S.p.A. MI2007C012565 05/12/2007 1281571 10/05/2010 35, 36

The above mentioned Community Trademarks’ certificate of registrations as well as the abstracts of the databases of the Italian Patent and Trademark Office (UIBM) and WIPO regarding the above mentioned Italian and international trademarks are hereto enclosed as ANNEXES 3.1-3.6 - “PIRELLI RE trademarks”.
Trademarks included in the ANNEXES 3.1-3.6, registered in Italy, in the EU, in China, Croatia, Russia and Turkey, have been used by Pirelli in connection with the following products and services:
a) apartment house management, renting of real; estate, housing agency, real estate management, real estate appraisal, real estate appraisal services, real estate affairs; insurance; financial affairs; monetary affairs, leasing of real estate and offices (Class 36 of International Classification System of Goods and Service);
b) franchising services; business advisory services relating to franchising; commercial management assistance in relation to franchises; advertising; business management; business administration; office functions (Class 35 of International Classification System of Goods and Service).
Pirelli has used such trademarks for many, many years and has invested substantial effort over a period of time, including the expenditure of substantial amounts, to develop good will in its trade name and trademarks to cause consumers throughout the world to recognize its marks as distinctly designating products and services that originate with Pirelli.
Hence, Pirelli enjoys extensive rights in such trademarks which are internationally well-known.

Domain names:

Pirelli is owner of numerous domain names listed on ANNEX 4 – “Domain name list”. In particular, the Complainant relies on its primary domain name, “pirelli.com”, created on January 11, 1995, as well as on the following domain names (hereinafter referred to as “PIRELLI RE domain names”):
a) pirellire.com, created on March 12, 2003;
b) pirellire.net, created on March 12, 2003;
c) pirellire.org, created on March 12, 2003.

Company name:

Pirelli is a joint stock company incorporated under the laws of Italy, as per abstract certificate issued by the Chamber of Commerce of Milano - Registrar of Companies (ANNEX 5 – “Company certificate” and ANNEX 6 – “English translation of company certificate”) and company by laws (ANNEX 7 – “Company by laws”).
During its century-old history Pirelli has changed its company name, leaving always unchanged the dominant part of it, namely “PIRELLI” (ANNEX 8 – “Certificate of changes in company name”).

The Complainant’s above-mentioned trademarks, domain names and company name together are hereinafter referred to as “PIRELLI Marks”.

* * * *

The domain name “pirellireimmobiliare.com” was registered on October 5, 2009, i.e. well after Complainant’s trademarks. As certified by the attached printout of the relevant WHOIS records at the time of filing of this Complaint, Giuseppe Corapi is shown as registrant (ANNEX 9 – “WHOIS records”).
The disputed domain name should be transferred to Pirelli, because it constitutes usurpation and violation of the rights of the Complainant with regard to its trademarks registered in Italy, in the EU, in China and in numerous other countries worldwide, its domain names and its company name for the following reasons.

ICANN Rules 3(b)(ix)(1); ICANN Policy 4(a)(i)
Confusing similarity of the disputed domain name with the trademarks, company name and domain names of the Complainant
The disputed domain name is confusingly similar to PIRELLI Marks, because it wholly incorporates the dominant part of PIRELLI Marks, namely the wording “PIRELLI”.
In respect to PIRELLI RE trademarks (see ANNEXES 3.1-3.6) and PIRELLI RE domain names (see ANNEX 4), the Respondent added the word “immobiliare”, which means real estate in Italian (ANNEX 10 – “English translation of the word immobiliare”) and coincides with one of the businesses of Pirelli, involved in the real estate sector. Adding such descriptive word is insufficient to negate the confusingly similarity between the disputed domain name and PIRELLI Marks, in particular PIRELLI RE trademarks and PIRELLI RE domain names, and even increases the likelihood of confusion.
It is well-founded that adding a generic/descriptive word related to Complainant’s business does not affect the attractive power of the dominant part of PIRELLI Marks, i.e., “PIRELLI”, and the domain name “pirellireimmobiliare.com” is consequently confusingly similar with the Complainant’s marks.
The domain name “pirellireimmobiliare.com” can be confused with:
a) the trademark registrations and/or applications of Pirelli valid in Italy and worldwide (see ANNEXES 2-3.1-3.6);
b) the domain names registered by Pirelli (see ANNEX 4), in particular, with:
pirelli.com;
pirellire.com;
pirellire.net;
pirellire.org.
c) the company name of Pirelli (see ANNEXES 5-6).
The similarity of the disputed domain name to PIRELLI Marks, is likely to lead to confusion and/or association for the Internet users.
See decisions: 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 (chemyahoo.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/FA129123 (thriftyairportparking.com - finding confusing similarity with the THRIFTY marks, particularly since those additions have connotations that relate to Complainant's business services); NAF/FA113283 (champs-sports.com and others - "The addition of generic words is especially confusing where the generic words bear an obvious relationship to Complainant's business"); NAF/FA109576 (hustlervideo.com - use of the generic term 'video' does not defeat a confusing similarity claim, because the generic term directly relates to Complainant's business, which increases the likelihood of confusion); 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).

