Decision for dispute CAC-UDRP-100960

Case number	CAC-UDRP-100960
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Domain names	PIRELLI.DIRECT, PIRELLI.COMPANY, PIRELLI.BUSINESS, PIRELLI.BIKE, PIRELLI.WORLD, PIRELLI.SERVICES, PIRELLI.REPAIR, PIRELLI.INTERNATIONAL, PIRELLI.GURU, PIRELLI.GUIDE, PIRELLI.DIRECTORY, PIRELLI.SUPPLIES, PIRELLI.SUPPLY

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	Pirelli & C. S.p.a.

Complainant representative

Organization	FASANO-Avvocati

Respondent

Name	Enam Miah

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain names.

IDENTIFICATION OF RIGHTS

The Complainant owns numerous trade mark registrations for the mark PIRELLI around the world, which include the following International trade mark registrations:

No. 873853 registered on 3 November 2005 in classes 9 and 12.
No. 944476 registered on 14 September 2007 in classes 12, 37 and 39.
No. 983473 registered on 5 August 2008 in classes 9 and 28.

FACTUAL BACKGROUND

The Complainant, Pirelli & C. S.p.A. (Pirelli) is a well known multinational global tyre manufacturer. It operates under the PIRELLI trade name. Pirelli owns numerous trade mark registrations, comprising the keyword PIRELLI, which are registered in many countries around the world.

Pirelli also owns rights in the domain name “pirelli.com”, created on 11 January 1995.

The disputed domain names were registered by the Respondent, Enam Miah, on 9 February 2015.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant submits that the disputed domain names are identical to PIRELLI marks, because they wholly incorporate the dominant part of the mark, namely the word “PIRELLI”.

The Complaint submits that it is well founded that generic top level suffixes “.direct”, “.company”, “.business”, “.bike”, “.world”, “.services”, “.repair”, “.international”, “.guru”, “.guide”, “.directory", “.supplies”, “.supply” are to be ignored when determining whether the disputed domain names are identical to the PIRELLI marks. A top level suffix is a technical requirement of registration and does not affect the dominant part “PIRELLI”. The disputed domain names are consequently identical to the Complainant’s mark.

The Complainant also submits that the disputed domain names can be confused with the trade mark registrations and/or applications of Pirelli, the trade name Pirelli; and the domain names registered by Pirelli, in particular with Complainant’s primary domain name: pirelli.com, which is likely to lead to confusion and/or association for the Internet users.

Lack of rights or legitimate interests

The Complainant says that the Respondent is not approved to use the PIRELLI marks in, or as part of, any domain name and has no association, affiliation or dealings with the Complainant.

The Complainant says the domain names currently resolve to parking pages, permitting the Respondent to earn pay-per-click revenue. The parking pages contain sponsored links to websites in competition with Pirelli’s core business. Hence, 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 non commercial or fair use, without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant’s PIRELLI marks.

Further, there is no evidence that the Respondent has been commonly known by the disputed domain names.

The Complainant submits that it has made out a prima facie case of absence of rights or legitimate interests in the domain names on the part of the Respondent and therefore, the evidentiary burden shifts to the Respondent to show that he has rights or legitimate interests in the domain names.

Registration and use of the disputed domain names in bad faith

The Complainant asserts that the disputed domain names have been registered and are being used in bad faith. The Respondent has registered and/or has been using 13 domain names which wholly comprise the dominant component of the well-known PIRELLI Marks and are identical to those marks. The Complainant says that this evidences a clear intent to trade upon the reputation and good will associated with the PIRELLI marks.

The Complainant says the Respondent is engaged in a pattern of registration of domain names identical to the PIRELLI marks, to which he is not entitled. Taking into account the widespread advertising campaigns carried out by Pirelli for the promotion of products and services covered by the PIRELLI marks, it is unlikely that the registration of the domain names in question may be attributed to mere chance and is with a full awareness and intent to exploit the reputation and goodwill of the Complainant and PIRELLI marks.

The Complainant asserts that the Respondent has been deliberately using the domain names, which are identical to PIRELLI marks, to attract for commercial gain, Internet users to its web sites, 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 sites. The Complainant says that the domain names resolve to parking pages with sponsored links of the Complainant's competitors, permitting the Respondent to earn pay-per-click revenue, which evidences a clear intent to trade upon the reputation and good will associated with PIRELLI marks.

The Complainant submits that under paragraph 2 of the Policy, the Respondent warranted that the domain names' registration would not infringe upon or otherwise violate the rights of any third party, and that he would not knowingly use the domain name is violation of any applicable laws or regulations. By registering a well-known mark, or by failing to check whether the registrations would have infringed on the rights of a third party, the Respondent violated these provisions.

The Complainant says the registration of the disputed domain names has been carried out with the sole purpose to attract, for commercial gain, Internet users to the web sites by creating a likelihood of confusion with the Complainant's marks, or to exploit in any other way Pirelli's reputation and good will.

The Complainant requests that the disputed domain names be transferred to the Complainant.

