

Decision for dispute CAC-UDRP-100432

Case number	CAC-UDRP-100432
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Domain names	PIRELLIMOTORCYCLERACING.COM, PIRELLIMOTOCYCLEDRAGRACING.COM

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	House Entertainment Group
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OTHER LEGAL PROCEEDINGS

Not applicable

IDENTIFICATION OF RIGHTS

The Complainant has registrations of the trademark "PIRELLI" in many countries and unregistered rights in this mark in many countries due to its extensive reputation and goodwill.

FACTUAL BACKGROUND

The following facts are asserted by the Complainant and not contested by the Respondent:

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. 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 term 2011-2013.

Over the years, further to its core business, namely tyre manufacturing, identified as 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.

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.

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.

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.

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. In 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.

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

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. The value of the PIRELLI brand was estimated by Interbrand in 2010 at approximately 1.8 billion euros.

Pirelli is owner of numerous registrations and/or applications for trademarks, comprising the keyword "PIRELLI" 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 class 42 (namely "Scientific and technological services and research and design relating thereto; industrial analysis and research services") are covered by 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 goodwill 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.

Pirelli owns and actively uses the domain name "pirelli.com", created on January 11, 1995, as its primary domain name, as well as numerous other domain names.

Pirelli is a joint stock company incorporated under the laws of Italy. During its century-old history Pirelli has changed its company name, leaving always unchanged the dominant part of it, namely "PIRELLI".

The domain names "pirellimotorcyclerracing.com" and "pirellimotocyledragracing.com" were registered on December 8, 2011, i.e. well after Complainant's trademarks.

Pirelli has no relationship with the Respondent whatsoever. Pirelli has never authorized the Respondent to use the domain names "pirellimotorcyclerracing.com" and "pirellimotocyledragracing.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).

Further, entering "pirellimotorcyclerracing.com" and "pirellimotocyledragracing.com" in the address bar of an internet browser redirects to a web site ("harvelperformance.com") which contains a picture of a motorcycle tyre, a logo which is confusingly similar with the "long P" trademark of the Complainant, and link to a third web site ("shop.harvelperformance.com") related to tyres.

Respondent has been deliberately using the domain names 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.

The Respondent provided the Registrar with a false contact information (e-mail address), therefore, the delivery of the cease and desist letter of the Complainant has failed.

PARTIES CONTENTIONS

COMPLAINANT: The Complainant contends that the domain names are confusingly similar to the mark "PIRELLI" in which it has registered and unregistered rights, since they differ from the mark only in the addition of descriptive words and the generic TLD suffix.

The Complainant submits that the Respondent has no rights or legitimate interests in the domain name. It points out that it has no relationship with the Respondent and has not authorised the Respondent to use the disputed domain names. It contends that the Respondent's use of the domain names to redirect Internet users to its own website relating to tyres does not constitute a bona fide offering of goods or services conferring any right or legitimate interest on the Respondent, nor is it legitimate non-commercial or fair use.

The Complainant alleges that the Respondent has registered and is using the domain name in bad faith, to attract Internet users to its website for commercial gain by creating a likelihood of confusion with the Complainant's marks.

RESPONDENT: The Respondent has not submitted any contentions.

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 domain names are confusingly similar to the Complainant's mark "PIRELLI" since they consist of this mark together with the descriptive phrases "motor cycle racing" or "motor cycle drag racing" and the generic TLD suffix. Since the Complainant sponsors motorcycle racing to demonstrate the technical qualities of its products, Internet users are liable to assume that the domain names locate websites established by the Complainant in connection with this sponsorship.

On the undisputed evidence, the Respondent's use of the domain names to direct to its own website apparently relating to tyres is not for a bona fide offering of goods or services nor is it a legitimate non-commercial or fair use. Nor does the Respondent appear to be commonly known by the domain names. On the evidence there does not appear to be any other basis on which the Respondent could claim any rights or legitimate interests in the domain names.

The Respondent is using the domain names to attract Internet users to its website for commercial gain by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship affiliation or endorsement of its website or of products or services advertised on it. In accordance with paragraph 4(b)(iv) of the UDRP this constitutes evidence of registration and use of the domain name in bad faith. There is no evidence to the contrary displacing this presumption.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **PIRELLIMOTORCYCLERACING.COM**: Transferred
 2. **PIRELLIMOTOCYCLEDRAGRACING.COM**: Transferred
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PANELLISTS

Name **Jonathan Turner**

DATE OF PANEL DECISION 2012-06-03

Publish the Decision
