Decision for dispute CAC-UDRP-101310

Case number	CAC-UDRP-101310
Time of filing	2016-10-13 09:52:12
Domain names	METZELER.NET

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	Pirelli Tyre S.p.A.

Complainant representative

Organization	FASANO-Avvocati

Respondent

Name	YongWan Ji

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 name <metzeler.net>.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of numerous trademark registrations consisting of/comprising METZELER, including the following:

- U.S. trademark registration No. 1200980 METZELER PERFECT, registered on April 20, 1982 in class 12;
- U.S. trademark registration No. 2351070 METZELER, registered on February 9, 2000, in classes 12 and 18;
- U.S. trademark registration No. 2382019 METZELER & device, registered on September 5, 2000 in classes 8, 12 and 18;
- U.S. trademark registration No. 4937767 METZELER RISK FREE GUARANTEE & device registered on April 12, 2016 in class 36;
- International Registration No. 431981 METZELER PERFECT, registered on July 2, 1977 in class 12;
- International Registration No. 444745 METZELER & device, registered on October 3, 1978 in class 12;
- International Registration No. 611622 METZELER & device, registered on June 9, 1993 in classes 7, 8, 9, 12, 18 and 25;
- International Registration No. 611623 METZELER, registered on June 9, 1993 in classes 7, 8, 9, 12, 18 and 25

FACTUAL BACKGROUND

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

Metzeler is a well-known motorcycle tire company founded in 1863 in Munich, Germany by Robert Friedrich Metzeler. The company originally manufactured a variety of rubber and plastic products, expanding in to aviation in 1890 and automotive and motorcycle tires in 1892. After World War II Metzeler focused only on the motorcycle tire production.

Metzeler has been part of Pirelli Group since 1986. Metzeler has more than 115 years of experience in motorcycle tire development and supply to the world's leading manufacturers. Metzeler has always been on the leading edge for technical innovation and superior quality and performance of its tires. Thanks to the success and leader position achieved in relation with the segments in which it operates, Metzeler is a well-known brand world-wide. Metzeler operates in numerous countries all over the world through its distributor network such as in Austria, Brasil, Canada, Germany, France, Italy, Japan, Spain, Switzerland, UK and in the United States.

The Complainant is owner of numerous registrations and/or applications for trademarks world-wide consisting of/comprising the word "METZELER".

The Complainant has used its trademarks for numerous years in connection with products of the below listed classes of the Nice Classification:

- class 7 of the International Classification System of Goods and Services (namely, “Machines and mechanical apparatus for manufacturing and mounting tires”);
- class 8 of the International Classification System of Goods and Services (namely, “Hand-operated tools as accessories for motorcycles”);
- class 9 of the International Classification System of Goods and Services (namely, “Balancing apparatus for motorcycle tires”);
- class 12 of the International Classification System of Goods and Services (namely, “Tires, particularly for motorcycles; air tubes and rings of foam rubber for tires; wheels with rims and rim bands, valves for tires; bags for motorcycles”);
- class 18 of the International Classification System of Goods and Services (namely, “Umbrellas”);
- class 25 of the International Classification System of Goods and Services (namely, “Clothing, footwear, headgear”).

Substantial effort has been invested over a period of time, including the expenditure of substantial amounts, to develop goodwill in the aforementioned trademarks to cause consumers throughout the world to recognize the marks as distinctly designating products and services that originate with the Complainant. Hence, the Complainant enjoys extensive rights in such trademarks. Complainant also operates websites at <us.metzelermoto.com>, <metzelermoto.com>, <metzelermoto.at>, <metzelermoto.com.br>, <metzelermoto.de>, <metzelermoto.fr>, <metzelermoto.it>, <metzelermoto.jp>, <metzelermoto.es>, <metzelermoto.ch> and <metzelermoto.co.uk>.

The domain name in dispute <metzeler.net> was registered on March 4, 2016, i.e. well after Complainant’s trademarks.

In the Complainant's view the disputed domain name should be transferred to the Complainant, because it constitutes usurpation and violation of the rights of the Complainant with regard to its trademarks registered world-wide.

In accordance with the Complainant's assertions, the disputed domain name is identical or confusingly similar to the Complainant’s trademarks, because it wholly incorporates the dominant part of such marks, namely the wording “METZELER” and it is well-founded that the gTLD (generic top-level domain) “.net” is ignored for the purpose of determination of the identity or the similarity between disputed domain name and Complainant’s trademarks.