ICANN Rules 3(b)(ix)(2); ICANN Policy 4(a)(ii)
Lack of rights or legitimate interests of Respondent in respect of the domain name “pirellireimmobiliare.com”
The Complainant shall make a prima facie showing that the Respondent has no rights and interests in the domain name; however, the burden of proof with respect to this element is light for the Complainant. See WIPO/DTV2002-0005 (deagostini.tv); WIPO/D2000-0648 (pivotalsoftware.com); WIPO/D2002-0503 (arroyocraftsman.com); WIPO/D2003-0455 (croatiaairlines.com).

Pirelli has no relationship with the Respondent whatsoever. Pirelli has never authorized the Respondent to use the domain name “pirellireimmobiliare.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) and WIPO.
Further, entering “pirellireimmobiliare.com” in the address bar of an internet browser has resolved to a web site in Italian related real estate services (ANNEX 11 – “Printout of pirellireimmobiliare.com of February 16, 2012”). Hence, there is no evidence that the Respondent’s use of “pirellireimmobiliare.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 “pirellireimmobiliare.com”.
See decisions: 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 bonafide offering of goods or services under Policy 4(c)(i) or a legitimate noncommercial 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).

ICANN Rules 3(b)(ix)(3); ICANN Policy 4(a)(iii)
Registration and use of “pirellireimmobiliare.com” in bad faith
The disputed domain name has been registered and is being used in bad faith considering that the disputed domain name wholly incorporates the dominant part of the well-known PIRELLI Marks, namely the wording “PIRELLI”. In respect to PIRELLI RE trademarks (see ANNEXES 3.1-3.6) and PIRELLI RE domain names (see ANNEX 4), the Respondent added a generic/descriptive word related to Complainant’s business.
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 Pirelli. This 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).
Without any doubt the Respondent has had relevant notice about the existence of PIRELLI Marks and the domain name has been registered and is being used with a view of commercial gain, since: a) it registered and has been using a domain name corresponding with the dominant part of PIRELLI Marks, adding a generic word (“immobiliare”, which means real estate in Italian, coinciding with a business sector of the Complainant); b) the Respondent is an Italian real estate agent (see ANNEX 11); and c) the web site to which the domain name resolved is related to real estate business (see ANNEX 11).
Furthermore, the correspondence exchanged between the Complainant and the Respondent makes it clear that this latter has registered the disputed domain name for the purpose of selling it to the Complainant or to third parties for valuable consideration in excess of his out-of-pocket costs related to the disputed domain name (ANNEX 12 – “Correspondence exchanged between the Complainant and Respondent”; ANNEX 13 – “English translation of the correspondence”). Further to

such correspondence, the Respondent cancelled the content of the web site to which the domain name resolved (ANNEX 14 – “Printout of pirellireimmobiliare.com of March 29, 2012”).
In the light of the foregoing, it is considered that the registration of the domain name “pirellireimmobiliare.com” has been carried out with the sole purpose of exploiting Pirelli’s reputation and good will and/or drawing on such domain name Internet 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).
See also NAF/FA95464 (statefarmnews.com – finding that a respondent registered the domain name “statefarmnew.com” in bad faith because that respondent intended to use a complainant’s marks to attract the public to the web site without the permission from that complainant); NAF/FA123933 (celebrex-drugstore.com – finding that respondent registered and used the domain name in bad faith pursuant to ICANN Policy 4(b)(iv) because respondent was using the confusingly similar domain to attract Internet users to its commercial website; NAF/FA126835 (barbiesgalleries.com – citing WIPO/D2000-1221 Pavillion Agency, Inc v. Greenhouse Agency Ltd finding that the “domain names are obviously connected with the complainant that use or registration by anyone other that complainant suggests “opportunistic bad faith””); NAF/FA96356 (broadcom2000.com); NAF/FA96209 (galluppll.com); NAF/FA740335 (cigaraficionada.com); NAF/FA881234 (stlawu.com).

