Decision for dispute CAC-UDRP-101321

Case number	CAC-UDRP-101321
Time of filing	2016-10-25 09:10:38
Domain names	METZELERMOTORCYCLETIRESTORE.COM

Case administrator

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

Complainant

Organization	Pirelli Tyre S.p.A.

Complainant representative

Organization	FASANO-Avvocati

Respondent

Name	Joe Greving

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any pending or decided legal proceedings, which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant bases its Complaint on the following trademarks:

METZELER PERFECT, US trademark registration No. 1200980, dating back to 1980 and duly renewed, covering goods and services in classes 12 and 35;
METZELER, US trademark registration No. 2351070, dating back to 1993, and duly renewed, covering goods in classes 12 and 18;
METZELER and device, US trademark registration No. 2382019, dating back to 1993, and duly renewed, covering goods in classes 8, 12 and 18;
METZELER and device, US trademark registration No. 4937767, dating back to December 9, 2014, covering goods in class 36;
METZELER PERFECT, International trademark registration No. 431981, dating back to 1977, and duly renewed, covering goods in class 12;
METZELER and device, International trademark registration No. 444745A, dating back to 1978, and duly renewed, covering goods in class 12;
METZELER and device, International trademark registration No. 611622, dating back to 1993, and duly renewed, covering

goods in classes 7, 8, 9, 12, 25;
METZELER , International trademark registration No. 611623, dating back to 1993, and duly renewed, covering goods in classes 7, 8, 9, 12, 25.

FACTUAL BACKGROUND

The Complainant 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, the Complainant focused only on the motorcycle tire production.

The Complainant has been part of Pirelli Group since 1986. The Complainant has more than 115 years of experience in motorcycle tire development and supply to the world leading manufacturers. The Complainant 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, the Complainant is a well-known brand world-wide.

The Complainant 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, where the Respondent is based, and Further, 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 Complainant is the owner of numerous METZELER trademark registrations and/or applications worldwide, among which those mentioned above. The Complainant has used its trademarks for many years in connection with “machines and mechanical apparatus for manufacturing and mounting tires”, in class 7, “hand-operated tools as accessories for motocycles products”, in class 8; “balancing apparatus for motorcycle tires”, in class 9; “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”, in class 12; “umbrellas”, in class 18 and “clothing, footwear, headgear”, in class 25. The Complainant has invested substantial amounts in the promotion of its trademarks.

The disputed domain name <metzelermotorcycletirestore.com> was registered on August 29, 2008.

PARTIES CONTENTIONS

The Complainant's contentions can be summarized as follows.

1. Identity or confusing similarity (Policy 4(a)(i); Rules 3(b)(ix)(1))

The disputed domain name is confusingly similar to the Complainant’s trademarks, because it wholly incorporates the dominant part of these marks, namely the word “METZELER”. The addition of the generic terms “motorcycle”, “tire” and “store”, do not affect the attractive power of the dominant part of the Complainant’s trademarks, and are insufficient to exclude the confusingly similarity between the disputed domain name and the Complainant’s marks. As the Complainant is involved in, and well-known for, its business of motorcycle tire manufacturing and sale, the addition of these generic terms increases the likelihood of confusion between the disputed domain name on the one side, and the Complainant's trademark on the other side.

2. Lack of rights or legitimate interests (Policy 4(a)(ii); Rules 3(b)(ix)(2))

The Complainant never authorised, either expressly or implicitly, the Respondent to use the Complainant’s trademarks in, or as part of, any domain name. Furthermore, the Complainant has no association, affiliation and/or dealings of any nature whatsoever with the Respondent, and does not endorse nor promotes his services.

There is no indication that the Respondent has legitimate interests in the trademark METZELER; according to searches conducted among Italian, EU, US and international trademarks, the Respondent does not appear to own any METZELER trademark, or any trademark including this element.

The disputed domain name resolves to a website, which is a blank page. Hence, there is no evidence that the Respondent's use of the disputed domain name is in connection with a bona fide offering of goods or services or amounts to a legitimate noncommercial or fair use, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark at issue.

Finally, there is no evidence that the Respondent has been commonly known by the disputed domain name.
For all these reasons, the Complainant believes that it has established a prima facie case of the Respondent's lack of rights or legitimate interests in the disputed domain name, and that the burden of proof to show that it has rights or legitimate interests in the disputed domain name now shifts to the Respondent.

