Decision for dispute CAC-UDRP-100877

Case number	CAC-UDRP-100877
Time of filing	2014-11-12 12:25:52
Domain names	PIRELLIMEXICO.COM

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	Pirelli & C. S.p.a.

Complainant representative

Organization	FASANO-Avvocati

Respondent

Organization	Registration Private - Domains By Proxy, LLC

OTHER LEGAL PROCEEDINGS

No other proceedings have been notified to the Panel.

IDENTIFICATION OF RIGHTS

Numerous trademarks under several Nice Classification categories are registered in favour of the Complainant in a range of jurisdictions. The Complainant has furthermore offered extensive proof of reputation and of being the holder of the pirelli.com domain name registration. The rights thereby identified relate to the brand "Pirelli" in several variants and include in particular rights related to tyres which have been marketed on the basis of the notoriety the Pirelli brand has won, including in the sporting world in connection with Formula 1 racing.

FACTUAL BACKGROUND

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

Pirelli & C. S.p.A. (hereinafter referred to as “Pirelli”) is a well-known multinational company. With sales of 6.15 billion Euros in 2013, it is the fifth largest global tyre manufacturer and leader in the high-end segments with high technological content. Today, Pirelli has 21 plants located in 13 countries throughout the world (Italy, U.K., Germany, Russia, Turkey, Romania, China, Egypt, Argentina, Brazil, Venezuela, Mexico, U.S.A.) 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,

combined with capacity for innovation, product quality and a brand strength, supported since 2002 by PZero fashion and high-tech projects and further enhanced by Formula 1, for which Pirelli has been the exclusive tyre supplier since 2011.

Further to its core business of tyre manufacturing, Pirelli has created new businesses in other segments: Pirelli Ambiente, engaged in the renewable energy sector; Pirelli & C. Eco Technology, dedicated to developing technologies to control pollutant emissions; Pirelli Labs, a centre of technological excellence and engine of innovation.

Thanks to the success and leader position achieved by Pirelli in relation to all segments in which it operates, its trademarks are well-known worldwide. In 2008 Pirelli was ranked among the 10 most valuable Italian global brands. According to Interbrand valuation made in 2011, Pirelli's brand has a value of 2.27 billion Euros, with an increase of 26% compared vs 1.8 billion Euros in 2010. Pirelli's presence in Formula 1 contributed for 200 million Euros to this growth. Pirelli sees its trademark as a driver to favor growth in the premium segment. According to the Interbrand figures, the Pirelli brand is 15% more effective than other brands in the choice of tire purchases mainly due to the consumer's perception of a premium brand particularly appreciated for its sporting, glamorous and prestigious image. Marketing expenditure is forecast to double in future to increase the brand's fame in all key premium markets, by optimizing the allocation between advertising and digital marketing and creating strong synergies between tires (Pirelli), Fashion (P Zero), the Pirelli Calendar and Formula 1.

The domain name "pirellimexico.com" was registered on 13 October 2009, i.e. well after the various Pirelli trademarks were taken out. The disputed domain name registration takes advantage of a privacy or proxy registration service. As certified by the relevant WHOIS records at the time of filing of the Complaint, Registration Private - Domains By Proxy, LLC was shown as registrant.

During the pre-complaint dealings the Complainant learnt that Mr. Luis Javier Pelayo - Llantas Supremas S.A. is the owner of the domain name. Soon after CAC's Request for registrar verification, the Registrar furthermore disclosed the data of the underlying registrant of the disputed domain name: Luis Javier Pelayo, Llantas Supremas S.A., Calz. Vallejo 1156, Col. Pardo Vallejo, Edo. de Mexico, 54170 Mexico (Phone: 52 55 53894066; Fax: 52 55 536895768; E-mail: lj.pelayo@llantassupremas.com.mx).

Being aware of the identity of the "true" domain name holder, the Complainant added Luis Javier Pelayo - Llantas Supremas S.A. as Co-Respondent to the Complaint.

