Decision for dispute CAC-UDRP-101309

Case number	CAC-UDRP-101309
Time of filing	2016-10-11 11:19:48
Domain names	GETMETZELER.COM

Case administrator

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

Complainant

Organization	Pirelli Tyre S.p.A.

Complainant representative

Organization	FASANO-Avvocati

Respondent

Organization	PERFECT PRIVACY, LLC

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings that relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is, inter alia, a registered owner of the following trademark containing a word element "METZELER":

(i) METZELER (word), International (WIPO) Trademark, registration date 9 June 1993, trademark no. 611623, registered for goods and services in classes 7, 8, 9, 12, 18, and 25;

besides other national and international trademarks consisting of the "METZELER" denomination.
(collectively referred to as "Complainant's trademarks").

The disputed domain name was registered on September 3, 2005, i.e. well after the Complainant’s trademarks and thus the Complainant enjoys seniority rights to the “METZELER” denomination.

FACTUAL BACKGROUND

Metzeler is a motorcycle tyre 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 (the Complainant) since 1986.

Metzeler operates in numerous countries all over the world through its distributor network such as in Austria, Brazil, Canada, Germany, France, Italy, Japan, Spain, Switzerland, UK and in the United States (the registrant is based in this latter country).

The disputed domain name <getmetzeler.com> was registered on 3 September 2005 and is held by the Respondent.

The domain name website (i.e. website available under internet address containing the disputed domain name) provides (likely automatically generated) links to various third party content that is associated or otherwise connected with the Complainant and his business, products bearing Complainant's trademarks (Metzeler branded products) or otherwise associated with the Complainant.

The Complainant seeks transfer of the disputed domain name to Complainant.

PARTIES CONTENTIONS

The Parties' contentions are the following:

COMPLAINANT:

CONFUSING SIMILARITY

The Complainant states that the disputed domain name is confusingly similar to Complainant's trademarks and that the disputed domain name contains the Complainant's trademarks in its entirety.

The addition of the term "GET" at the beginning of the disputed domain name is not sufficient to reverse the confusing similarity of the disputed domain name to the Complainant's trademarks. It also does not change the overall impression of the designation as being connected to the Complainant's trademarks or its business and domain names.

The Complainant refers to previous domain name decisions in this regard.

NO RIGHTS OR LEGITIMATE INTERESTS

The Respondent has not been commonly known by the disputed domain name. Neither the Complainant has authorized, permitted or licensed the Respondent to use Complainant's trademarks in any manner. The Respondent has no connection or affiliation with the Complainant whatsoever. On this record, Respondent has not been commonly known by the disputed domain name so as to have acquired rights to or legitimate interests in it.

Furthermore, the domain name website has been during its existence either inactive and without any content or contained links to third parties' websites with a content linked to tyres and related business, i.e. business in which the Complainant is involved.

The Complainant refers to previous domain name decisions contending that the Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests; once such prima facie case is made, the burden shifts to the Respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name.

BAD FAITH REGISTRATION AND USE

Seniority of the Complainant's trademarks predates the disputed domain name registration and such trademarks are well

known in relevant business circles. The Respondent can be considered to be aware of the Complainant's trademark when registering the domain name due to well-known character thereof.

The disputed domain (at the time of filing of the complaint) did not resolve to any active website. Previously, the domain name website contained links to content related to the business of the Complainant. In the light of the foregoing, the Complainant asserts that the disputed domain name was registered and used with the sole purpose of exploiting the reputation and goodwill of the Complainant’s trademarks for commercial gain.

It is well-founded that registration of the disputed domain name that is confusingly similar to the Complainant’s trademarks which enjoys strong reputation, plus other facts, such as above described use (or non-use) of the disputed domain name, are sufficient to establish bad faith under the 4(a)(iii) of the Policy.

The Complainant refers to previous domain name decisions contending that registering a domain name incorporating trademarks that enjoy high level of notoriety and well-known character constitute prima facie registration in bad faith.