RESPONDENT:

The Respondent asks the Panel to take in account that his response is without legal assistance and limited knowledge of the UDRP arbitration process.

He says he was not aware of any complaints by Pirelli until he received correspondence from the case administrator and has been denied the ability to take a more thoughtful action to demonstrate his good character.

The Respondent says it is a duty of trade mark owners to actively protect their marks. By pursuing UDRP arbitration, Pirelli is explicitly acknowledging that it did not protect its trade mark by registering the domain names during the sunrise period for new gTLDs.

The Respondent denies bad faith and submits that in light of the Pirelli's decision not to participate in ICANN's trademark protection mechanism, the burden of proof (especially in the area of bad faith) needs to rise significantly above "balance of probability".

The Respondent submits that the registration of multiple similar domain names cannot be regarded as a demonstration of bad faith because it is a common practice used by website owners. The Respondent asserts that a generally accepted practice, by definition cannot be an act of bad faith. He says:

"A possible argument for bad faith in this instance could be made, by stating that each of the new gTLD has significant independent value. But Pirelli is not making this argument, as its no true. While country specific extensions have a distinctive value, as one might want to find country specific offering, for the new gTLD's this is currently not true.
Therefore if owning a single DN is not automatically an example of bad faith, then owning multiple DN's cannot equally be regarded as an act of bad faith. "

Regarding pay-for-click advertisement on the disputed domain names, the Respondent says that until the CAC forwarded the complaint he had no knowledge that the registrar had put advertisements on the sites. He did not request or explicitly give permission to the registrar to put adverts on the sites. He says he had no reason to believe that the registrar would put advertisements on the sites and that as far as he is aware he will not economically benefit from the advertisements.

The Respondent says that after finding out about advertisements, Pirelli could have contacted him and he would have then taken the necessary action. The Respondent says he did not know that his registrar would puts ads on the site and that it is

unreasonable to believe this action showed bad faith. The Respondent says that on being informed of the advertisements, he immediately tried to remove them but was informed that Godaddy's terms and condition entitled it to place pay-per-click ads and they would not remove them.

The Respondent submits that arbitration under the UDRP can only take place because all registrars have the relevant clauses in their terms and conditions. He submits that clauses in the registrar's terms and conditions are as equally valid as the UDRP clauses and that it should be beyond the scope of the arbitration to reinterpret or effectively find against the clauses.

The Respondent submits that if the registrar's terms and conditions are inconsistent with ICANN policy, then it is the responsibility of ICANN and the registrar to resolve this issue going forward, not for the parties involved in this arbitration.

The Respondent says the domain name parking did not require his positive action and cannot be viewed as bad faith. He also says that as a matter of good faith he has managed to remove the advertisements from the sites.

The Respondent says he is not involved in cyber-squatting, typo-squatting or pseudo - cyber-squatting and this too demonstrates his good faith.

The Respondent asserts that that the domain names were only recently registered. He says there is typically a delay between registering a domain name and content being available on that the site but that content will soon be available, as evidenced by an invoice annexed to the response. He says PIRELLI.WORLD will be the main site and the other 12 domain names will be redirected to it. The main site would be a fans site to allow motor heads to read about tyres and to learn and watch videos related to Pirelli. It will be clear that it's a fan (appreciation) site, so there will be no confusion with Pirelli's official site and that his actions will not prevent Pirelli's pursuing its online activities.

The Respondent also asserts the right to freedom of expression, which he says is recognized as a human right under article 19 of the Universal Declaration of Human Rights, to which all members of the United Nations are signatories. He says a fan site is a form of free speech and should be able to include trademark protected names in their domain names unless they deliberately show bad faith.

In conclusion the Respondent submits that he has not shown bad faith and has not tried to make any illegitimate commercial gains and requests that the complaint be dismissed.

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

Paragraph 4(a) of the Policy requires the Complainant to prove each of the following three elements:

(i) That the dispute domain names are identical or confusingly similar to a trade mark or service mark in which the Complaint has rights.
(ii) The Respondent has no rights or legitimate interests in the domain names.
(iii) The domain names have been registered and used in bad faith.

A. Identical or confusingly similar

The Panel is satisfied that the Complainant is the owner of numerous trade mark registrations for the mark PIRELLI in the EU and around the world, including Singapore.

That the generic top level suffix, which is a technical necessity, may be disregarded when considering whether a disputed domain name is confusingly similar to a trade mark in which the Complainant has rights. Disregarding the top level suffixes “direct”; “company”; “business”; “bike”; “world”; “service”; “repair”; “international”; “guru”; “guide”; “directory”; “supplier” and “supply”, each of the disputed domain names is identical to the Complainant’s mark PIRELLI.

The Respondent does not dispute that the trade mark PIRELLI is a well known brand, but says the Complainant is under a duty to protect its trade mark and should have registered the disputed domain names in the sunrise period. The Respondent argues: “the deliberate decision [of] Pirelli not to participate in the ICANN trade mark protection mechanism means that the standard of proof required (especially in the area of bad faith) needs to rise significantly above the “balance of probabilities”.

