

Decision for dispute CAC-UDRP-100616

Case number	CAC-UDRP-100616
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Time of filing	2014-10-30 13:21:12
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Domain names	PIRELLI.ORG
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Case administrator

Name	Lada Válková (Case admin)
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Complainant

Organization	Pirelli & C. S.p.a.
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Complainant representative

Organization	FASANO-Avvocati
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Respondent

Organization	Avalon di Sodre
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OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other pending or decided proceeding relating to the disputed domain name.

IDENTIFICATION OF RIGHTS

Pirelli is owner of numerous registrations and/or applications for trademarks, comprising the keyword “PIRELLI”, as per the trademark list enclosed with the Complaint. These trademarks 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 the following fields:

- power cables and systems (classes 9 and 38);
- telecommunication cables and systems (classes 9 and 38);
- tyres (class 12);
- real estate (class 36).

Moreover, the Complainant provided evidence it owns PIRELLI trademarks for goods and services in classes 7, 14, 17, 18, 25, 28, 35, 41 and 42.

According to the Complaint, 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.

The Complainant also owns trade name rights over the name PIRELLI, which it has used since 1872.

Finally, the Complainant owns rights in the domain name “pirelli.com”, created on January 11, 1995, as its primary domain name, as well as in numerous other PIRELLI domain names.

FACTUAL BACKGROUND

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

FACTUAL GROUNDS

About the Complainant

The Complainant claims that 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, which has always been combined with capacity for innovation, product quality and brand strength. 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 since 2011.

In line with its “green performance” strategy, Pirelli - always focused on research and development - operates with ever increasing attention to products and services of high quality and technology and low environmental impact.

Over the years, further to its core business, namely the tire manufacturing, identified as Pirelli Tyre, 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.

The Complainant contends that 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, 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.

The disputed domain name has been registered on January 12, 2014 by Avalon di Sodre, i.e., well after the registration and use of the Complainant's earlier rights.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

The Complainant's contentions are the following:

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, trade name and domain names for the following reasons.

According to the Complainant, the disputed domain name is identical to the PIRELLI earlier trademarks, trade name and domain names (hereinafter globally referred to as the “PIRELLI Marks”), because they wholly incorporate the dominant part of such

signs, namely the term “PIRELLI”.

It is well founded that the disputed domain name is to be considered identical to the PIRELLI Marks since the generic top-level suffix “.org” is to be ignored for the purpose of determination of the identity between the disputed domain name and the PIRELLI Marks (as it is a technical requirement of registration).

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

According to the Complainant, Pirelli has no relationship whatsoever with the Respondent. Pirelli has never authorized the Respondent to use the domain name “pirelli.org” or any other domain name. Additionally, there is no indication that the Respondent has 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).

The Complainant contends that before receiving the Complainant’s cease and desist letter the domain name resolved to a web site displaying the well-known PIRELLI Marks of the Complainant. It is not possible to recall such web site through the wayback machine tool of archive.org. Currently the disputed domain name does not redirect to any active web site. Hence, there is no evidence that the Respondent has used or has been preparing to use the domain name “pirelli.org” in connection with a bona fide offering of goods or services or a legitimate noncommercial or fair use, without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant’s PIRELLI Marks.

Finally, there is no evidence that the Respondent has been commonly known by the domain name “pirelli.org”.

The Complainant claims that 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 comprising the dominant component of the well-known PIRELLI Marks and, therefore, is confusingly similar to said marks. This is a clear evidence of the intent to trade upon the reputation and goodwill associated with PIRELLI Marks.

- Respondent has been deliberately using a domain name confusingly similar to the 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 the Complainant 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 goodwill of the Complainant and PIRELLI Marks.

Furthermore, the fact that, before the receipt of the Complainant’s cease and desist letter, the domain name resolved to a web site displaying the well-known PIRELLI Marks confirms that the Respondent was aware of the Complainant, of its business and of the PIRELLI Marks. Soon after the receipt of said cease and desist letter the Respondent did not reply, but cancelled the content of the web site. Unfortunately, it is not possible to recall such web site through the wayback machine tool of archive.org. Currently, the disputed domain name does not resolve to any active web site, thus, the Respondent is a passive holder of the domain name “pirelli.org”.

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.

