

Decision for dispute CAC-UDRP-100430

Case number **CAC-UDRP-100430**

Time of filing **2012-04-06 11:28:46**

Domain names **pirelli.net**

Case administrator

Name **Tereza Bartošková (Case admin)**

Complainant

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

Complainant representative

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

Respondent

Name **Stanley Pace**

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any legal proceedings that are pending or decided and which relate to the Disputed Domain Name.

IDENTIFICATION OF RIGHTS

As set forth in the Factual Background, below, Complainant states, and provides evidence in support thereof, that it is the owner of numerous trademark registrations that contain the word PIRELLI, in Italy, the European Union and the United States, among other locations (the "PIRELLI Trademark").

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT (AS SET FORTH VERBATIM IN THE COMPLAINT) 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 multinational company based in Milan, Italy (ANNEX 1 – "Brochure Pirelli"). 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. A strength supported since 2002 by PZero fashion and high-tech project and further enhanced by Formula 1, for which Pirelli is the exclusive tyre supplier for the three-year terms 2011-2013.

Over the years, further to its core business, namely tyre manufacturing, identified as Pirelli Tyre (ANNEX 2 – “Brochure Pirelli Tyre”), 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.

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).

The Company's tyre business consists of two main segments: consumer (70% of total revenues) deals with tyres for motor vehicles, sports utility vehicles (SUVs), light commercial vehicles and motorbikes; and industrial (30% of revenues), which means tyres for buses, heavy trucks, agricultural machinery and steelcord, the fundamental strengthening element for radial tyres. These businesses are in turn focussed on two different sales channels: replacements (75% of 2010 revenues), tyres for vehicles already and on the road, and original equipment (25% 2010 revenues), directly focussed on manufacturers.

Pirelli 's technological skills and innovative approach have allowed it to consolidate agreements with the most prestigious motor vehicle and motorbike manufacturers in the world.

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.

Century-old history

The history of Pirelli coincides with the history of the tyre industry. In 1872 Giovanni Battista Pirelli, a young engineer, founded the Company in Milan at the age of twenty-four. A year later, the first facility for the production of rubber articles was up and running.

Toward the end of the century the process of diversification began: from insulated telegraph cable (1879) to underwater telegraph cable (1886) to the first bicycle tyres (1890). The first automobile tyre came off the line in 1901. With the new century, Pirelli began enjoying its first sporting victories and building plants abroad: in Spain (1902), Great Britain (1914) and Argentina (1917).

Starting in the 1920s, drivers like Nuvolari, Ascari and Fangio regaled Pirelli with a rousing series of auto racing trophies. In 1927 the Superflex Stella Bianca racing tyre was introduced.

The beginning of the 1950s saw the birth of the Cinturato radial, which would leave a decisive mark in the history of tyres. In the meantime, Pirelli continued with its massive geographical expansion, which proceeded through the '60s and '70s, acquiring the German tyre manufacturer Veith, while starting up cable production facilities in Perù (1968) and Australia (1975). In the mid-'70s Pirelli invented the low profile tyre, the famous P7, one of the most important inventions in the industry after the Cinturato radial. Another discovery revolutionised the world of cables: fibre optics.

During the 1980s Pirelli acquired the German motorcycle tyre maker Metzeler and Standard Telephone Cable, manufacturer of telecommunications land cable.

After a company-wide restructuring in 1992-93, Pirelli implemented an international relaunch, and in 1994 presented the Pirelli P

Zero ultra-low profile tread, used for the most prestigious tyre models.

In recent years, Pirelli Cables & Systems has reinforced its position of primacy in the energy field with the acquisitions of Siemens (1998), Metal Manufactures Ltd and Draka Holding (1999).

The new millennium saw yet another revolution in the tyre sector: the MIRST™ production system, introduced in 2000, for the automated fabrication of high-performance tyres.

While MIRST™ "mini-factories" were built in Germany, Great Britain the United States, extending also to motorcycle tyre production, in 2002 the Bicocca pilot plant in Milan began operating its futuristic CCM (Continuous Compound Mixing) system. 2001 saw the opening of Pirelli Labs, the cutting-edge development division for the Group's new technologies, from photonics and fibre optics to material sciences.

As for real estate, after a decade of steady growth that made Pirelli the most important player in the Italian real estate panorama, Pirelli RE went public in 2002.

In 2004 the core business of the Group expanded to include new activities in the fields of broadband access and photonics (Pirelli Broadband Solutions), as well as those regarding the environment and renewable energy sources (Pirelli Ambiente Holding).