The Respondent’s submission is not well founded. ICANN is not a “trade mark protection mechanism” as the Respondent asserts. Its role includes responsibility for IP addresses and the domain name system. ICANN’s Uniform Dispute Resolution Policy (UDRP) applies by contract to registration of the disputed domain names and provides a system to resolve a domain name disputes.

UDRP proceedings are not trade mark proceedings, even though the Complainant’s ownership of trade mark rights is relevant in determining whether the disputed domain names are confusingly similar to a trade mark in which the Complainant has rights (see paragraph 4 (a) (i) of the Policy).

The Panel finds that each of the domain names “pirelli.direct”, “pirelli.company”, “pirelli.business”, “pirelli.bike”, “pirelli.world”, “pirelli.services”, “pirelli.repair”, “pirelli.international”, “pirelli.guru”, “pirelli.guide”, “pirelli.directory pirelli.supplies” and “pirelli.supply, are confusingly similar to the Complainant’s mark PIRELLI and that that the first element, set out in paragraph 4 (a) (i) of the Policy, has been met.

B. No rights or legitimate interests

The Complainant says that it has no association, affiliation or dealings with the Respondent and has not authorized the Respondent to use the PIRELLI marks in or as part of a domain name.

The disputed domain names resolve to parking pages with pay per click advertising and sponsored links to websites that compete with the Complaint’s business. This type of use is neither a bona fide offering of goods or services under paragraph 4(c)(i) of the Policy, nor a legitimate non-commercial or fair use under paragraph 4(c)(iii) of the Policy.

The Complainant has established a prima facie case that the Respondent lacks rights or a legitimate interest in the domain names. The burden of proof now passes to the Respondent to show he has rights or legitimate interests.

The Respondents asserts that “Pirelli.world” would be a fan site and that all the 12 other domain names would be directed to it. As evidence of this proposed use, the Respondent has submitted an invoice headed: Proposal for Pirelli.World website: Enam H Miah. But the invoice is undated and has no commencement date for the proposed work. Consequently, there is no evidence to indicate that before the Respondent had notice of the complaint he had made demonstrable preparations to use the domain names in connection with a bona fide offering of goods and services (paragraph4(c)(i) of the Policy).

The Respondent has not established any of the circumstances set out in paragraph 4 (c) of the Policy by which he could demonstrate rights or legitimate use of the domain names.

The Panel finds that the Respondent has no rights or legitimate interest in the disputed domain names.

C. Registered and used in bad faith

Paragraph 2 of the Policy provides that it is the Respondent's responsibility, when registering the domain names, to determine whether the domain names would infringe or violate someone else's rights. The Respondent is also required to represent and warrant that the registration of the domain name will not infringe the rights of any third party.

The Complainant says that in registering 13 domain names which comprise the PIRELLI marks there is clear evidence of intent to trade off the reputation and goodwill in the PIRELLI marks.

The Respondent argues that registration of multiple similar domains cannot be regarded as a demonstration of bad faith. He says that if owning a single domain name is not automatically bad faith then owning multiple domain names cannot be bad faith.

However, the Respondents argument ignores the fact that each of the domain names incorporates the Complainant's well known mark PIRELLI, that he knew of the Complainant's rights when he registered 13 domain names incorporating the PIRELLI name and that the sites features pay per click advertising.

The Respondent argues that Godaddy's terms and conditions, which allows Godaddy to put advertisements on sites as it sees fit, are inconsistent with the terms of the UDRP and that it is the responsibility of ICANN and the registrar to resolve this issue rather than the parties to this dispute.

It is not the role of the Panel to resolve any alleged inconsistence between the UDRP and Godaddy's terms and conditions.

The Respondent makes a number of submissions on freedom of expression. He says that a fan site is a form of free speech and that the fan site should be able to use the trade mark in a domain name for this purpose. However, each of the disputed domain names features pay per click advertising and link to websites that compete with the Complainant's business. There is no evidence to show that the domain names are being used for genuine non-commercial free speech.

The Panel finds that the requirements of paragraph 4(a) (iii) of the Policy are satisfied and that the Complainant has proved that the Respondent has registered and used the disputed domain names in bad faith

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FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **PIRELLI.DIRECT**: Transferred
2. **PIRELLI.COMPANY**: Transferred
3. **PIRELLI.BUSINESS**: Transferred
4. **PIRELLI.BIKE**: Transferred
5. **PIRELLI.WORLD**: Transferred
6. **PIRELLI.SERVICES**: Transferred
7. **PIRELLI.REPAIR**: Transferred
8. **PIRELLI.INTERNATIONAL**: Transferred
9. **PIRELLI.GURU**: Transferred
10. **PIRELLI.GUIDE**: Transferred
11. **PIRELLI.DIRECTORY**: Transferred

12. **PIRELLI.SUPPLIES**: Transferred
13. **PIRELLI.SUPPLY**: Transferred

PANELLISTS

Name	**Mrs Veronica Bailey**

DATE OF PANEL DECISION 2015-05-20

Publish the Decision