In addition, the Complainant outlines that, as per the WHOIS records, the Respondent is YongWan Ji. The Complainant states that the Respondent has never received any approval, expressed or implied, to use the Complainant’s trademarks in or as part of any domain name and that the Complainant has no association, affiliation and/or dealings of any nature whatsoever with the Respondent. The above, in the Complainant's view, is sufficient to make out a prima facie case of absence of rights or legitimate interests in the domain name on the part of the Respondent.

Furthermore, the Complainant assumes that the domain name <metzeler.net> currently resolves to the website, which is a blank page with the only English disclaimer that “the domain metzeler.net may be for sale” and that previously the domain name in dispute resolved to a website containing the same disclaimer and third parties’ links to further websites apparently related to tires, business in which the Complainant is involved. According to the above it is clear, in the Complainant's view, that there is no evidence that the Respondent’s use of <metzeler.net> is either a bona fide offering of goods or services or a legitimate non-commercial or fair use, without intent for commercial gain.

The Complainant also believes that the disputed domain name has been registered and is being used in bad faith considering that:

A) The disputed domain name consists of the well-known trademark of the Complainant, e.g. the wording “METZELER”, such domain name is identical or confusingly similar to the Complainant’s trademarks and taking into account the vast and widespread advertising campaigns carried out by the Complainant for the promotion of products covered by its marks, it is unlikely that the registration of the domain name in question may be attributed to a mere chance and not, as is, with a full awareness and intent to exploit the reputation and good will of the Complainant’s trademarks.

B) The disputed domain name does not resolve to any active website and contains the disclaimer “the domain metzeler.net may be for sale”; such passive use of the domain name is sufficient to find bad faith.

In accordance with the above mentioned, the Complainant considers that the registration of the domain name <metzeler.net> had been carried out with the purpose of:

- selling, renting, or otherwise transferring the domain name registration to the complainant or to a competitor of the complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or
- attracting, for commercial gain, Internet users to the web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the web site or location or of a product or service on the web site or location.

The Complainant also outlines that Respondent, YongWan Li, was already involved in a UDRP domain name dispute no. D2016-0379 before the WIPO for the abusive registration of the domain name <bomcosmetics.net>.

The Registrar communicated that the language of the registration agreement is Korean. The Complainant requested that the language of the proceedings be English for the following reasons:

1) The Complainant is owner of numerous trademark registrations worldwide comprising South Korea consisting of the word "METZELER".
2) Such trademarks are well-known internationally.
3) The Respondent has registered and used the disputed domain name with Latin letters and not Korean ones since it wholly comprises the Complainant's well-known marks.
4) The Respondent is clearly aware of the Complainant's international business and of its marks.
5) The domain name currently resolves to the website, which is a blank page with an English disclaimer that “the domain metzeler.net may be for sale”
6) Previously the domain name resolved to a website containing the same disclaimer and third parties’ links to further websites apparently related to tires, business in which the Complainant is involved and therefore, it is clear that Registrant understands English language.

Furthermore, in that regard the Complainant emphasizes that the Respondent was involved in an UDRP domain name dispute which was conducted in English.

For the reasons mentioned above the Complainant insists that the language of proceeding shall be English since the

translation of the Complaint and participating in a proceeding in Korean language would cause undue delay and expense for the Complainant.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

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

As far as the language of the proceedings is concerned, Rule 11 states as follows:

"Unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding."

The Complainant has requested that the language of the proceedings should be English for the reasons listed in the Complaint, even though the language of the Registration Agreement is Korean. The Panel finds that the Complainant has introduced convincing arguments, having regard to the circumstances of this case, and thus accepts that the proceedings may be in English.

In addition, it should be noted that the same conclusion was reached by the Panel in a previous decision where the Respondent was involved and the language of the Registration Agreement was Korean. This, in consideration of arguments similar to those introduced by the Complainant in the present proceeding (see Get Fresh Cometics v Yongwan Ji, WIPO Case no.2016-0379).

The Panel is satisfied that all procedural requirements under the Policy have been 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 provides that to obtain the transfer of the disputed domain name, the Complainant must prove that each of the following elements is present:

(i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;

(ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and

(iii) the disputed domain name has been registered and is being used in bad faith.