However, the Panel would like to point out that there was a clerical error on the part of the Provider for pursuant to paragraph 2(a)(ii) of the Rules the Provider is to send the Complaint in electronic form inter alia to postmaster@<contested domain name> in order to employ reasonably available means to achieve actual notice to the Respondent pursuant to paragraph 2(a) of the Rules. Nevertheless, the Case Administrator acting on behalf of the Provider sent in error the Complaint to postmaster@pirrelli.org instead of to postmaster@pirelli.org. The Complainant drew the Provider's attention to this issue via nonstandard communication dated November 25, 2014. The Provider then immediately sent the Complaint, including any annexes, in electronic form by email to postmaster@pirelli.org. On December 1, 2014 the Provider informed that on November 28, 2014 the email returned back undelivered as the email address had permanent fatal errors.

Pursuant to paragraph 4(c) of the Rules the date of the commencement of the administrative proceeding shall be the date on which the Provider completes its responsibilities under paragraph 2(a) of the Rules in connection with sending the Complaint to the Respondent. Furthermore, paragraph 5(a) of the Rules stipulates that the Respondent shall submit a response to the Provider within twenty days of the date of commencement of the administrative proceeding.

In the light of the foregoing, the Panel is to determine whether the Respondent was given a fair chance to respond to the Complaint. The purpose of the aforementioned paragraphs is to deliver in such a way as to give legally sufficient assurance that actual knowledge of the matter has been conveyed to the Respondent. In the case at hand, the Written Notice of the Complaint was sent to all postal-mail addresses shown in the domain name's registration data and supplied by Registrar to the Provider as well as to the email addresses except for postmaster@pirelli.org on November 3, 2014.

A question arises as to which date is to be considered as the date of commencement of the administrative proceeding pursuant to paragraph 5(a) of the Rules.

The Panel has no doubts there was a clerical error on the part of the Provider. However, it is to be emphasized that this particular error has literally no impact on achieving the goal of paragraph 2(a) of the Rules, i.e. achieving actual notice, for the email sent on November 26, 2014 returned back as undelivered due to permanent fatal errors. If the Provider had sent this email to postmaster@pirelli.org on November 3, 2014 the result would have been the same. In other words, the Panel finds that the Provider employed all reasonably available means calculated to achieve actual notice to the Respondent and in that sense the date of commencement of administrative proceeding shall be November 3, 2014. Finally, the Panel would like to add that if the Panel was to decide that the date of commencement of administrative proceeding was November 26, 2014 the Respondent would be given another twenty days to submit a response to the Provider in accordance with paragraph 5(a) of the Rules. For the email sent to postmaster@pirelli.org was not delivered anyway, the Panel is of the opinion that such prolongation of the deadline to deliver a response would constitute redundant delay in the proceedings and would be against the spirit and purpose of the Rules because the goal of the proceedings under UDRP is to create a streamlined and speeded up process for resolving domain name disputes.

PRINCIPAL REASONS FOR THE DECISION

1. 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).

The disputed domain name is identical, in its distinctive part, to the PIRELLI Marks.

The addition of the gTLD .org does not add any difference to the domain name, since it is an obliged element of the domain itself.

Accordingly, the Complainant has complied with the first requirement of the Policy, as provided for by paragraph 4(a)(i) thereto.

2. The Respondent lacks rights or legitimate interests in respect of the Domain Name (within the meaning of paragraph 4(a)(ii) of the Policy).

Under the UDRP, once a complainant has made out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production lies on the respondent. This is so because proving a negative fact is quite difficult, if not impossible. In the instant case, the Respondent has failed to demonstrate that it owns legitimate rights or interests.

According to the Complainant, there is no relationship between the Complainant and the Respondent. The Complainant did not authorize the Respondent to use the disputed domain name or any other domain name comprising the PIRELLI trademark. Additionally, there is no indication that the Respondent has any legitimate interest in the name PIRELLI according to the searches the Complainant has done on the IPTO, OHIM, USPTO and WIPO's databases, nor there is any evidence whatsoever that the Complainant it is known by the PIRELLI name.

Finally, the Complainant alleges that before receiving its cease and desist letter the domain name resolved to a web site displaying the well-known PIRELLI Marks. The website contents have been ever since changed and the domain name does not redirect to any active web site. Hence, there is no evidence that the Respondent has used or has been preparing to use the domain name "pirelli.org" in connection with a bona fide offering of goods or services or a legitimate noncommercial or fair use, without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant's PIRELLI Marks.

The Respondent had the opportunity to rebut all the aforementioned arguments, but failed to do so as it did not submit any Response within the given deadline.