3) Registration and use of the disputed domain name in bad faith (Policy 4(a)(iii); Rules 3(b)(ix)(3))

As far as registration in bad faith is concerned, the Complainant points out that the disputed domain name consists of the dominant component of its well-known trademarks, i.e. the word "METZELER", and of the generic terms "motorcycle", "tire" and "store", reflecting the Complainant's business. Taking into account the vast and widespread advertising campaigns carried out by the Complainant for the promotion of its trademarks, it is unlikely that the registration of the disputed domain name occurred by mere chance and not because of the Respondent's full awareness of the Complainant's trademarks, and intent to exploit their reputation and goodwill.

As far as use in bad faith is concerned, the Complainant points out that the disputed domain name resolves to an inactive website and that it is well-founded that registration of a trademark, which enjoys strong reputation, coupled with the passive use of the disputed domain name are sufficient to conclude that the use of the disputed domain name is in bad faith under para. 4(a)(iii) of the Policy.

In light of the foregoing, according to the Complainant, the registration of the disputed domain name has either been carried out with the purpose of:

- selling, renting, or otherwise transferring the disputed domain name 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 trademarks 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.

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

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

A. Identity or confusing similarity

The Panel finds that the disputed domain name is confusingly similar to the Complainant's METZELER trademark. As a matter of fact, the disputed domain name fully includes the term METZELER, followed by the generic terms "motorcycle store". It is a well-established principle that the addition of generic terms to a third party's trademark does not avoid likelihood of confusion. On the contrary, where these generic terms refer to the Complainant's activity, like in the instant case, the likelihood of confusion is enhanced rather than diminished.

Therefore, the Panel finds that the Complainant has successfully proved the first requirement under the Policy.

B. Lack of rights or legitimate interests

Since proving a negative fact is almost impossible, Panelists in UDRP proceedings have generally agreed that it is sufficient for the Complainant to establish a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name to shift the burden of proof to the Respondent.

In the case at issue, the Complainant argued that it never authorised the Respondent to register the METZELER trademark as a domain name and that the Respondent does not own any Italian, EU or US METZELER trademark. Furthermore, there is no evidence that the Respondent is using the disputed domain name in connection with a bona fide offering of goods or services, or is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain, to misleadingly divert consumers or to tarnish the Complainant's trademark. Finally, there is no evidence whatsoever of the fact that the Respondent is known by the disputed domain name.

The Panel finds that the Complainant's arguments are sufficient to establish a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent had the possibility to rebut the Complainant's arguments, by providing evidence attesting to its rights or legitimate interests in the disputed domain name, but failed to do so.

As a consequence, the Panel is satisfied that also the second requirement under the Policy is met.

C. Registration and use in bad faith

The Panel finds that the disputed domain name was registered and is being used in bad faith for the following reasons.

As far as registration in bad faith is concerned, the Panel notes that the disputed domain name consists of the Complainant's trademark, coupled with generic terms describing the Complainant's activity. It is not conceivable that when the Respondent registered the disputed domain name it was not aware of the Complainant's trademark. This is so, first, because the Respondent's trademark consists of a fanciful term, which has no meaning whatsoever in any language, including in English, i.e. the language of the country of origin of the Respondent. Furthermore, because the addition in the disputed domain name of generic terms referring to the Complainant's activity is a clear indication of the Respondent's knowledge of the Complainant's trademark and activity, at the time of the registration of the disputed domain name.

As far as use in bad faith is concerned, the Complainant has proved that at the time of the drafting of the Complaint, the disputed domain name did not resolve to an active webpage. Passive holding of a domain name can in some circumstances amount to use in bad faith. This is so, in a case like the one at issue, where the disputed domain name includes a third party's trademark, and the registration of this domain name was made in bad faith.

Furthermore, while writing this decision, the Panel has noted that the disputed domain name now resolves to a parking page containing pay-per-click links. Accordingly, in the absence of any contrary evidence from the Respondent, the Panel finds that the Respondent is deliberately using the disputed domain name to intentionally attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation or endorsement of the website, in accordance with paragraph 4(b)(iv) of the Policy.

Therefore, the Panel concludes that also the third requirement under the Policy is met.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **METZELERMOTORCYCLETIRESTORE.COM**: Transferred

PANELLISTS

Name	**Angelica Lodigiani**

DATE OF PANEL DECISION 2016-12-07

Publish the Decision