In 2005 the Group sold its Cables and Energy and Telecommunications Systems business to Goldman Sachs, with the new company taking the name of Prymsian. Also in 2005, Pirelli opened its first tyre production plant in China, in the province of Shandong later to become the Group's production hub. In the same year a production plant of steelcord for tyres was opened in Romania.

2006: Pirelli opened its first tyre production plant in Romania.

2007 saw an increased presence of Pirelli in China. In the Chinese production plant as well as the production of tyres for HGVs, tyres for cars began to be produced. During the year, the Group's holding in Olimpia was sold off.

2008: the Group continued expanding its production. Pirelli and Russian Technology signed an agreement for a joint venture to start tyre production in Russia, in the region of Samara.

In 2009 a new plant was opened in Romania for the production of anti-particulate filters: an agreement for the manufacture of filters in China too was signed with the Chinese group Hixy.

In spring 2010 the Pirelli Foundation was officially opened at the Bicocca in Milan, through which the Group aims to valorise the company's historic archive and develop its business philosophy. 2010 marked the return of Pirelli to Formula 1, when the exclusive contract to supply tyres for the 2011-2013 World Championships was awarded.

2010 also saw Pirelli focus on the core business of tyres, and the Premium segment in particular, the high and very high range of tyres in which the group already holds a position of leadership. As part of this focus, the transformation into a "pure tyre company" concluded in the year with the sale of Pirelli Broadband Solutions and the spin-off of the real estate business, Pirelli Re, now called Prelios. The construction of the first factory in Mexico was also announced. Production is expected to start in 2012 and will be destined principally for the NAFTA market.

2011: Pirelli is confirmed as the exclusive supplier of tyres for the World Superbike Championship until 2015.

Well-known brand

As mentioned above Pirelli is distinguished for its long industrial tradition, which has always been combined with capacity for innovation, product quality and brand strength. Thanks to the success and leader position achieved by Pirelli in relation with all segments in which it operates, Pirelli's marks are well-known worldwide.

With a brand value estimated by Interbrand in 2010 of approximately 1.8 billion euros, PIRELLI brand represents a potential to be leveraged and will become even stronger through the involvement with Formula One.

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 3 - "Trademark list"). Trademarks included in ANNEX 3 are registered in Italy, in the EU, in the United States and in many other countries all over the world. Pirelli has used its trademarks for many, many years in connection with:

- power cables and systems sector (classes 9 and 38 of the International Classification System of Goods and Services);

- telecommunications cables and systems sector (classes 9 and 38 of the International Classification System of Goods and Services);
- tyre sector (class 12 of the International Classification System of Goods and Services);
- real estate sector (class 36 of the International Classification System of Goods and Services).

Furthermore, products and services of class 7 (namely, “Machines and machine tools; motors and engines”) class 14 (namely, “Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments”) class 18 (namely, “Leather and imitations of leather, and goods made of these materials and not included in other classes”) class 25 (namely, “Clothing, footwear, headgear”) class 28 (namely, “gymnastic and sporting articles”) class 35 (namely “Franchising services; business advisory services relating to franchising; commercial management assistance in relation to franchises; advertising; business management; business administration; office functions”) class 41 (namely “Education; providing of training; entertainment; sporting and cultural activities”) and 42 (namely “Scientific and technological services and research and design relating thereto; industrial analysis and research services”) belong to many trademark registrations and/or applications of Pirelli.

Pirelli 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.

Domain names:

Pirelli owns and actively uses the domain name “pirelli.com”, created on January 11, 1995, as its primary domain name, as well as numerous domain names listed on ANNEX 4 – “Domain name list”.

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 “pirelli.net” was registered on October 24, 1997, i.e. well after PIRELLI Marks. As certified by the attached printout of the relevant WHOIS records at the time of filing of this Complaint, Pace Stanley 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 and worldwide, its domain names and company name for the following reasons.

ICANN Rules 3(b)(ix)(1); ICANN Policy 4(a)(i)

> Identity and/or confusing similarity of the disputed domain name with the trademarks, company name and domain names of the Complainant

The disputed domain name is identical and/or confusingly similar to Complainant’s trademarks, company name and domain

names, because it wholly incorporates the dominant component of PIRELLI Marks, namely the wording "PIRELLI".

It is well founded that the disputed domain name is to be considered identical and/or confusingly similar with PIRELLI Marks since the top-level suffix ".net" is ignored for the purpose of determination the similarity between the disputed domain name and the word "PIRELLI" (as it is a technical requirement of registration). See WIPO/D2002-0760 (barep.biz inter alia); WIPO/D2002-0424 (geac.org).