* * * *

Therefore, having ascertained 1) the confusing similarity of the domain name “pirellireimmobiliare.com” with the rights deriving from the trademarks, company name and domain names in which Pirelli has exclusive rights; 2) the reputation and good will associated with Pirelli and its trademarks; 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 undersigned authorized representative of the Complainant requests that the domain name “pirellireimmobiliare.com” be transferred to Pirelli & C. S.p.A..

LIST OF ANNEXES

ANNEX 1 – “Brochure of Pirelli”;
ANNEX 2 – “Trademark list”;
ANNEXES 3.1-3.6 – “PIRELLI RE trademarks”;
ANNEX 4 – “Domain name list”;
ANNEX 5 – “Company certificate”;
ANNEX 6 – “English translation of company certificate”;
ANNEX 7 – “Company by laws”;
ANNEX 8 – “Certificate of changes in company name”;
ANNEX 9 – “WHOIS records”;
ANNEX 10 – “English translation of the word immobiliare”;
ANNEX 11 – “Printout of pirellireimmobiliare.com of February 16, 2012”;
ANNEX 12 – “Correspondence exchanged between the Complainant and Respondent”;
ANNEX 13 – “English translation of the correspondence”;
ANNEX 14 – “Printout of pirellireimmobiliare.com of March 29, 2012”.

PARTIES CONTENTIONS

FACTS ASSERTED BY COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

Complainant is a company which has its headquarters located in Italy in Milan. The Pirelly & C. S.p.A Company is well-known worldwide for its know-how in the tires industry which is regarded as being its hallmark. As time goes by, the Company decided to spread and widen its know-how and create other businesses among which Pirelli Real Estate S.p.A, which focuses on real estate, Pirelli Ambiante S.p.A and Pirelli & C. Eco technology S.p.A which focus on sustainable development to name a few. Pirelli Real Estate S.p.A also known under the name Pirelli RE, has developed a business model of its own which encountered great success. In August 2006, Pirelli RE employed over 1500 people according to Complainant’s record.

Pirelli RE happens to be listed on the Borsa Italiana, which is the Italian Stock Exchange.

In 2010, the Pirelli Real Estate S.p.A was rebranded into Prelios S.p.A. This rebranding leads to the separation of the former Pirelli Real Estate S.p.A also known under the name Pirelli RE as Pirelli wanted to focus on its core business. As the Complainant mentioned it in its contention for the decision CAC n° 100413 :"in 2010, Pirelli, as a result of the desire to focus exclusively on core industrial activities in the tyre sector, concluded the spin-off of the real estate business and renamed Pirelli RE into Prelios" (CAC decision n°100413, Organization Pirelli & C. S.p.A v. organization Anpoer).

According to Complainant's records, on August 3, 2006, Pirelli & C S.p.A owned at 50,3% Pirelli Real Estate. As of today, Prelios S.p.A is financed by Pirelli & C. S.p.A until July 2017. Prelios, formerly Pirelli RE, is separated from Pirelli & C. S.p.A since October 25, 2010. Prelios is still an actor of paramount importance on the real estate market in Italy as well as at the International level.

Respondent registered the domain name <pirellireimmobiliare.com> on October 5, 2009 thanks to the Registrar Tucows. The records of the Complainant show up that the domain name <pirellireimmobialiare.com> redirected towards the website www.reclick.it where stands a picture of Giuseppe Corapi and an e-mail address. The website www.reclick.it features that the Reclick Agency was created in 1994 and is a real estate company which proposes real estate in Milan and its hinterlands. The website is available only in Italian. Respondent appears to be an individual named Giuseppe Corapi who happens to be an Italian real estate agent.

The Complainant submitted the following documents to prove the abovementioned facts:

-Brochure dated of 2006 describing the Pirelli Group including Pirelli Real Estate S.p.A
-Tucowsdomains Whois search conducted by Complainant on March 29, 2012
-Copies of Complainant's trademarks registrations
-Screenshot of the website www.pirellireimmobiliare.com dated of Feburary 16, 2012
-Correspondence exchanged between the Complainant and the Respondent in February 2012

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

1. Identity (paragraph 4(a)(i) of the Policy)

In the light of the records provided by Complainant, it appears that it owns miscellaneous trademarks worldwide. Arguably, the Company Pirelli & C. S.p.A owns the international trademarks Community and Italian trademarks comprising the term "PIRELLI RE" such as follows:

-Community trademark n°006083158, PIRELLI RE registered on the 6th of June 2008 protecting classes 35 and 36;
-Community trademark n°006754154, PIRELLI RE registered on the 14th of January 2009 protecting classes 35 and 36;
-Community trademark n°003218476, PIRELLI RE registered on the 4th of August 2004 protecting classes 35 and 36;
-International trademark n°946106, PIRELLI RE registered on the 27th of July 2007 protecting classes 35 and 36.

