

Decision for dispute CAC-UDRP-100422

Case number **CAC-UDRP-100422**

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Domain names **pirellireifen.info**

Case administrator

Name **Tereza Bartošková (Case admin)**

Complainant

Organization **Pirelli & C. S.p.A.**

Complainant representative

Organization **Avvocato Pierfrancesco Carmine Fasano (FASANO-Avvocati)**

Respondent

Organization **Domains By Proxy, LLC**

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant is the owner of trademark registrations for PIRELLI in several jurisdictions worldwide.

FACTUAL BACKGROUND

The Complainant PIRELLI & C. S.p.A. is a multinational company based in Italy and is among the largest tyre manufacturers in the world.

The Complainant is the owner, amongst others, of the following trademark registrations for PIRELLI (word mark):

the Italian Trademark Registration Nos. 1133043, filed on May 7, 1975, in classes 19 and 37; 1312451, filed on March 5, 1958, in classes 1, 2, 7, 8, 9, 10, 11, 12, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28 and 34; the Community Trademark Registration No. 3733136, filed on March 31, 2004, 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 International Trademark Registration No. 720495, registered on May 7, 1999, in classes 1, 2, 7, 8, 9, 10, 11, 12, 16, 17, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28 and 34; the Indonesian Trademark Registration Nos. 100881, filed on September 14, 1984, in class 12; 548971, filed on

October 27, 1994, in class 9; 100880, filed on September 14, 1984, in class 9; and 100882 filed September 14, 1984, in class 11.

The Complainant has used its trademark PIRELLI for many years in connection with, inter alia, goods and service in the tyre sector. The Complainant's PIRELLI mark is well-known and the name PIRELLI is renowned in connection with tyres.

The Complainant is also the holder of several domain names constituted by or including the mark PIRELLI, amongst others, of the following domain names: <pirelli.com>, registered on January 11, 1995 and <pirellityres.com>, registered on July 29, 2002.

The disputed domain name <pirellireifen.info> was registered, on November 8, 2011, in the name of Domains By Proxy, LLC. Soon after CAC's Request for registrar verification, the Registrar disclosed the data of the underlying registrant of the disputed domain name, identifying the registrant as Cas Rudi, located Jln jeruk raya blok L4 No 1 Rt 05 Rw 15 Kel Sukatani Kec Tapos Depok, JawaBarat 16454 Indonesia (email address: casrudi@ymail.com). The Complainant thus added Cas Rudi as Co-Respondent to the Complaint and has been allowed to proceed against both.

The disputed domain name is not currently used for an active website, but has been used in the past to promote tyres of a number of companies which are in direct competition with the Complainant.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant points out that the disputed domain name should be transferred to the Complainant because it constitutes usurpation and violation of the rights of the Complainant with regard to its trademarks, registered in Italy and worldwide, its domain names and company name for the following reasons:

- 1) The disputed domain name is confusingly similar to the trademarks, company name and domain names of the Complainant, because it wholly incorporates the dominant part of PIRELLI marks; the addition of the word "reifen", which means "tyre" in German and coincides with the core business of the Complainant, is insufficient to negate the confusingly similarity between the disputed domain name and PIRELLI marks and even increases the likelihood of confusion.
- 2) The Respondents have no rights or legitimate interests in respect of the disputed domain name, since i) the Complainant has no relationship with Domains By Proxy, LLC and/or Cas Rudi whatsoever and has never authorized both Respondents to use the disputed domain name "pirellireifen.info" or any other domain name; ii) there is no indication that the Respondents have any legitimate interest in the 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); iii) there is no evidence that the use of "pirellireifen.info" is either a bona fide offering of goods or services or a legitimate noncommercial or fair use, without intent for commercial gain since the disputed domain name resolves to a web site (in German) related to tyres of the Complainant's competitors and containing links to further web sites; and iv) there is no evidence that Domains By Proxy, LLC and/or Cas Rudi have been commonly known by the domain name "pirellireifen.info".
- 3) The disputed domain name has been registered and is being used in bad faith since i) the web site to whom it resolves makes it clear that it has been registered and is being used for commercial gain, with the intent to trade upon the reputation and good will associated with PIRELLI marks; ii) the disputed domain name 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 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; iii) the Respondents had relevant notice about the existence of PIRELLI Marks, since they registered and have been using a

domain name corresponding with the dominant part of PIRELLI marks, adding a generic word ("reifen", which means tyre in German, coinciding with the core business of the Complainant) and the web site to which the domain name resolves is related to tyres of Pirelli's competitors; and iv) both the Respondents were involved in a similar case of cybersquatting having also registered the domain name "pirelliwinterreifen.info" (CAC Case no. 100398).

RESPONDENT:

No administratively compliant response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed 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 Respondents to have no rights or legitimate interests in respect of the disputed 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 disputed 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. The disputed domain name includes the registered and well-known trademark PIRELLI of the Complainant, with the addition of the word "reifen", which is the German for "tyres". According to a number of prior decisions under the UDRP, the addition of a generic term to a trademark is not sufficient to exclude the confusing similarity. Furthermore, the addition of the term "tyre", which is inherent to the Complainant's business, is apt to increase the likelihood of confusion among the disputed domain names and the Complainant's trademark.
 2. The Panel finds that the Complainant successfully submitted prima facie evidence that the Respondents have made no use of, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services, nor are making a legitimate non-commercial or fair use of the disputed domain name, nor are commonly known under the disputed domain name. In fact, the Respondents have made a commercial use of the disputed domain name to advertise tyres of Complainant's competitors and to provide links to third party websites. Under these circumstances and in absence of a Response, the Panel finds that Respondents have no rights or legitimate interest in the disputed domain name.
 3. In light of the well-known character of the Complainant's trademark PIRELLI, the Panel finds that the Respondents were more likely than not aware of it at the time of the registration. Based on the evidence submitted by the Complainant and not challenged by the Respondent as to the use of the disputed domain name, the Panel also finds that the Respondents have intentionally attempted to attract, for commercial gain, Internet users to the correspondent website by creating a likelihood of confusion with the mark of the Complainant as to the source, sponsorship, affiliation, or endorsement of their website or of a product on their website or location. The fact that the Respondents have been subject to a prior UDRP proceeding involving another domain name confusingly similar to the Complainant's trademark ("pirelliwinterreifen.info", CAC Case no. 100398), is a further circumstance highlighting the Respondents' bad faith.
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FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **PIRELLIREIFEN.INFO**: Transferred

PANELLISTS

Name **Luca Barbero**

DATE OF PANEL DECISION **2012-05-07**

Publish the Decision