It is undoubtful that the suffix .net does not affect the attractive power of the dominant part of PIRELLI Marks, i.e., "PIRELLI", and the domain name "pirelli.net" is consequently identical and/or confusingly similar with the Complainant's marks.

The domain name "pirelli.net" can be confused with:

- a) the trademark registrations and/or applications of Pirelli valid in Italy and worldwide (see ANNEX 3);
- b) the domain names registered by Pirelli (see ANNEX 4), in particular, with Complainant's primary domain name: pirelli.com;
- c) the company name of Pirelli (see ANNEXES 5-6).

The identity and/or similarity of the disputed domain name to PIRELLI Marks, is likely to lead to confusion and/or association for the Internet users.

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 "pirelli.net"

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 "pirelli.net" 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).

Further, entering "pirelli.net" in the address bar of an internet browser resolves to a web site containing third parties links to further web site, some of them related to tyres or real estate services, businesses in which Pirelli is involved (ANNEX 10 – "Printout of pirelli.net of February 16, 2012"). Moreover, on such web site the following can be read: "Il dominio pirelli.net è in vendita" (translation in English: The domain name pirelli.net is for sale). Hence, there is no evidence that the Respondent, before any notice of the dispute, used or prepared to use "pirelli.net" in connection with 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 "pirelli.net".

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 compalainant'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 compalainant'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 (gallupll.com - finding that the respondent does not have rights in a domain name when the respondent is not known by the mark); NAF/FA740335 (cigarafionada.com - finding that the respondent was not commonly known by the "cigarafionada.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 "pirelli.net" in bad faith

The disputed domain name has been registered and is being used in bad faith considering the following cumulative circumstances.

Respondent's bad faith is clearly evident from the fact that it has registered and/or has been using a domain name which wholly comprises the dominant component of well-known PIRELLI Marks ("PIRELLI") and, therefore, is confusingly similar to such PIRELLI Marks. This evidences a clear intent to trade upon the reputation and good will associated with PIRELLI Marks. Respondent was 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 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. See decision CAC Case N. 05367 (Giorgio Armani s.p.a. v. Antares S.p.A., Germano Armani).

Furthermore, a review of the web site to which "pirelli.net" resolves makes it clear that the domain name has been registered and used with a view of commercial gain. The disputed domain name resolves to a web site containing third parties links to further web site, some of them related to tyres or real estate services, businesses in which Pirelli is involved (see ANNEX 10). On such web site the following can be read: "Il dominio pirelli.net è in vendita" (translation in English: The domain name pirelli.net is for sale). Moreover, the domain name "pirelli.net" is available for purchase on Sedo: "This domain name (PIRELLI.NET) without content is available for sale by its owner through Sedo Domain Marketplace" (ANNEX 11 – "Printout of Sedo related to pirelli.net of February 16, 2012"). Such circumstance is also confirmed by the e-mail of Respondent showing the interest to sell the disputed domain name and requesting an offer (ANNEX 12 – "E-mail of Respondent of March 1, 2012").

In the light of the foregoing, it is more than likely that the registration of the domain name "pirelli.net" has been carried out with the sole purpose of exploiting Pirelli's reputation and good will 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 (celebex-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 than complainant suggests "opportunistic bad faith"); NAF/FA96356 (broadcom2000.com); NAF/FA96209 (gallupll.com); NAF/FA740335 (cigaraficionada.com); NAF/FA881234 (stlawu.com).

* * * *

Therefore, having ascertained 1) the confusing similarity of the domain name "pirelli.net" 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 Respondent's rights and legitimate interests 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 "pirelli.net" be transferred to Pirelli & C. S.p.A..

* * * *

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

The Panel finds that the Disputed Domain Name is identical to the Complainant's PIRELLI Trademark.

The Panel finds that Complainant has made out a prima facie case that the Respondent lacks rights or legitimate interests. Given that the Respondent has not come forward with any allegations or evidence demonstrating rights or legitimate interests in the Disputed Domain Name, the Panel finds that the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP.

The Panel finds that bad faith exists as set forth in paragraph 4(b)(iv) of the UDRP, that is, by using the Disputed Domain Name in connection with a monetized parking page that contains links to companies offering services competitive with Complainant, Respondent has "intentionally attempted to attract, for commercial gain, Internet users to [Respondent's] 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 [Respondent's] web site or location or of a product or service on [Respondent's] web site or location."

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **PIRELLI.NET**: Transferred

PANELLISTS

Name **Douglas M. Isenberg**

DATE OF PANEL DECISION 2012-05-18

Publish the Decision