The Administrative Panel found that the domain name <pirellireimmobialiare.com> is confusingly similar to the trademark owned by Complainant.

Firstly, trademark of Complainant is entirely incorporated in the disputed domain name <pirellireimmobiliare.com>. Secondly, while using the term “immobiliare”, which is a clear reference to Complainant’s activities in real estate, Respondent induces the Internet users into believing that they are on the official webpage of Complainant.

Secondly, the addition of the extension “.com” does not prevent the finding of similarity between Complainant’s trademark and the aforementioned domain name (WIPO Case n° D2007-1257, Accor SA v. jacoop.org).

2. Absence of Rights or Legitimate Interests (paragraph 4(a)(ii) of the Policy).

Complainant contended that Respondent has never been granted a license in order to register the domain name <pirellireimmobiliare.com>. In addition, Respondent never sought the consent of Complainant in order to register the aforementioned domain name. Consequently, Respondent lacks any right or legitimate interest in using the litigated domain name.

In the light of the screenshot of the website dated February 16, 2012 to which the domain name redirected, the Panel gathered miscellaneous information. Firstly, Respondent is an Italian real estate agent. He seems to be one of the founding members of the Reclick agency, an Italian real estate agency.

Given the silence of Respondent and its offer to sell the domain name for an amount exceeding its out-of-pocket costs, the Panel can reasonably infer that Respondent is not making a bona fide offering of goods or services. Moreover, the website www.pirellireimmobiliare.com is tackling with the core activity of Pirelli RE, namely real estate.

Registrant could have registered legitimately a domain name encompassing the letters “re” which refers to its field of activity with the term “immobiliare”. However, he is not entitled to register a domain name which incorporates Complainant’s trademark PIRELLI RE in its entirety.

Given the fact that the word “Pirelli” does not have any dictionary meaning, it is not a sheer coincidence if Respondent registered said domain name. In addition PIRELLI is a well-known trademark.

The domain name in dispute is so similar to the well-known PIRELLI RE trademark that Respondent cannot reasonably pretend he was intending to develop a legitimate activity through the disputed domain name. Arguably, Respondent registered said domain name knowing that the trademark benefited from a certain reputation. The reputation of the trademark PIRELLI RE was acknowledged by a previous Panel (CAC Case N.100413, Organization Pirelli & C. S.p.A v. organization Anpoer:”Complainant owns the mentioned PIRELLI RE Trademark Registrations, and is broadly known by this name”). The Panel can also underline that the time of the registration, namely in October 2009, is well posterior to the registration of PIRELLI RE trademarks.

The website to which the domain name redirects is currently inactive and was cut after Complainant reached Respondent by e-mail. This fact added to the previous elements conveys the idea that Respondent does not have any legitimate interest in the disputed domain name.

3. Bad Faith (paragraph 4(a)(iii) of the Policy).

In the light of the records, it seems that Respondent has registered the domain name <pirellireimmobiliare.com> for the sole purpose of selling the domain name to the Complainant or to third-parties for an amount exceeding his out-of-pocket costs.

Furthermore, Respondent has merely added the word “immobiliare” which means real estate in Italian to the trademark registered by Complainant. This sole change is prone to create a likelihood of confusion as real estate is the core activity of Pirelli RE.

Respondent appears to be an Italian real estate agent. If Respondent had rights or legitimate interest to register the domain name <pirellireimmobiliari.com> he would have vigorously defended his right in responding to Complainant.

Moreover, Respondent is likely to bait Internet users on its website and to free ride on the reputation and promotional investment made by Pirelli. Decisions issued by previous panels have held that the use of domain names to divert Internet users evidences bad faith. Indeed, Respondent is taking undue advantage of Complainant’s trademark to generate profits (WIPO Case No. D2008-0025 SNCF v. Comdot Internet Services Private Limited./PrivacyProtect.org and WIPO Case No. D2010-1805, Dun & Bradstreet Corporation v. Private Whois Service).

The website www.pirellireimmobiliare.com does no longer resolve to any active website. However, passive holding of a domain name is constitutive of bad faith (WIPO Case No.D2000-0003, Telstra Corporation Limited v. Nuclear Marshmallows).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **PIRELLIREIMMOBILIARE.COM**: Transferred

PANELLISTS

Name	**Nathalie Dreyfus**

DATE OF PANEL DECISION 2012-04-26

Publish the Decision