Before receiving the Complainant's cease and desist letter the domain name resolved to a web site displaying the well-known PirelliMarks of the Complainant. Currently the domain name resolves to a parking page permitting the Respondents to earn pay-per-click revenue there is no evidence that the Respondent has used or been preparing to use the domain name "pirellimexico.com" in connection with a bona fide offering of goods or services or a legitimate noncommercial or fair use but rather documents submitted by the Complainant stand as evidence that commercial gain may be secured from misleadingly diverting consumers.

The Complainant adduced evidence that the Respondent is engaged in a pattern of registering domain names confusingly similar to the Pirelli marks, to which he is not entitled and preventing the Complainant from registering the domain names such as: pirellimexico.com, pirellimexico.com.mx, pirellimexico.mx, llantaspirelli.mx. Soon after the receipt of such cease and desist letter the Respondent replied confirming to be owner of the domain name and offering it for sale to the Complainant for an amount which exceeds his out-of-pocket expenses related to the domain name. Furthermore, he cancelled the content of the web site, so removing future trace of material infringing the Complainant's rights but redirected the domain name to a parking page.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT: The slight difference through addition of a geographical term "mexico" notwithstanding, the disputed

domain name “pirellimexico.com” is confusingly similarity to the trademarks or service marks in which the Complainant has rights and should be transferred to Pirelli, because its registration and use constitutes usurpation and violation in bad faith and with no legitimate right or interest on the Respondent's part of the rights of the Complainant with regard to its trademarks, trade name and domain names.

The Complainant requested that this dispute be allowed to proceed against Registration Private - Domains By Proxy, LLC as well as Luis Javier Pelayo - Llantas Supremas S.A..

RESPONDENT: None.

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.

Based on the arguments of CAC decision No. 100221 the Panel accepts the request of the Complainant that the Complaint proceeds against Registration Private - Domains By Proxy, LLC as well as Luis Javier Pelayo - Llantas Supremas S.A.

PRINCIPAL REASONS FOR THE DECISION

Pirelli is a world-famous brand associated with the Complainant's quality tyre manufacturing and distribution business but diversified into other areas as well, including renewable energy and pollutant emissions reduction and fashion accessories. The Complainant has multinational holdings and is active in some 160 countries. The Complainant adduced extensive evidence demonstrating Pirelli’s commitment to developing, maintaining and protecting its highly visible and valuable brand. To defend such a prized brand, the Complainant is owner of numerous trademarks, some of distinguished longevity that date back to early in the modern industrial era.

The Panel finds that the Respondent, according to a screenshot produced by the Complainant, displayed prominently Pirelli tyres on a website which resolved to the pirellimexico.com domain name registered in the Respondent’s name. This occurred without the Respondent having any discernible business relationship with any Pirelli entity. To the contrary, the Respondent sought to sell the contested domain name to the Complainant at a price above normal incidental costs.

Once correspondence with the Complainant had been initiated, the Respondent then removed the website. The Respondent failed to submit a Response to the Complaint.

There is no question that the addition of “Mexico” in the contested domain name, a country in which the Complainant moreover has a presence, merely indicates a geographical association with the name and does not detract from the basis for the name’s protection. Therefore, the Panel finds the disputed domain name to be confusingly similar to the Complainant's trademarks.

As noted in previous similar cases, such as No. CAC 100413 (pirellirecinisello.com), the burden of proof upon the Complainant to show the absence of a legitimate right or interest on the Respondent's part is light and the absence of any business relationship in relation to the holder of such a famous brand, as shown in this case, discharges that burden. The evidentiary burden therefore shifts to the Respondent to show by concrete evidence that he does have rights or legitimate interests in that name. The Respondent has made no attempt to do so. Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

The Panel finds that the conduct of the Respondent:

- in using material associated with the Pirelli brand without authorization
- in then withdrawing the website containing it upon entering correspondence with the Complainant, and
- in seeking to make a gain under the terms offered to transfer the contested name to the Complainant

indicates bad faith. The absence of any Response in face of such evidence of bad faith, or of any circumstances on their face capable of countering its indication, thus prompts the inference of bad faith registration and use to be drawn.

The Panel therefore has no hesitation in finding for the Complainant and awarding transfer of pirellimexico.com to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **PIRELLIMEXICO.COM**: Transferred

PANELLISTS

Name	**Kevin J. Madders**

DATE OF PANEL DECISION 2014-12-16

Publish the Decision