The Complainant presents the following evidence which has been assessed by the Panel:

- Information about the Complainant and its business;
- Excerpts from various trademark databases regarding Complainant's trademarks;
- Excerpts on the disputed domain name from WHOIS database;
- Screenshots of the disputed domain name website.

RESPONDENT:
The Respondent has not provided any response to the complaint.

RIGHTS

The Panel concludes that the disputed domain name is confusingly similar to trademarks in which the Complainant has rights within the meaning of paragraph 4(a)(i) of the Uniform Domain Name Dispute Resolution Policy ("UDRP" or "Policy").

For details, see "Principal Reasons for the Decision".

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 name within the meaning of paragraph 4(a)(ii) of the Policy.

For details, see "Principal Reasons for the Decision".

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.

For details, see "Principal Reasons for the Decision".

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

RIGHTS

Since the domain name and the Complainant’s trademarks are not identical, the key element investigated and considered by

the Panel is whether the disputed domain name consisting of a term “METZELER” accompanied by a prefix “GET” is confusingly similar to the Complainant’s trademarks.

The threshold test for confusing similarity under the UDRP involves a comparison between the trademark and the domain name itself to determine likelihood of Internet user confusion. In order to satisfy this test, the relevant trademark would generally need to be recognizable as such within the domain name. An addition of common, dictionary, descriptive, or other descriptive terms is typically insufficient to prevent threshold Internet user confusion. Confusing similarity test under the UDRP typically involves a straightforward visual and aural comparison of the trademark with the domain name.

Applying the principles described above, the Panel contends that incorporation of the dominant “METZELER” element of Complainant’s trademarks (which standalone enjoys high level of distinctiveness) into the disputed domain name constitute confusing similarity between Complainant’s trademark and such domain name. Addition of a non-distinctive element - prefix “GET” - to the “METZELER” denomination cannot prevent the association in the eyes of internet consumers between the disputed domain name and the Complainant’s trademarks and thus the likelihood of confusion still exists.

For sake of completeness, the Panel asserts that the top-level suffix in the domain name (i.e. the ".com") must be disregarded under the confusing similarity test as it is a necessary technical requirement of registration.

Therefore, the Panel has decided that there is confusing similarity in this case, it also concludes that the Complainant has satisfied paragraph 4(a)(i) of the UDRP.

NO RIGHTS OR LEGITIMATE INTERESTS

As evidenced by the Complainant and based on general Internet search, the Respondent is not commonly known by the disputed domain name. Given the fact, that (i) the Respondent links the domain name website to third party's websites that presents information (among others) about Complainant’s products and offers the same for sale and (ii) in the absence of the Respondent's response, the Panel concludes that there is no indication that the domain name was intended to be used in connection with a bona fide offering of goods or services as required by the Policy.

Consequently, the evidentiary burden shifts to the Respondent to show by concrete evidence that it does have rights or legitimate interests in that name. However, the Respondent failed to provide any information and evidence that it has relevant rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a) (ii) of the Policy).

BAD FAITH

The Panel finds it grounded that the Respondent registered and used the disputed domain name in bad faith, namely, by blocking the domain name for itself and not using it for any legitimate purpose.

Such circumstances indicate that the Respondent has registered the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant. With comparative reference to the circumstances set out in paragraph 4(b) of the Policy deemed to establish bad faith registration and use, panels have found that the apparent lack of so-called active use of the disputed domain name without any active attempt to sell or to contact the trademark holder (passive holding), does not as such prevent a finding of bad faith.

In addition, the Claimant has proven that the Respondent has used (at least for some time) the disputed domain name in attracting internet user’s to content promoting sale and offer of tyres and other goods for which the Complainant’s trademarks are registered, likely with intention to free-ride on reputation and goodwill of such trademarks and Complainant’s business.

For the reasons described above and since the Respondent failed to provide any explanation in this regard, the Panel contends, on the balance of probabilities, that the disputed domain name has been registered and is being used by the

Respondent in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **GETMETZELER.COM**: Transferred

PANELLISTS

Name	**JUDr. Jiří Čermák**

DATE OF PANEL DECISION 2016-11-30

Publish the Decision