Ad (i) The Complainant has established it has rights in the trademark "METZELER". The Panel notes that "METZELER" is a

well-known trademark as per the information provided by the Complainant and additional Internet searches made by the Panel. The only difference between the disputed domain name and the Complainant's trademark is the gTLD ".net". The Panel finds that the disputed domain name is identical to the Complainant's mark as "METZELER" is incorporated in its entirety in the disputed domain name and it is a well-established principle that suffixes (TLDs) such as ".com", "org" or, in this case, ".net", may be disregarded when determining if there is identity or confusing similarity (see e.g. Playboy Enterprises International, Inc. v. John Taxiarchos, WIPO Case No. D2006-0561; Burberry Limited v. Carlos Lim, WIPO Case No. D2011-0344; Magnum Piercing, Inc. v. The Mudjackers and Garwood S. Wilson, Sr., WIPO Case No. D2000-1525). The Panel therefore finds that paragraph 4(a)(i) of the Policy has been established.

Ad (ii) The Complainant has long standing rights in the trademark "METZELER". The Complainant provided prima facie evidence that the Respondent does not have rights or legitimate interests in respect of the disputed domain name as it is not commonly known under the disputed domain name and as the Respondent was never authorized or licensed or otherwise permitted by the Complainant to use the disputed domain name. The Respondent, in the absence of any response, has not shown any facts or elements to justify legitimate rights or interests in the disputed domain name. Therefore, on the basis of the evidences submitted and in the absence of a response the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name. Accordingly, the Panel finds that the Complainant has satisfied also paragraph 4(a)(ii) of the Policy.

Ad (iii) Taking into account the reputation and fame of the "METZELER" trademark and the fact that this trademark has been incorporated in its entirety in the disputed domain name, the Panel concludes that the Respondent must have known of the "METZELER" trademark when he registered the disputed domain name. The adoption of a well-known trademark into a domain name by someone with no apparent connection with the name suggests opportunistic bad faith (see The Gap, Inc. v. Deng Youqian, WIPO Case No. D2009-0113; SembCorp Industries Limited v. Hu Huan Xin, WIPO Case No. D2001-1092; Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co., WIPO Case No. D2000-0163). Moreover, the Respondent's use of the disputed domain name merely to (a) redirect users to a website displaying several links to further websites apparently related to tyres, business in which the Complainant is involved and (b) indicate that the disputed domain name "may be for sale" supports the conclusion that the Respondent registered the disputed domain name for the purpose of attempting to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's mark as to source, sponsorship, affiliation, or endorsement of the Respondent's website and the websites linked thereto, according to paragraph 4(b)(iv) of the Policy (see Christophe Josse v. perfect Privacy, LLC/Agus Informesi, WIPO Case No. D2015-2282). In addition, the Panel finds that in this case said Respondent's use of the domain name in dispute (i.e. passive holding) is sufficient to demonstrate bad faith use, in particular because of the reputation of the Complainant's trademark and the fact that it is not possible to conceive of any plausible good faith use of such domain names by anyone other than the Complainant (see Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003). The Respondent did not respond and in the absence of any evidence by the Respondent or a satisfactory and credible explanation of how the registration and use of the disputed domain name which incorporates the well-known "METZELER" trademark has not been in bad faith, the Panel finds that paragraph 4(a)(iii) of the Policy has also been satisfied. Furthermore, in Get Fresh Cosmetics Ltd/a Bomb Cosmetics v. Yongwan Ji, WIPO Case No. D2016-0379, the Panel finds registration in bad faith in a case where the same Respondent of the present procedure (YongWan Ji) had registered the domain name <bombcosmetics.net> identical to the well-known trademark "BOMB COSMETICS". Therefore, the Respondent's bad faith is also shown by a pattern of conduct consisting in registering domain names that incorporate well-known trademarks of others(See e.g, Valeant Pharmaceuticals International and Valeant Canada Limited v. Johnny Carpela, WIPO Case No. D2005-0786 and Alloy Rods Global, Inc. v. Nancy Williams, WIPO Case No. D2000-1392).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **METZELER.NET**: Transferred

PANELLISTS

Name	**Avv. Guido Maffei**

DATE OF PANEL DECISION 2016-11-18

Publish the Decision