Decision for dispute CAC-UDRP-100935

Case number	CAC-UDRP-100935
Time of filing	2015-02-26 10:06:14
Domain names	PIRELLIPROMOCIONES.COM, PIRELLILLANTAS.COM

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	Pirelli & C. S.p.a.

Complainant representative

Organization	FASANO-Avvocati

Respondent

Organization	Llantas Supremas S.A.

OTHER LEGAL PROCEEDINGS

No legal proceeding has been commenced or terminated in connection with the disputed domain names.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the trademark PIRELLI, with registrations in Italy and in several other countries, including in Mexico, were the Respondent is based.

FACTUAL BACKGROUND

The Complainant is a multinational company based in Italy which is among the largest tyre manufacturers in the world and leader in the high-end segments with high technological content. The Complainant has 21 plants located in 13 countries throughout the world, including in Mexico, and a commercial network that covers over 160 countries.

The Complainant is the owner of numerous trademark registrations and applications constituted of or comprising PIRELLI, including the following trademark registrations:

- Italian trademark registration No. 0000748773 for PIRELLI (word mark), filed on April 4, 1996, in classes 9 and 12;
- Community trademark registration No. 003733136 for PIRELLI (word mark), filed on March 31, 2004, in all classes;
- Mexican trademark registration No. 357790 for PIRELLI (word mark), filed on June 29, 1988, in classes 7, 12 and 17;
- Mexican trademark registration No. 356327 for PIRELLI (figurative mark), filed on June 29, 1988, in classes 7, 12 and 17.

The Complainant operates its main web site at <pirelli.com>, registered on January 11, 1995.

The disputed domain names <pirellipromociones.com> and <pirellillantas.com> were registered on October 13, 2009.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS

A. COMPLAINANT

The Complainant states that the disputed domain names <pirellipromociones.com> and <pirellillantas.com> are confusingly similar to the Complainant's trademark, as they wholly incorporate the trademark PIRELLI with the addition of generic terms "promociones" (meaning special "offers" in Spanish) and "llantas" (meaning "tyres") which is not sufficient to negate the confusingly similarity between the disputed domain names and the Complainant's trademark.

The Complainant also notes that, considering the fact that the Complainant's core business is the manufacturing and sale of tyres, the addition of these descriptive terms related to Complainant's business even increases the likelihood of confusion with the Complainant's trademark. The Complainant further states that the generic top-level suffix ".com" has to be ignored for the purpose of determination of confusing similarity between the disputed domain name and the trademark PIRELLI.

With reference to the Respondent's lack of rights or legitimate interests in respect of the disputed domain names, the Complainant points out that the Complainant has no relationship with the Respondent whatsoever and that the Complainant has never authorized the Respondent to register or use the disputed domain names.

The Complainant highlights that the disputed domain name "pirellipromociones.com" does not resolve to any active website, while "pirellillantas.com" resolves to a parking page permitting the Respondent to earn pay-per-click revenue, and concludes that there is no evidence that the Respondent has used or has been preparing to use the disputed domain names 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 trademark PIRELLI.

The Complainant also states that the Respondent is not commonly known by the disputed domain names.
With reference to the bad faith requirement, the Complainant asserts that the Respondent's bad faith is evident from the fact that it registered and has been using domain names incorporating the trademark PIRELLI and submits that the Respondent clearly intended to trade upon the reputation and goodwill associated with the Complainant's trademark.

The Complainant contends that, considering the vast and widespread advertising campaigns carried out by the Complainant for the promotion of products and services covered by the trademark PIRELLI, it is unlikely that the registration of the disputed domain names may be attributed to mere coincidence and was not made with full awareness and intent to exploit the reputation and goodwill of the Complainant and its marks.

The Complainant also indicates that, as the Respondent seems to be involved in the sale of tyres, it is unlikely that the Respondent did not have knowledge of the Complainant and its business.

The Complainant further asserts that, by registering a well-known trademark or by failing to check whether the disputed domain names would have infringed the rights of a third party, the Respondent violated paragraph 2, letters b) c) and d) of the UDRP Policy, which provides that, when registering a domain name, the applicant may warrant that the domain name registration will not infringe upon or otherwise violate the rights of any third party and that it has no unlawful purpose and will not knowingly use the domain name is violation of any applicable laws or regulations.