Accordingly, the Panel accepts the Complainant's arguments supporting the Respondent's lack of rights or legitimate interest in the disputed domain name.

3. 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).

Registration in bad faith

The Panel believes that it is highly conceivable that the Respondent was aware of the Complainant's earlier conflicting signs when it registered the disputed domain name. As a matter of fact, the PIRELLI trademarks are distinctive and well-known. Therefore, it is not conceivable that the Respondent registered the disputed domain name by chance. Moreover, the fact that the domain name initially resolved to a website displaying the Complainant's Marks is a clear evidence that the Respondent was well aware of the existence of the Complainant and of the Complainant's Marks at the time it registered the disputed domain name.

According to paragraph 2, letters b) c) and d), of the UDRP Policy the Respondent warranted that the domain name registration would not infringe upon or otherwise violate the rights of any third party, had no unlawful purpose and it would not knowingly use the domain name in violation of any applicable laws or regulations. By registering a well-known mark or by failing to check whether the registration would have infringed on the right of a third party, the Respondent violated the mentioned provisions and

registered the domain name in bad faith.

Use in bad faith

As far as use in bad faith is concerned, the Complainant adduced several facts to demonstrate use of the disputed domain name in bad faith.

First, Respondent's bad faith is clearly evident from the fact that it has registered and/or has been using a domain name comprising the dominant component of the well-known PIRELLI Marks. This is clear evidence of the intent to trade upon the reputation and goodwill associated with the PIRELLI Marks.

Moreover, the Respondent has been deliberately using the domain name confusingly similar to the 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.

As ruled in WIPO Case DNU2014-0001 (pirelli.nu - <http://www.wipo.int/amc/en/domains/search/text.jsp?case=DNU2014-0001>: "Given the distinctive nature of the Complainant's PIRELLI mark and the reputation of the mark, it is inconceivable to the Panel that the Respondent registered the disputed domain name without prior knowledge of the Complainant or without intention of targeting the Complainant and the Complainant's activities towards its customers"); See also CAC/05367 (giorgioarmaniparfums.eu - http://eu.adr.eu/adr/decisions/decision.php?dispute_id=5367).

Furthermore, the fact that after having received the Complainant's cease and desist letter the Respondent changed the <pirelli.org> website, rather than assigning back the domain name to its legitimate owner, is another indication of bad faith.

There is a consensus view that the mere passive holding of a domain name constitutes use in bad faith. As a matter of fact, no use in good faith can exist, when the domain name corresponds to a well-known third party's trademark, and when the legitimate owner of said well-known earlier trademark has not authorized the use and registration of the objected to domain name. See also the following decisions: WIPO/D2000-0003 (telstra.org - <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0003.html>); WIPO/D2000-0574 (jupitercasino.com - <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0574.html>); WIPO/D2002-0131 (ladbrokespoker.com - <http://www.wipo.int/amc/en/domains/decisions/html/2002/d2002-0131.html>); WIPO/D2007-1903 (numberone.com - <http://www.wipo.int/amc/en/domains/decisions/html/2007/d2007-1903.html>); WIPO/D2008-1393 (maybank.com - <http://www.wipo.int/amc/en/domains/decisions/html/2008/d2008-1393.html>); WIPO/D2009-0273 (pentiumgroup.net - <http://www.wipo.int/amc/en/domains/decisions/html/2009/d2009-0273.html>); NAF/FA95476 (epsondirect.com - <http://domains.adrforum.com/domains/decisions/95476.htm>); WIPO/D2001-1242 (1800redroof.com 1888redroof.com, 1877redroof.com - <http://www.wipo.int/amc/en/domains/decisions/html/2001/d2001-1242.html>); WIPO/D2000-0147 (carolinapanthers.com - <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0147.html>).

In the light of the foregoing, it is more than likely that the registration of the domain name "pirelli.org" had the sole purpose to attract, for commercial gain, Internet users to the web site by creating a likelihood of confusion with the Complainant's marks or to exploit in any other way Pirelli's reputation and goodwill and/or with the purpose of selling the domain name to the Complainant or to a third party.

Accordingly, the Panel concludes that the Complainant has also demonstrated use of the <pirelli.org> domain name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **PIRELLI.ORG**: Transferred

PANELLISTS

Name	Angelica Lodigiani
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DATE OF PANEL DECISION	2014-12-17
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Publish the Decision	
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