The Complainant highlights that, on the same day the disputed domain names were registered (October 13, 2009), the Respondent registered also the following domain names, comprising the Complainant's well-known trademark PIRELLI: <llantaspirelli.mx>, <pirellimexico.com.mx>, <pirellimexico.mx>, <pirellimexico.com>, <pirellimexico.net>, <pirellimexico.org>,

<pirellimexico.info>, <pirellipromociones.mx>, <pirellipromociones.com.mx>, <pirellillantas.mx> and <pirellillantas.com.mx>. The Complainant informs the Panel that the domain names <llantaspirelli.mx>, <pirellimexico.com.mx>, <pirellimexico.mx> and <pirellimexico.com> were transferred to the Complainant following separate ADR proceedings. In view of the above, the Complainant asserts that the Respondent has engaged in a pattern of registration of domain names confusingly similar to the trademark PIRELLI.

As to the use of the disputed domain names, the Complainant contends that the Respondent has been deliberately using them to attract, for commercial gain, Internet users to its web site, by creating a likelihood of confusion with the PIRELLI trademark and products as to the source, sponsorship, affiliation or endorsement of the disputed domain names or of a product or service on the Respondent's web site.

B. RESPONDENT

No administratively compliant response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown that the disputed domain names are 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 disputed domain names (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 names have been registered and are 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 names include the registered trademark PIRELLI of the Complainant, with the addition of the generic terms "promociones" (meaning "special offers" in Spanish) and "llantas" (meaning "tyres"), which are not sufficient to negate the confusingly similarity between the disputed domain names and the Complainant's trademark.

2. The Complainant has stated that the Respondent is not affiliated with or authorized by the Complainant in any way. There is no evidence of the fact that the Respondent might have been commonly known by the disputed domain names or by a name corresponding to the disputed domain names. The Respondent is passively holding the disputed domain name <pirellipromociones.com> while <pirellillantas.com> is pointed to a parking page with pay-per-click links, which typically generate revenues for the domain owner. Based on the evidence on records and considering that the Respondent has not submitted a Response, the Panel finds that the Respondent has not made use of, or demonstrable preparations to use, the disputed domain names in connection with a bona fide offering of goods or services. In view of the above and of the well-known character of the Complainant's trademark incorporated in the disputed domain names, the Panel also finds that the disputed domain names are not being used in connection with a legitimate non-commercial or fair use. Therefore, the Complainant has made a prima facie case that the Respondent has no rights or legitimate interest in the disputed domain name.

3. As to bad faith at the time of registration, in light of the prior registration and use of the trademark PIRELLI by the Complainant in connection with the products manufactured and sold by the Complainant, including in Mexico, where the

Respondent is based, and considering the well-known character of the trademark PIRELLI, that is entirely reproduced in the disputed domain names, the Panel finds that the Respondent was likely aware of the Complainant's trademark when registered the disputed domain names and that the registration cannot be ascribed to a mere coincidence. In any case, given the reputation of the Complainant's trademark as far as bad faith is concerned, the Respondent should have been aware of the Complainant's rights as it was obliged to determine whether its domain name registrations infringe or violate someone else's rights under paragraph 2 of the Policy.

As to the use of the disputed domain name, as mentioned above, <pirellillantas.com> is pointed to a parking page displaying several pay-per-click links to third party web sites. The Panel finds that 4(b)(iv) is applicable in this case since the Respondent intentionally attempted to attract, for commercial gain, Internet users to its web site by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation or endorsement of the site.

Furthermore, the disputed domain name <pirellipromociones.com> is not used in connection with an active web site, i.e. is passively held. As established in a number of prior cases, the concept of "bad faith use" in paragraph 4(b) of the Policy includes not only positive action but also passive holding; see the landmark case Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003.

As an additional circumstance of bad faith, the Panel finds that the Respondent has registered the disputed domain names in order to prevent the Complainant from reflecting its mark in corresponding domain names, and has engaged in a pattern of such conduct since it registered several additional domain names confusingly similar to the trademark PIRELLI under different TLDs.

Therefore, the Panel concludes that the Respondent has registered and used the disputed domain names in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **PIRELLIPROMOCIONES.COM**: Transferred
2. **PIRELLILLANTAS.COM**: Transferred

PANELLISTS

Name	**Luca Barbero**

DATE OF PANEL DECISION 2015-04-09

Publish the Decision